

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

CARBYNE BIOMETRICS, LLC,

Patent Owner

IPR2024-00333,

IPR2024-00507

U.S. Patent No. 11,475,105

**PETITIONER'S NOTICE RANKING PETITIONS AND
EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS
FOR U.S. PATENT NO. 11,475,105**

I. INTRODUCTION

Petitioner filed two Petitions challenging claims of U.S. Patent 11,475,105 (the “105 patent”). Pursuant to the Consolidated Trial Practice Guide November 2019 (“TPG”), Petitioner submits this paper to “identify: (1) a ranking of the Petitions in the order in which it wishes the Board to consider the merits..., and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions.” TPG, 60.

II. RANKING OF PETITIONS

Per the Board’s TPG guidance, Petitioner ranks as follows:

RANK	PETITION	CLAIMS	GROUND
1	IPR2024-00333 (challenges all asserted claims together with claims 10 and 29)	1, 14, 18, 33 and 35	Kesanupalli, Cheng, Kodama
		9-11 and 28-30	Kesanupalli, Cheng, Kodama, Challenger
		1, 9-11, 14, 18, 28-30, 33 and 35	[priority break] Jakobsson ’351, Kodama
2	IPR2024-00507 (all challenged claims are not presently asserted)	2, 4, 12, 15, 21, 23, 31 and 34	Kesanupalli, Cheng, Kodama
		5, 6, 24, 25	Kesanupalli, Cheng, Kodama, Hubner
		2, 4, 12, 15, 21, 23, 31 and 34	[priority break] Jakobsson ’351, Kodama
		5, 6, 24, 25	[priority break] Jakobsson ’351, Kodama, Hubner

III. MATERIAL DIFFERENCES BETWEEN THE PETITIONS

Parallel Petitions challenge different claims. The first Petition challenges claims 1, 9-11, 14, 18 and 28-30, while the second challenges claims 2, 4-6 12, 15, 21, 23-25, 31 and 34.¹ Different claims are challenged in each Petition. Challenges to dependent claims involve materially different secondary references with different motivations to combine and different claim construction issues.

IV. INSTITUTION OF AN ADDITIONAL PETITION IS WARRANTED

The Board has recognized “there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.” TPG, 59. These circumstances are present here.

Parallel Petitions here address a priority date dispute. The ’105 Patent issued on a continuation-in-part (CIP) application (17/123,018) filed December 15, 2020 claiming priority (as a CIP) to Application 17/027,481 (“the ’481 App”), which in turn claims priority through a chain of applications to provisional applications

¹ The second petition necessarily sets forth each and every element of claims 1 and 18, which are the base claims for the challenged dependent claims.

including Application No. 61/587,387 (“the ’387 Prov”), dated January 17, 2012.

Priority date—the effective filing date of the ’105 patent claims—is in dispute. Patent Owner has asserted priority based on the ’387 Prov. *See* Preliminary Infringement Contentions (“PICs”), APPL-1029, 9. Petitioner asserts that neither the ’481 App nor any application in the ’105 patent’s chain of priority provides written description support for the subject matter claimed in the ’105 patent, and as such, the effective filing date of each of the claims of the ’105 patent is no earlier than December 15, 2020. Accordingly, the Petitions present challenges based on a first primary reference (Kesanupalli), which is prior art even with respect to the Patent Owner’s asserted 2012 priority date, as well as challenge(s) based on a different primary reference (Jakobsson ’351) that is prior art with respect to the much later effective filing date asserted by Petitioner.

Parallel Petitions here challenge numerous complex claims. Patent Owner currently asserts three independent claims and five dependent claims of the ’105 patent are infringed and also “reserves the right to amend or supplement its contentions to identify additional claims infringed by Defendant after discovery proceeds.” PICs, APPL-1029 at 2. Patent Owner’s attempt to reserve of rights to assert further claims on a timeline that could bar Petitioner’s challenge of such claims itself supports the filing of the second petition. Moreover, the convoluted nature of independent claims, together reciting over 775 words of claim language,

contributes to circumstances that support exercise of discretion and institution of two petitions so that Petitioner may sufficiently address all desired claims.

As an additional factor, the first Petition covers claims that include “restricted interface” limitations for which Petitioner relies on a combination with Challenger (APPL-1007) and for which application of an appropriate claim construction tracks added matter of the ’105 patent (a CIP) that purports to introduce new and materially different examples of a “restricted interface.” On the other hand, the second Petition covers claims that include “pairing” limitations for which Petitioner relies upon a combination with Hubner (APPL-1030) and for which the added matter of the ’105 patent suggests possible alternative meanings. Adequate treatment of these issues was not possible in a single petition. Thus, materially different secondary references, different motivations to combine and different claim construction issues also contribute to word counts that necessitate multiple petitions.

Parallel Petitions here would not materially increase burden on the Board. Despite the challenge of distinct sets of claims, the Board can efficiently resolve the grounds of the first and second Petitions, as second-Petition challenges rely on a combination of the same base prior art (Kesanupalli/Cheng/Kodama; Jakobsson ’351/Kodama), with only the addition of a single prior art reference (Hubner) for a

subset of dependent claims in the second Petition. Petitioner intends to seek consolidation of the two proceedings under 35 U.S.C. § 315(d), if instituted.

V. CONCLUSION

Petitioner has shown material differences between the two Petitions in that the Petitions address different set of claims. The Board should exercise its discretion to institute a second petition at least due to the parties' priority date dispute, which drives the need to present obviousness challenges with respect to each of the Patent Owner's asserted 2012 priority date *and* the Petitioner's asserted 2020 priority date. The Board can efficiently resolve the grounds of the second petition as those challenges rely on the same base combination of references to illustrate obviousness as the first petition, with a single additional reference added to the obviousness combinations for a sub-set of claims of the second Petition.

Respectfully submitted,

Dated: January 31, 2024

/David W. O'Brien/
David W. O'Brien
Lead Counsel for Petitioner
Registration No. 40,107