

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

CARBYNE BIOMETRICS, LLC,

Patent Owner

IPR2024-00334

U.S. Patent No. 11,514,138

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

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This authorized Reply addresses legal and factual errors in Patent Owner's (PO's) treatment of discretion under 35 U.S.C. §325(d) and errors in criticizing the Kesanupalli-Brown combination based on an improper discounting of the evidentiary weight of Petitioner's expert testimony. *See* (POPR) Paper 7, 26-50.

A. The Director has clarified §325(d) policy and *Advanced Bionics*' framework turns on being previously *meaningfully* addressed, which was not the case for grounds and references here

The Office recently engaged in notice and comment rulemaking clarifying the Director views and reflecting the Office's interpretations of proper exercise of discretion to institute IPRs, including under §325(d) and *Advanced Bionics*. 77 Fed. Reg. 28693, 28702 (April 19, 2024) ("RULES FOR 325(D)"). Specifically, RULES FOR 325(D) clarify that "mere prior citation of prior art in an IDS will not automatically satisfy the first prong of...*Advanced Bionics*;" rather, "application of section 325(d) should be limited to situations in which prior art or arguments were *meaningfully addressed* by the Office." *Id.*, 28702, 28700 (emphasis added). PO's request for discretionary denial cannot be sustained under these clarifications as the Grounds presented in the Petition have never been *meaningfully addressed*.

Neither Kesanupalli nor Brown was before the Office during prosecution and mere IDS citation of a Kesanupalli '450 publication with overlapping disclosure did not meaningfully address the claims here challenged. *See, id.*, 28702. Kesanupalli '450 was used in *different* grounds (Johansson–Kesanupalli '450) challenging

claims of a *different patent*, which were denied institution because that third-party petitioner failed to demonstrate that either reference disclosed a first processor that communicates with a second processor using a restricted interface—a basis irrelevant to the '138 Patent. *See Samsung Electronics. Co., Ltd. et al. v. RightQuestion, LLC*, IPR2022-00251, Paper 17, 23-26. Neither the Ground presented here, nor Kesanupalli's teachings relied upon here, were meaningfully addressed in that non-institution decision, much less meaningfully addressed as to *claims of the '138 Patent*. *See* RULES FOR 325(D), 28701 (“If the art or arguments were previously evaluated by the Office in the record *of a related application*, patent owner must establish that the art or arguments were previously evaluated with *respect to claims that are substantially the same as the claims in the challenged patent*”) (emphasis added). Independent claims of the '138 Patent do not recite a “restricted interface,” and dependent claims adding the term have no requirement of first and second processors. Similarly, PO's characterization of Brown as a mere “remote wiping reference” does not implicate *Advanced Bionics*. Unrelated references that differ in content and scope do not become the same or substantially the same simply because they are each applicable to a remote wiping-based limitation. *See* POPR, 34-37; APPL-1001, 12:3. Moreover, the POPR omits the fact that, in response to the reproduced examiner's analysis of Owen with respect to wiping, applicant secured allowance, not by differentiating Owen's remote wiping

teachings, but rather by adding unrelated amendments to its claims. *See* APPL-1002, 40-48. Neither the Grounds (Kesanupalli-Brown) of the Petition, nor the references' teachings relied upon therein, have ever been *meaningfully addressed* by the Office.

B. PO's misapplies precedent, errantly asserting that Dr. McDaniel's testimony should be given "no weight" based on correspondence between his declaration and the Petition

PO's argument rests on its suggestion that the Board should accord Dr. McDaniel's testimony "no weight" based on correspondence between his testimony and arguments presented in the Petition. *See* POPR, 38-39. **First**, PO misapplies precedent. *Kinetic Techs.* and *Volkswagen* stand for the proposition that conclusory, unsupported arguments by a party in its substantive papers do not acquire greater evidentiary weight in mere repetition by an expert. *See Kinetic Techs., Inc. v. Skyworks Sols., Inc.*, IPR2014-00529, Paper 8, 15 (PTAB Sep. 23, 2014) ("Merely repeating an argument from the Petition in the declaration of a proposed expert does not give that argument enhanced probative value."); *see also, Volkswagen Group of America, Inc. v. StratosAudio, Inc.*, IPR2021-00717, Paper 12, 35-37 (Nov. 12, 2021) (finding declaration "provided little additional probative value" for a limitation recognized as missing from the applied art, but claimed to be obvious, citing only the expert), *Facebook, Inc. v. Voxer IP LLC*, IPR2021-00399, Paper 8, 22 (argument in Petition was inadequate; declaration that mirrored those arguments did not provide further support). The cited cases do not stand for PO's much more

expansive proposition (as applied here) that an expert's articulated reasoning with rational underpinning to support a legal conclusion of obviousness ceases to be articulated or rational or is somehow divested of probative weight when also relied upon—even duplicated—in party briefing. Attempts to extend *Kinetic Techs*-type language beyond its proper context have been rejected by the Board. For example, in *Google LLC v Parus Holdings, Inc.*, the Board agreed “with [PO's] general characterization that [the expert] largely repeats most of the Petition verbatim” but “disagree[d] with [PO's] implication that [they] should therefore summarily discount [the expert's] testimony.” IPR2022-00805, Paper 7, 9 (Nov. 7, 2022).

Second, PO seeks to misdirect through selective reproduction of Petitioner's expert's declaration. Dr. McDaniel relies on articulated reasoning and rational underpinnings spanning dozens of paragraphs of testimony *including* explicitly detailing, within the context of the combination, a processor's access to stored credentials, which PO suggests is important for a successful combination. *See, e.g.*, Petition, 43 (citing APPL-1003, ¶147 (explaining that “processor circuitry executing the sensor 204 has access to the record in the storage on the device to facilitate the wiping”))). PO's myopic focus on just two paragraphs is misrepresentative.

C. PO's arguments mischaracterize prior art and misapply law

PO presents unsupported *attorney argument* that because Brown teaches wiping memory from a certain storage/memory location within Brown's exemplary

system and “that is not where Kesanupalli stores its credentials,” a reasonable expectation of success of the combination is lacking. POPR, 49. “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference...Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). The combination here does not rely on Brown’s processor/memory architecture, but rather Brown’s *teaching* of implementing a wipe command to delete user’s personal data related to security functions, applied to the device of Kesanupalli. *See, e.g.*, Petition, 40-43, 15-20; APPL-1003, ¶¶75-82, 139-148. Kesanupalli teaches the processor/memory architecture including accessibility of the stored data to a processor. Petition, 23-25. Brown need not implement the very same architecture for a POSITA to be motivated to, and reasonably expect success in, applying its remote wipe teachings to Kesanupalli’s architecture as detailed in the Petition and Dr. McDaniel’s declaration. PO raises other meritless factual disputes, which cannot be addressed fully within the limits of this reply and can be resolved at trial with a fully developed record.

Petitioner has provided declaratory evidence in support of Kesanupalli-Brown combination; PO provides only attorney argument. *See Google LLC v Parus Holdings, Inc.*, IPR2022-00805, Paper 7 at 10. At bottom, for at least the reasons summarized above, the POPR does not support denial of institution.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e), service was made on Patent Owner as detailed below.

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