

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

CARBYNE BIOMETRICS, LLC,
Patent Owner

Case: IPR2024-00334
U.S. Patent No. 11,514,138

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

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I. INTRODUCTION

Petitioner's Reply provides no compelling arguments and does not move the needle.

II. RESPONSES

A. Proposed rules on § 325(d) have no impact on these proceedings.

Petitioner states that the Board and Director have “recently engaged in notice and comment rulemaking relative to . . . § 325(d).” Reply at 1. As Petitioner admits, the new “approach to § 325(d)” has not been adopted. *Id.* (stating the new rules have been “publish[ed] [for] notice and comment.”). The proposed rules are just that, *proposed* rules—which may change or fail to be adopted. The proposed rules do not govern these proceedings and Petitioner's arguments related to them should be ignored. Reply at 1-3.

B. Petitioner fails to show that its declaration should be given weight.

Petitioner does not deny that the expert declaration and its Petition have identical sections. Reply at 4-5. Instead, Petitioner dismisses Patent Owner's arguments because the copying and pasting from the Petition to the expert declaration is not as bad as the cases that Patent Owner cited in its Preliminary Response. *Id.* But Petitioner cannot seriously contend that its expert declaration should be provided *any* weight with respect to the motivation to combine analysis as they are nearly identical. *Compare* Pet. 40-41 *with* Ex. 1003 at ¶¶ 81-82 (cited on Reply at 4).

Petitioner did not identify (and Patent Owner is not aware of) any additional evidence cited by its expert in ¶¶ 81-82 of the declaration that are not found on the corresponding pages of the Petition. *Id.* The Board should see through Petitioner's handwaving and give the declaration little weight.

C. Patent Owner is not making a bodily incorporation argument.

In a single off-hand remark with no support or citations to anything in the record, Petitioner states that Patent Owner is making a bodily incorporation argument. Reply at 4-5. Patent Owner is not. Patent Owner's argument goes to why a POSITA would *not* have been motivated to combine the references or had a reasonable expectation of success. POPR at 49 ("The Petition has no support at all for the proposition that a POSITA would have had a reasonable expectation of success wiping Kesanupalli's secure storage with Brown's generic disclosures.")

D. There are no fact issues that require a trial.

Finally, Petitioner states that there are factual issues that can only be resolved at trial. Reply at 5. But Patent Owner's arguments largely go to the motivation to combine the references and given the "little" weight the Board should give the expert declaration with respect to these sections and Patent Owner's citations to the prior art references, there is no factual dispute that requires a trial.

III. CONCLUSION

For the reasons stated herein and in the POPR, institution should be denied.

Dated: May 28, 2024

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S PRELIMINARY SUR-REPLY TO PETITIONER'S REPLY PURSUANT TO 37 C.F.R. § 42.10(b)** has been served on Petitioner via email on the following counsel of record for Petitioner:

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