

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 11,514,138

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

Dissatisfied with the Board's thorough analysis and its reasoned determination that a POSITA would have combined teachings of both Brown and Challenger with Kesanupalli, Patent Owner (PO) requests Director Review ("Request," Paper 27). PO alleges two "errors," (i) an improperly shifted burden and (ii) a failure to properly "consider and weigh all" its evidence. Request, 1, 6-7. But PO's arguments mischaracterize the Board's analysis and are contrary to the FWD (Paper 26). The so-called "errors" are merely disagreements with the Board's findings, and the Request should be denied.

I. NO REVIEWABLE ERROR IS DEMONSTRATED

Requests for Director review of a final written decision are limited to: (a) abuse of discretion; (b) important issues of law or policy; (c) erroneous findings of material fact; and (d) erroneous conclusions of law. The Request does not credibly raise any such abuse, issue, or error.

PO alleges that the Board "shift[ed] the burden away from the petitioner" in its obviousness analysis. Request, 10. This first allegation of error misrepresents the FWD, which explicitly recognized that "Petitioner has the burden," noted that a reason to "shift[]" that burden is "not present," and determined that *Petitioner* had, in fact, met its burden. *See* FWD, 10, 33. PO's second allegation of error—failure to properly weigh the evidence—is simply a plea for the Director to reweigh and to reconsider evidence and arguments already fully considered by the Board. At

bottom, neither constitutes an erroneous finding of fact or conclusion of law. Each so-called “error” is addressed below.

A. The Board did not improperly shift any burden.

PO contends “the Board’s analysis stated that [PO] failed to disprove the petitioner’s alleged motivation to combine, rather than requiring the petitioner to carry its burden.” Request, 9. This statement is false.

First, as discussed above, the FWD explicitly recognized there is no shift of Petitioner’s burden: “The Petitioner has the burden of proving unpatentability by a preponderance of the evidence. [] That burden only shifts to Patent Owner in limited circumstances not present here.” FWD, 10 (emphasis added). The FWD then correctly determined that Petitioner carried its burden, “show[ing] by a preponderance of the evidence” that each claim was obvious. *See, e.g.*, FWD, 33.

Second, PO’s supposition of burden-shifting is based entirely on its own mischaracterization of a single sentence of the FWD. The FWD correctly stated: “Patent Owner does not explain why the disclosed system of Kesanupalli would not benefit in the way as explained by Petitioner, by inclusion of Brown’s wiping feature.” FWD, 31. This sentence follows nearly ten pages addressing *both* Petitioner and PO’s assertions (FWD, 21-27) and discussing why PO’s arguments were unpersuasive (FWD, 27-31). No burden was shifted. As recognized in the FWD, Petitioner provided “articulated reasoning for a proper motivation to combine

teachings, [with] a rational underpinning” including explaining how Kesanupalli’s system would “benefit from inclusion of Brown’s wiping feature, i.e., reducing the risk of unauthorized or malicious access of sensitive data in case the device is lost or stolen.” FWD, 31. PO did not rebut, refute, or otherwise provide any contrary explanation directed to this benefit as applied to Kesanupalli in the context of a lost or stolen device. *See* FWD, 25-27 (summarizing PO’s assertions); Paper 16 (Pet. Reply), 3 (“PO does not rebut the legal or technical sufficiency of this evidence”). Instead, PO chose to present reasons *not* to combine the prior art teachings. *See* FWD, 25-27 (discussing PO’s unpersuasive arguments directed to what it alleged was the “main goal” of Kesanupalli (the reference) and to what it alleged were the “decisions” of Mr. Kesanupalli (the person)). The FWD statement merely reflects an absence of countervailing evidence in the record. Weighing evidence, which includes recognizing what arguments are presented, is not burden-shifting.

PO also “question[s]” the Board’s “acceptance” of Petitioner’s “generalized statements about security improvements.” Request, 10. Again, PO identifies no reviewable error or supportive caselaw, just disagreement with the Board’s finding. As discussed below, PO’s demand for security improvements to be narrowly tailored to a specific threat was soundly rejected by the Board.

B. Board did not err in its consideration of the prior art.

PO argues the FWD “failed to properly weigh the evidence submitted by

[PO]" because the Board "dismissed or ignored [its] evidence." Request, 11. But PO does not identify any of its arguments or evidence absent from the Board's analysis. To the contrary, the Board thoroughly considered and addressed¹ each of PO's arguments—and found them to be unpersuasive.

As best understood based on the Request, PO now argues that two of its theories were not sufficiently appreciated by the Board, namely its arguments:

- that the "primary objective" or main goal of Kesanupalli (the reference) was "thwarting social engineering attacks," and neither Brown's wiping function nor Challenger's TPM advanced that supposed objective or goal (Request, 12); and
- that Ramesh Kesanupalli (the person) "demonstrate[d] a conscious decision" not to describe wiping or TPM features in the Kesanupalli reference, and as such, provided "definitive evidence of non-obviousness" (Request, 13).

However, each of PO's arguments was recognized and addressed, nearly verbatim, by the Board. *See* FWD, 25 ("[PO] argues ... 'Kesanupalli's *main goal* was to thwart social engineering attacks," and that Brown's teachings about wiping 'would not further Kesanupalli's goals.'"), 25-26 ("According to [PO], we must also consider

¹ PO raised arguments related to limitation [1.7], which are addressed at FWD, pp. 25-32 and raised arguments related to dependent claims 11 and 23, which are addressed at FWD , pp. 43-49.

what Ramesh Kesanupalli, [] actually did, i.e., not describing wiping in the disclosure of the Kesanupalli reference ...[, and according to PO], Mr. Kesanupalli's decision not to include wiping reflects 'common sense and real world indicators' which must not be ignored."). The Board not only recognized but fully considered these arguments and found them unpersuasive. FWD, 27-32, 46-69.

Specifically, the Board reasoned that Kesanupalli is not limited to social engineering attacks as its "only goal or interest...to the exclusion of everything else." *See* FWD 27-29 (enumerating the other security features of Kesanupalli). Even if Kesanupalli had a single goal, limiting the obviousness framework to that goal would be "misplaced and inappropriate" under case law. FWD, 30. Moreover, PO did not persuasively counter Petitioner's articulated reason for combining teachings of securing data in a lost or stolen device. FWD, 31. The Board also found that "subjective decisions of Mr. Ramesh Kesanupalli, even if demonstrated unambiguously (and they are not), are not a stand-in for the legal construct of a POSITA." FWD, 32 (also noting that PO's argument lacked evidence and did not undermine Petitioner's reasoning that POSITA would have wanted to include a wiping feature). Thus, the Board expressly considered and rejected both arguments.

II. CONCLUSION

Rather than demonstrating error in the FWD, PO simply disagrees with the Board's conclusions. Accordingly, PO's Director Review Request should be denied.

Respectfully submitted,

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HAYNES AND BOONE, LLP
2801 N. Harwood Street, Suite 2300
Dallas, TX 75201

/David W. O'Brien/

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

CERTIFICATE OF SERVICE

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

Date of service July 1, 2025

Manner of service Electronic Mail: rkamprath@mckoolsmith.com;
gfishback@mckoolsmith.com;
Carbyne_Apple@mckoolsmith.com

Documents served **AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST**

Persons served Richard A. Kamprath
MCKOOL SMITH, P.C.
300 Crescent Court, Suite 1500
Dallas, Texas 75201

George Fishback
MCKOOL SMITH, P.C.
303 Colorado Street, Suite 2100
Austin, Texas 78701

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