

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

CARBYNE BIOMETRICS, LLC,

Patent Owner

IPR2024-00507

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

**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) as well as PO's attorney argument regarding the reasonable likelihood that Petitioner will prevail at trial on the combination of references and priority date. *See* (POPR) Paper 8, 6-10, 26-52.

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. (All emphasis in quotations added.) None of Kesanupalli, Cheng, or Kodama were before the Office during prosecution of the '105 Patent. And mere IDS citation of a Kesanupalli '450 publication with overlapping disclosure in this or related patents is insufficient. *See, id.*, 28701-28702. 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 '105 Patent. *See Samsung Electronics. Co., Ltd. et al. v. RightQuestion, LLC*, IPR2022-00251, Paper 17, 23-26.

B. PO's misapplies precedent, errantly asserting that Dr. McDaniel's testimony should be "given little weight" based on correspondence between his declaration and the Petition

Kinetic Techs. and *Volkswagen* stand for the proposition that conclusory, unsupported arguments by a party in its substantive paper(s) do not acquire greater evidentiary weight in mere repetition by an expert. *See, e.g., 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."); *Volkswagen Group of America, Inc. v. StratosAudio, Inc.*, IPR2021-00717, Paper 12, 35-37 (PTAB, Nov. 12, 2021). By contrast, Dr. McDaniel's declaration includes articulated reasoning and rationale underpinnings backed by citations to background art. *See generally*, APPL-1003, ¶¶81-90, 139-147 (*e.g.*, ¶82 "homogenous interface design," APPL-1009, APPL-1020). Further, PO's characterization of the declaration and Petition as "nearly identical" is wrong and based on a misleading, truncated citations—the paragraph in Dr. McDaniel's declaration immediately following that reproduced by the PO begins "I now *explain further* the mitigating complexity [] issues [of the previous paragraph]" and goes on to provide further reasoning and analysis. APPL-1004, ¶82.

C. Kodama is analogous art to the '105 Patent

The Petition and Dr. McDaniel explain that Kodama and the '105 Patent are in the same field of endeavor. Petition, 16-18. PO incorrectly narrows the scope of its inquiry to confine Kodama's backup teachings to just one implementation—"a TV programming recorder at a repair plant." POPR, 37. But the analogous art inquiry is "not limited to the specific point of novelty, the narrowest possible conception of the field, or the particular focus within a given field." *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1001-1002 (Fed. Cir. 2016). And Kodama explicitly states "[t]he backup target appliance is *not limited* to an HDD recorder, and the present invention can be *applied to any electronic appliance* such as a mobile phone, a PDA or a PC...Moreover, there is *no particular limitation in the backup target data* upon applying the present invention[.]" APPL-1010, [0040], [0041]; Petition, 17. Thus, Kodama itself directly contradicts PO's attorney argument. Expert testimony (APPL-1003, ¶¶83-84) and illustration of the same search subclass (Petition, 17-18) reinforce the point.

D. The '105 Patent is entitled only to its filing date

The propriety of challenging priority within IPRs has been frequently confirmed. *See, e.g., Arthrex, Inc. v. Smith & Nephew, Inc.*, 35 F.4th 1328, 1343-1345 (Fed. Cir. 2022); *Indivior UK Ltd. v. Dr. Reddy's Lab'ys S.A.*, 18 F.4th 1323, 1330 (Fed. Cir. 2021), *Reckitt Benckiser v. Ansell Healthcare*, IPR2017-00066,

Paper 35. Here, PO incorrectly argues that a sentence that includes the term “policy” in a provisional application filed Jan., 2012, when considered *in combination* with a sentence first introduced Dec., 2020 in the continuation-in-part (CIP) filing of the ’105 Patent, supports its priority claim. POPR, 44-45. A disclosure relied upon for priority must reasonably convey to those skilled in the art that the inventor had possession of the claimed subject matter *as of the filing date sought*. 35 U.S.C. § 120, *Arthrex, Inc. v. Smith & Nephew, Inc.*, 35 F.4th 1328, 1343 (Fed. Cir. 2022); *Tronzo v. Biomet, Inc.*, 950 F. Supp. 1149, 1154-55 (S.D. Fla. 1996), *aff’d in part*, 156 F.3d 1154 (Fed. Cir. 1998). Text introduced by the CIP—years after the date sought—is neither evidence the inventor had possession of a “brand” based limitation, nor instructive of a POSITA’s interpretation of the term “policy” *as of the filing date sought*. Moreover, the Federal Circuit has held that § 120 “requires an applicant to meet the disclosure requirement of §112, ¶1 in a single parent application in order to obtain an earlier filing date for individual claims.” *Studiengesellschaft Kohle, M.B.H v. Shell Oil Col.*, 112 F.3d 1561, 1564 (Fed. Cir. 1997).

E. PO’s arguments mischaracterize prior art and misapply law

PO attacks the references individually alleging Kodama cannot be properly combined because it lacks biometrics and ostensibly because one of its described implementations permits a weaker password practice. POPR, 40-43, 46-53. These allegations are irrelevant and mistake differences for conflict. “The test for

obviousness...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 Petition relies on Kodama’s teaching of initiating a backup *at least in part based on the first device being the same brand as the second device*, not for password management or biometrics, both of which are taught by Kesanupalli (or identified in Jakobsson ’351), and neither of which is contrary to nor incompatible with Kodama’s teaching of checking a device brand when initiating a backup of an electronic device. *See* Petition, 31-35, 61-63.

PO similarly and irrelevantly mischaracterizes Cheng as not needing to store biometrics in a security portion (POPR, 31-35) despite the Petition’s demonstration that Kesanupalli teaches storage of biometrics. The PO cited Cheng portions say nothing about biometric storage or access thereto, they merely opine biometrics are difficult to “replicate,” and moreover, Cheng actually secures such data (*e.g.*, using encryption). *See* Petition, 31-33 (citing APPL-1003, ¶146). 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’s positions and statements of POSITA’s understanding are supported by evidence; PO’s contentions to the contrary are not. *See Google LLC v Parus Holdings, Inc.*, IPR2022-00805, Paper 7, 10. At bottom, for at least the reasons summarized above, the POPR does not support denial of institution.

Respectfully submitted,

Dated: May 21, 2024
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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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