Paper No. 7

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY INTERACTIVE ENTERTAINMENT INC. and
SONY GROUP CORPORATION,
Petitioners,

v.

RESONANT SYSTEMS, INC.,
Patent Owner.

Case No. IPR2024-00697
U.S. Patent No. 8,093,767

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST

Exhibit No	*Description*
2001	Defendant Apple Inc.'s Proposed Claim Constructions, (*Resonant Systems, Inc. v. Apple Inc.*, Case No. 23-cv-00077-ADA (W.D. Tex.))
2002	Court's Claim Construction Order (*Resonant Systems, Inc. v. Apple Inc.*, Case No. 23-cv-00077-ADA (W.D. Tex.), Dkt. 91)
2003	Defendant Apple Inc.'s Opening Claim Construction Brief (*Resonant Systems, Inc. v. Apple Inc.*, Case No. 23-cv-00077-ADA (W.D. Tex.), Dkt. 75)
2004	Order Modifying Scheduling Order (*Resonant Systems, Inc. v. Apple Inc.*, Case No. 23-cv-00077-ADA (W.D. Tex.), Dkt. 57)
2005	Federal Court Management Statistics, Western District of Texas, 2018-2023
2006	Excerpt of Plaintiff's Infringement Contentions (*Resonant Systems, Inc. v. Apple Inc.*, Case No. 23-cv-00077-ADA (W.D. Tex.))
2007	Excerpt of Defendant's Final Invalidity Contentions (*Resonant Systems, Inc. v. Apple Inc.*, Case No. 23-cv-00077-ADA (W.D. Tex.))

I. INTRODUCTION

Petitioner Apple unreasonably delayed filing a IPR petition challenging the '767 patent, waiting more than ten months after it was served with a complaint asserting the patent before doing so. As a result of this delay, the court and the parties have already invested substantial work into resolving the case in district court. The court has already issued its claim construction order, and by the time a decision on instituting this IPR petition is due, fact discovery will be less than two weeks from completion. Trial in district court is scheduled to begin almost three months before a final written decision would be due in this IPR. And Petitioner is asserting exactly the same prior art in district court, in the same obviousness combinations, as it asserts in this IPR petition. Petitioner provides no justification for this delay and has offered no stipulation to reduce the overlap and wasteful duplication between the district court and IPR proceedings. Accordingly, the Board should exercise its discretion to deny institution on *Fintiv* grounds.

Even further multiplying waste and inefficiency, Petitioner filed two parallel IPR petitions, challenging the same five claims of the '767 patent. The '767 patent presents no unusual circumstances that would have prevented Petitioner from setting forth an adequate validity challenge to these five

claims within the 14,000 words ordinarily allowed to IPR petitioners. Petitioner fails to show that this is one of the "rare" cases where the Board should institute two parallel petitions on the same patent. Therefore, even if the Board does not deny institution on *Fintiv* grounds, it should decline to institute both of the parallel IPR petitions.

II. BACKGROUND

A. Background to the '767 Patent

Many electronic devices such as mobile phones and game controllers make use of components that produce vibrational forces. The '767 patent teaches and claims improved vibration modules with features suitable for such applications:

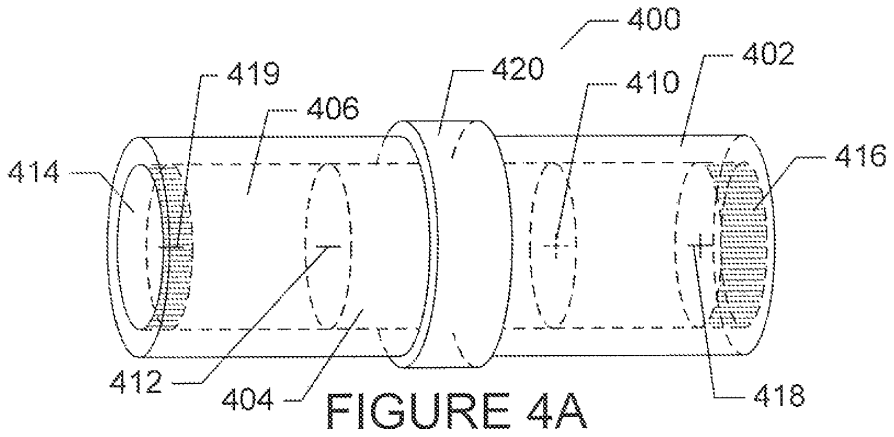

FIGURE 4A

(Ex. 1001 at 5.) Compared to prior art solutions, the inventions of the '767 patent offer greater durability, greater efficiency, an ability to generate useful

vibrations over a range of frequencies, and more desirable patterns of vibration.

III. LEVEL OF ORDINARY SKILL IN THE ART

Patent Owner believes that a POSITA at the time of the invention would have had (1) a bachelor's degree in electrical engineering, mechanical engineering, or a comparable field of study, and (2) at least two years of professional experience with electro-mechanical control systems, or other similarly relevant industry experience. Additional relevant industry experience may compensate for lack of formal education or vice versa.

Petitioners offer a similar level of ordinary skill in the art. Patent Owner does not believe that any of the arguments herein would change if the Board were to adopt Petitioners' definition for the level of ordinary skill rather than Patent Owner's.

IV. LEGAL STANDARDS

The petitioner has the burden to clearly set forth the basis for its challenges in the petition. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) as "requiring IPR petitions to identify 'with particularity ... the evidence that supports the grounds for the challenge to each claim'"). A petitioner may not rely on the Board to substitute its own reasoning to remedy the deficiencies in a petition. *SAS Inst., Inc. v.*

Iancu, 138 S. Ct. 1348, 1355 (2018) ("Congress chose to structure a process in which it's the petitioner, not the Director, who gets to define the contours of the proceeding."); *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (rejecting the Board's reliance on obviousness arguments that "could have been included" in the petition but were not, and holding that the Board may not "raise, address, and decide unpatentability theories never presented by the petitioner and not supported by the record evidence"); *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed. Cir. 2015) (holding that "a challenge can fail even if different evidence and arguments might have led to success"); *Wasica Finance GMBH v. Continental Auto. Systems*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (holding that new arguments in a reply brief are "foreclosed by statute, our precedent, and Board guidelines").

The Board "may reject even uncontroverted expert testimony when it is intrinsically unpersuasive." *Granite Constr. Co. v. United States*, 962 F.2d 998, 1006 (Fed. Cir. 1992). The petitioner cannot satisfy its burden of proving obviousness by employing "mere conclusory statements." *Magnum*, 829 F.3d at 1380.

An obviousness determination requires finding that a POSITA would have been motivated to modify or combine teachings in the prior art. *In re Stepan Co.*, 868 F.3d 1342, 1345–46 (Fed. Cir. 2017). Obviousness concerns

"whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention." *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015). The "mere fact that these possible arrangements existed in the prior art" does not provide a motivation to substitute the arrangement in one prior art embodiment with the arrangement in another." *Virtek Vision International ULC v. Assembly Guidance Systems, Inc.*, 97 F.4th 882, 887 (Fed. Cir. 2024). Because a motivation to modify or combine is part of the *prima facie* case for obviousness that must be set forth in the petition, a petitioner should not be permitted to present "an entirely new rationale to explain why one of skill in the art would have been motivated to combine" in its reply. *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1370 (Fed. Cir. 2016).

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112 ¶ 6. Even were a claim does not utilize the word "means," § 112 ¶ 6 will apply if "the claim term fails to recite

sufficiently definite structure or else recites function without reciting sufficient structure for performing that function." *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349 (Fed. Cir. 2015).

V. CLAIM CONSTRUCTION

In the District Court, Petitioner has asserted that the preamble of claim 1 is limiting. Ex. 2001 (Apple's Proposed Claim Constructions) at 2. Patent Owner consented to that proposal and the District Court entered a construction that the preamble of claim 1 is limiting. Ex. 2002 (*Markman* order) at 1. The Board should enter the same construction, finding that the preamble of claim 1 is limiting based on Petitioner's assertion in the District Court and based on the District Court's order. Furthermore, the Board may also consider the arguments made by Petitioner before the District Court in connection with the identical preambles of other patents and reach a conclusion on the merits that the preamble is limiting. For example, Petitioner argued before the District Court that the preambles of several claims, including '767 Patent claim 1, "limiting because the specifications are replete with references to the 'invention' as described in the preamble." Ex. 2003 (Apple opening claim construction brief) at 12 (citing '767 patent, 10:9–14). Petitioner relied on case law that, in Petitioner's view, held that a preamble should be construed as limiting

when "[t]he specification is replete with references to the invention as [described in the preamble], including the title of the patent itself and the 'Summary of the Invention.'" *Id.* at 23 (quoting *Poly-Am., L.P. v. GSE Lining Tech., Inc.*, 383 F.3d 1303, 1310 (Fed. Cir. 2004)). For these reasons, the Board should apply the construction that Petitioner asserted in the District Court, that the preamble of claim 1 as limiting.

The claim construction arguments expressly raised in the Petition regarding means-plus-function terms relate to issues not relevant to the arguments made in this Preliminary Response, such that there is no need for the Board to make claim construction determinations about Section 112, Paragraph 6 to decide institution. *See* Pet. at 5-10; *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999); *Apple Inc. v. Uniloc Luxembourg S.A.,* IPR2018-00420, Paper No. 7 at 8 (PTAB Aug. 6, 2018). For reference, the District Court agreed with Patent Owner and ordered that the "control component" term has its plain and ordinary meaning and is not subject to means-plus-function treatment. Ex. 2002 at 3-4.

VI. DISCRETIONARY DENIAL

A. The Board Should Exercise Its Discretion to Deny Institution on *Fintiv* Grounds

35 U.S.C. § 314(a) gives the Board discretion to deny institution of IPR due to the advanced state of parallel district court litigation regarding the same

issues. *See NHK Spring Co. v. Intri-Plex Techs., Inc*., IPR2018-00752, Paper 8 at 19-21 (PTAB Sept. 12, 2018) (precedential) ("*NHK*"). The Board has set forth six factors for determining whether discretionary denial in light of such parallel litigation is appropriate, and in analyzing them, "takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv I*"); *see also Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7-17 (PTAB May 13, 2020) (informative) ("*Fintiv II*"); Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (dated June 21, 2022) ("Interim Discretionary Denial Memo").

Each of these six *Fintiv* factors weigh in favor of the Board exercising its discretion to deny institution here. For Factor 1, no stay of the parallel district court litigation has been granted, and a stay is unlikely given the advanced stage of the case. For Factor 2, the district court trials will occur almost three months before the deadline for a final written decision in this proceeding. For Factor 3, largely due to Petitioner's delay in filing the Petition, there will be much investment by the parties and the district court—the district court has already issued its claim construction order, and by the time the Board issues its institution decision, fact discovery will also be near completion. For Factor

4, there is substantial overlap in both the claims and art at issue in this proceeding and in the district court; Petitioner had not made a *Sotera* stipulation to address the concerns of inefficiency and inconsistent rulings. For Factor 5, Petitioners are defendants in the parallel litigation. And for Factor 6, not only did Petitioners unduly delay in filing the Petition, but the Petition also fails to present a compelling challenge on the merits. Each of these factors is addressed in more detail below.

1. *Fintiv* Factor 1: The district court has not granted a stay, nor is there any evidence that a stay will be granted.

In the parallel district court proceeding (*Resonant Systems, Inc. v. Apple Inc.*, Case No. 23-cv-00077-ADA (W.D. Tex.)) involving the same challenged claims of the ’767 Patent and the Petitioner, the district court has not granted a stay pending IPR. Further, there is no evidence that a stay will be granted. Moreover, the motion to transfer to the Northern District of California that Petitioner refers to has been denied. (*Resonant Systems, Inc. v. Apple Inc.*, Case No. 23-cv-00077-ADA (W.D. Tex.), Dkt. 83.)

Moreover, the facts here indicate that it is unlikely that the district court would grant a stay pending IPR even if this IPR were instituted, given the late stage of litigation. The parties have already exchanged final infringement and invalidity contentions (Ex. 2004 at 2), the fact discovery period is more than

half completed (Ex. 2004 at 1–2), and the court has entered its claim construction order (Ex. 2002). And by the time the Board's institution decision is due in this proceeding (October 25, 2024), less than two weeks will remain in fact discovery, and trial will be just over nine months away. (Ex. 2004 at 2–3.) Trial is currently set for August 4, 2025—almost three months before the earliest deadline for a final written decision in this IPR. (Ex. 2004 at 3.)

Where the district court litigation has not been stayed, and any stay is speculative and unlikely, allowing this IPR to proceed in parallel would be wasteful and inefficient. Factor 1 weighs against institution.

2. *Fintiv* Factor 2: The district court trials will occur almost three months before the deadline for a final written decision in this proceeding.

"If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*." *Fintiv I* at 9.

Here, the deadline for a final written decision in this IPR is October 25, 2025, which may be extended to April 25, 2026, for good cause or in the case of joinder. 37 C.F.R. § 42.100(c). Meanwhile, the district court litigation is set for trial on August 4, 2025. (Ex. 2004 at 3.) The timeframe set by the district court is consistent with the Federal Court Management Statistics for the West-

ern District of Texas. *See* Interim Discretionary Denial Memo at 3 & n.4 (encouraging use of these statistics in evaluating this factor). Those statistics indicate that, over the past six years, a civil case in the district was brought to trial 25 months after filing. Ex. 2005 (indicating median times to trial for civil cases for the twelve-month period ending in December for 2018-2023 as 20.4, 27.9, 18.5, 25.5, 29.5, and 28.3). Here, the trial is set approximately 26 months after June 1, 2023, the date the case was filed. (Ex. 2004 at 3; *Resonant Systems, Inc. v. Apple Inc.*, Case No. 23-cv-00077-ADA (W.D. Tex.), Dkt. 1.)

Thus, the district court trial is set to occur ***about three months*** before the deadline for a final written decision, and possibly nine months before the deadline if extended. This weighs heavily against institution. Indeed, the Board has denied institution on account of even smaller gaps between the final written decision and trial. *See, e.g.*, *EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022) (finding this factor weighed in favor of discretionary denial and denying institution where "the beginning of the jury trial in the WDTX Cases is roughly ***one or two months*** before any final decision would have been due had *inter partes* review been instituted"); *Fintiv II* at 13 (finding this factor weighed in favor of discretionary denial and denying institution where the district court trial was scheduled to occur ***two months*** before the deadline for the Board to reach a final written

decision); *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 17 at 9 (PTAB May 2, 2022) ("*NXP*") (same), *reh'g denied*, Paper 20 (PTAB Aug. 25, 2022).

Petitioner implies that the Board should ignore these set trial dates because it is "uncertain and subject to change due to a number of factors." Paper 3 at 79. But the Petition presents no evidence that the trials will not proceed on the set dates, which, as noted above, is consistent with the most current time-to-trial statistics for the Eastern District of Texas. *See* Interim Discretionary Denial Memo at 3 & n.4. "[B]ased on the evidence of record, there is no evidence to suggest that trial will be delayed." *Nine Energy* at 9; *see also NXP* at 9 ("We generally take courts' trial schedules at face value absent some strong evidence to the contrary.") (quoting *Fintiv II* at 13).

Because the district court trial is currently set to occur about three months before the earliest deadline for a final written decision in this IPR, the set date is consistent with current time-to-trial statistics, and there is no evidence that the date may change, this factor weighs heavily against institution. *Fintiv II* at 13.

3. *Fintiv* Factor 3: By the time an institution decision is reached, both fact discovery and claim construction proceedings will be well underway.

Factor 3 relates to the "amount and type of work already completed in the parallel litigation by the court and the parties ***at the time of the institution decision***." *Fintiv I* at 9 (emphasis added). Here, claim construction before the district court is complete. (Ex. 2002.) Fact discovery is likewise already well underway. The parties have collectively served and responded to dozens of interrogatories and dozens of requests for production, as well as served 15 third-party subpoenas. Extensive document production has also already occurred. And by the time the institution decision issues, the deadline to complete discovery will be less than two weeks away. (Ex. 2004 at 2–3.) Those investments weigh strongly against institution because they ensure that this IPR cannot be an efficient alternative to district court litigation. This favors discretionary denial, and panels have found this factor to favor denial when the parallel litigation was at a similarly advanced stage as here. *See, e.g.*, *BOE Tech. Grp. Co. v. Element Capital Commercial Co.*, IPR2023-00808, Paper 9 at 23-24 (PTAB Nov. 15, 2023) (denying institution in part because "[s]ignificant discovery has been completed, including the exchange of infringement and invalidity contentions, document requests and interrogatories, and proposed claim terms for construction, and … close of fact discovery is near").

Of course, the reason that the district court litigation will be so far along at the time of institution is because Petitioner unduly delayed in filing the Petition, filing on April 12, 2024, over ten months after being served with the first district court complaint on June 7, 2023. (*Resonant Systems, Inc. v. Apple Inc.*, Case No. 23-cv-00077-ADA (W.D. Tex.), Dkt. 15.) The Petition offers no explanation for Petitioner's delay.

Because there has been substantial investment in the parallel proceedings, and Petitioner delayed in filing the Petition, Factor 3 weighs heavily against institution.

4. *Fintiv* Factor 4: There is substantial overlap between this IPR and the district court proceeding.

This factor looks at "whether all or some of the claims challenged in the petition are also at issue in district court" and whether the "petition includes the same or substantially the same claims, grounds, arguments, and evidence" as the parallel district court case. *Fintiv I* at 12-13. Here, there is complete overlap between the challenged and asserted claims, and some of the same prior art applied in the Petition is also relied upon at the district court.

First, the Petition challenges the same claims that are currently asserted in the litigation. (*Compare* Paper 3 (challenging claims 1–5) *with* Ex. 2006 at 1 (asserting claims 1–5)). Second, Petitioner asserts each of the references relied upon in this Petition as a prior art reference in its district court invalidity

contentions. (Ex. 2007 at 123–124 (identifying Shahoian, Cosper, and Ramsay as anticipating '767 patent), 141 (identifying Shahoian in view of Cosper, Rossi, Ramsay, and Aldrich as rendering '767 patent obvious).)

In short, the Petition challenges the same claims asserted in the parallel litigation, and Petitioner relies on each of its IPR references at the district court. This raises substantial "concerns of inefficiency and the possibility of conflicting decisions," weighing against institution. *See Fintiv I* at 12.

5. *Fintiv* Factor 5: Petitioner is the defendant in the district court litigation.

Petitioner are defendant in the parallel litigation. "Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial." *Fintiv II* at 15.

6. *Fintiv* Factor 6: Other circumstances weigh strongly against institution, including the weakness of the Petition and Petitioner's delay.

This factor looks at "other circumstances that impact the Board's exercise of discretion, including the merits." *Fintiv I* at 9. This factor weighs heavily against institution for two reasons. *First*, contrary to Petitioner's assertion, the Petition fails to present a "compelling unpatentability challenge" (*see* Interim Discretionary Denial Memo at 2-5). Petitioner failed to identify a single reference that anticipates or renders obvious even one of the challenged claims, so each ground relies on combinations of references from multiple

fields of endeavor. The various grounds depend on different constructions of a term "control component . . ." disputed in the district court. If Petitioner had truly believed it had a "compelling" challenge, it would not have gone to the expense of filing a second back-up petition based upon a different primary reference. (*See* IPR2024-00698.) And it would not have resorted a combination of five different prior art references to invalidate claim 1 under the claim construction that Petitioner itself advances. (IPR2024-00697, Paper 3, Ground 2B; IPR2024-00698, Paper 2, Ground 2B. Such complicated and contingent grounds are not the makings of a "compelling" challenge.

Second, there is evidence that Petitioner unduly delayed in filing the Petition, as discussed above for Factor 3, and Petitioner offers no explanation for its delay.

* * *

Each of the six *Fintiv* factors weigh in favor of the Board exercising its discretion to deny institution.

B. The Board Should Exercise Its Discretion to Deny Institution of this Parallel Petition

The Board should deny institution of *inter partes* review because the instant Petition is one of two parallel petitions that Petitioner filed challenging claims of the '767 patent. If the Board grants institution of the other parallel petition in IPR2024-00698, the Board should exercise its discretion and deny

institution in this proceeding because Petitioner has not shown that this is one of the "rare" instances where two petitions are needed. Petitioner offers no persuasive reason for this Petition; its arguments make clear that they wanted to have the "backup" grounds in case the grounds of one of the petitions fail. Indeed, the two petitions challenge the same five claims of the '767 Patent, simply with different primary references.

Under 35 U.S.C. § 314(a), the Board has discretion to deny institution of IPR. *See, e.g.*, *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018). When a petitioner opts to file two parallel petitions on the same patent, as Petitioner as done here, the Board considers the following guidance in the November 2019 Consolidated Trial Practice Guide ("CTPG"):

> Based on the Board's experience, ***one petition should be sufficient*** to challenge the claims of a patent in most situations. ***Two or more petitions filed against the same patent*** at or about the same time (e.g., before the first preliminary response by the patent owner) may place a ***substantial and unnecessary burden*** on the Board and the patent owner and could raise ***fairness, timing, and efficiency concerns***. In addition, multiple petitions by a petitioner are not necessary in the vast majority of cases. To date, a substantial majority of patents have been challenged with a single petition.

CTPG at 59 (emphasis added). If a petitioner opts to file two or more parallel petitions concerning the same patent:

> [That] petitioner should … identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, 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 if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a).

Id. at 59-60. However, the CTPG emphasizes that, although there may be "cases [in which] ***two petitions*** by a petitioner may be needed, … this ***should be rare***." *Id.* at 59 (emphases added).

Here, Petitioner filed two petitions, IPR2024-00697 and IPR2024-00698 that each challenge the same five claims, with the only material difference being that IPR2024-00697 presents grounds based upon combinations with the primary reference Shahoian, and IPR2024-00698 presents grounds based upon combinations with the primary reference Izumi.

Petitioner filed the same Petitioner's Notice Ranking and Explaining Material Differences Between Petitions ("Ranking Notice") as Paper 3 in IPR2024-00697 and as Paper 2 in IPR2024-00698, ranking IPR2024-00697 above IPR2024-00698. To the extent that the Board institutes review of

IPR2024-00697, institution of IPR2024-00698 should be denied as an unnecessary parallel petition. Petitioner asserts that this is a case where two petitions are appropriate, but none of the reasons provided by Petitioner demonstrate that is so.

First, these IPRs do not present either of the circumstances that the CTPG gives as examples of when more than one petition might be necessary: "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." CTPG at 59.

The '767 patent only has five claims, only one of which is independent. This is an unusually small number of claims, not one of the "rare" cases where more than one petition might be necessary due to the number of claims. The Board has previously held that a "Petitioner's contention that 20 claims is a quantum of claims that could not addressed in a single petition strains credulity." *Apple, Inc. v. Koss Corp.*, IPR2021-00686, Paper 12 at 13 (PTAB Oct. 12, 2021). Indeed, "[t]he Board routinely receives petitions challenging more than 18 claims," and "the basic filing fee for an *inter partes* review contemplates challenging up to 20 claims." *Id.* (citing 37 C.F.R. § 42.15(a)(2)-(3)).

Petitioner also does not suggest that there is any dispute about priority date requiring arguments under multiple prior art references. Indeed, both primary prior art references Shahoian and Izumi are § 102(b) prior art references based upon the earliest provisional patent application the '767 patent claims priority to. IPR2024-00697, Paper 2 at 2; IPR2024-00698, Paper 3 at 2. With the exception of the Aldrich reference used as a secondary reference in each petition, each of the prior art references is a U.S. patent or published patent application, meaning that little space in the petitions needed to be devoted to establishing when they were published.

Petitioner's principal argument in favor of the parallel petitions is that the primary references Shahoian and Izumi are directed to different "applications" ("haptic" applications and shaver applications, respectively). Ranking Notice at 3–4. As a result, Petitioner contends that the combinations with secondary references and the motivations to combine are "materially different." *Id.* But to allow parallel petitions simply because the prior art is "materially different" would create an exception that swallows the rule. For virtually every patent, there will be more than one primary prior art reference that a petitioner could construct a validity challenge around. A petitioner seeking to file parallel petitions will almost always want to present different prior art, raising at least "materially different" issues in the two petitions, because filing

two petitions that rise or fall on exactly the same set of issues would be a wasted effort. Accepting this rationale for parallel petitions is entirely inconsistent with the CTPG's instruction that such parallel petitions should be "rare." CTPG at 59.

Petitioner also suggests that both petitions are necessary "to show the breadth of prior art that reads on the overly broad claims." Ranking Notice at 4. Breadth of claims is not, by itself, a reason to invalidate a claim or to institute an IPR. (Purportedly) broad claims must be invalidated the same way as any other claims, by demonstrating the existence of prior art that anticipates them or renders them obvious. If anything, purported breadth of claims should weigh against parallel petitions. For truly overbroad claims, with a breadth of invalidating prior art, it should be possible to find one reference, or perhaps a combination of two, that satisfies those claims in a straightforward way. Purported breadth is not a justification for submitting 27,942 words of petitions to challenge just one independent claim and four dependent claims.

Petitioner further suggests that the existence of "means-plus-function" issues justifies multiple petitioners. Ranking Paper at 4. But the case that Petitioner cites is highly distinguishable. *DJI Europe BV v. Daedulus Blue LLC.*, IPR2020-01474, Paper 15 (PTAB Feb. 12, 2021). There, there were 12 claims asserted in litigation, with the challenged claims containing "**42 limitations**

in means-plus-function format, requiring claims construction pursuant to 37 C.F.R. § 42.104(b)(3).” *Id.* at 10 (emphasis in original). The issue was thus not the mere existence of means-plus-function limitations, but the very large number of them, each requiring its own claim construction discussion under the Board’s rules.

Here, there are only five claims at issue. There are only two terms that Petitioner proposes be construed, only one of which is even disputed between the parties. Paper 2 at 4–10. The entire claim construction discussion in each petition is only six pages long, less than 10 percent of each petition. IPR2024-00697, Paper 2 at 4–10; IPR2024-00698, Paper 3 at 4–10. Given the large number of patents with means-plus-function claims, particularly following the Federal Circuit’s decision in *Williamson v. Citrix*, it is not exceptional for an IPR petition to need to address the construction of two claim terms, both of which (the petition contends) are means-plus-function. It would not be consistent with the CTPG’s instruction that parallel petitions be “rare” to allow them whenever a patent has a modest number of terms that the petitioner contends are means-plus-function.

Because the IPR2024-00697 and IPR2024-00698 petitions do not present one of the “rare” circumstances where multiple petitions challenging the same patent are justified, the Board should decline to institute both petitions.

VII. CONCLUSION

For the reasons set forth above, the Board should exercise its discretion to deny institution of this IPR, either on *Fintiv* grounds or on the ground that it is an unjustified parallel petition.

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CERTIFICATE OF WORD COUNT

I certify that there are 4,913 words in this paper, excluding the portions exempted under 37 C.F.R. § 42.24(a)(1), according to the word count tool in Microsoft Word.

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CERTIFICATE OF SERVICE

I hereby certify that "Patent Owner's Preliminary Response" was served on July 25, 2024 by email sent to:

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