

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC. and AMAZON.COM SERVICES LLC,
Petitioner,

v.

NOKIA TECHNOLOGIES OY,
Patent Owner.

Case No. IPR2024-00798
Patent. No. 9,743,602

PATENT OWNER'S PRELIMINARY RESPONSE

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2001	Declaration of Franco Lodato
2002	<i>Curriculum Vitae</i> of Franco Lodato
2003	Motorola SLVR L7 Full Phone Specifications (Wayback Machine 2006) https://web.archive.org/web/20060110072607/http://www.gsmaarena.com:80/motorola_slvr_l7-1053.php
2004	Motorola SLVR L7 Pictures (Wayback Machine 2006) https://web.archive.org/web/20060111091533/http://gsmaarena.com:80/motorola_slvr_l7-pictures-1053.php
2005	Motorola SLVR L7 – Mobile Phone Museum https://mobilephonemuseum.com/phone-detail/motorola-slvr-l7

I. INTRODUCTION

Amazon.com, Inc. and Amazon.com Services LLC, (“Petitioner” or “Amazon”) petitioned for *inter partes* review of claims 1-36 (“Challenged Claims”) of U.S. Patent No. 9,473,602 (the “’602 Patent”), which is owned by Nokia Technologies Oy (“Patent Owner” or “Nokia”). Each of Petitioner’s three grounds of unpatentability fail because the cited references do not qualify as prior art. The Board should deny institution.

In its failed attempt to demonstrate that the cited references, McClure-997 and McClure-998, are prior art to the ’602 Patent, Petitioner argues that the ’602 Patent is not entitled to its earliest priority date because “the specification is directed to a flip-phone where the camera is in the second (top) section,” and “does not contain written description for a camera located in the same section or housing as the battery, engine, and user input section.” Petition, p. 12. But this is simply not true, the specification is not limited to flip-phones. Indeed, the ’602 Patent discloses and Petitioner does not address, that an example one-piece housing is disclosed with respect to FIGS. 11-13 and “[t]he configurations shown in FIGS. 11-13 could be used in candy-bar style telephone handsets as well as flip-phone style handsets.” Ex. 1001, 5:58-60. None of this disclosure is addressed by Petitioner nor its expert.

Worse still, Petitioner spends less than six pages of the Petition advancing conclusory arguments attacking the priority date of the ’602 Patent, fatally failing to

address multiple explicit disclosures in the originally-filed specification that conveyed to the POSITA that the inventor had possession of the claimed invention. Petitioner thus fails to demonstrate that the originally-filed application does not provide written description support for the claimed invention of the '602 Patent.

Because Petitioner fails to demonstrate that the '602 Patent is not entitled to a priority date at least before the effective filing dates of McClure-997 and McClure-998, Petitioner fails to demonstrate that McClure-997 and McClure-998 are prior art to the '602 Patent. Grounds 1-3 fatally rely on McClure-997 and McClure-998, thus Petitioner has failed to demonstrate that any challenged claim is unpatentable.

Accordingly, Patent Owner requests that the Board deny institution of *inter partes* review.

II. BACKGROUND

A. Overview of the '602 Patent

The '602 Patent is titled “Portable Electronic Device,” and is generally directed to a “form factor configuration of a portable electronic device.” Ex. 1001, Cover, 1:18-21; Ex. 2001, ¶51.

The '602 Patent recognized a desire at the time for “[u]ltra thin telephone products,” and an emphasis on “mechanical thickness, allowing the feature set and industrial design to be adjusted to suit this goal.” Ex. 1001, 1:23-34; Ex. 2001, ¶52. The '602 Patent emphasized “maintain[ing] aesthetic balance in proportions” and

“allow[ing] added thickness to avoid a ‘squeezed appearance.’” Ex. 1001, 1:35-39; Ex. 2001, ¶52.

The ’602 Patent addressed the technological limitations associated with devices at the time by presenting several embodiments of a “portable electronic device” in which different configurations provide for a reduction in thickness of the portable electronic device. Ex. 2001, ¶53.

The ’602 Patent presents solutions to the technical problem of reducing thickness in a handheld device by providing for unique configurations of an engine section, a battery, and a user input section. Ex. 2001, ¶54. One example device in the ’602 Patent is a “flip-phone type of telephone comprising a first section 12 connected to a second section 14,” however the ’602 Patent explains that “features of the invention could be used in other types of portable electronic devices, such as a PDA or a hand-held gaming device.” Ex. 1001, 2:60-67; Ex. 2001, ¶54. The ’602 Patent also discloses that “[t]he configurations shown in FIGS. 11-13 could be used in candy-bar style telephone handsets as well as flip-phone style handsets.” Ex. 1001, 5:58-60. Ex. 2001, ¶54.

The ’602 Patent also notes that “the invention can be embodied in many alternate forms of embodiments,” and “[i]n addition, any suitable size, shape or type of elements or materials could be used.” Ex. 1001, 2:52-59; Ex. 2001, ¶55.

The '602 Patent discloses a “first housing member 28,” an “engine 30,” a “battery 32,” and a “user input section 34,” where the “first housing member 28 generally comprises a one-piece tubular member,” which “could be formed from an extruded member with holes punched into it after it is extruded.” Ex. 1001, 3:27-36, FIG. 7; Ex. 2001, ¶56. The '602 Patent discloses that the “user input section generally comprises keymats 50, an EL backlight foil 52, a keymat dome sheet 54 and a keymat stiffener 56,” and “in alternate embodiments, any suitable user input section could be provided.” Ex. 1001, 3:54-62; Ex. 2001, ¶57.

The “engine 30 generally comprises a printed circuit board, a transceiver, a processor, and a memory, among other components,” where a “width of the engine 30 is only about less than half the width 22 of the telephone.” Ex. 1001, 3:63-67, FIG. 8; Ex. 2001, ¶58.

The '602 Patent depicts a “battery 32 [] located adjacent the lateral side of the engine 30 and is also about less than half the width 22 of the telephone.” Ex. 1001, 3:67-4:2; Ex. 2001, ¶59. The '602 Patent underscores the benefits of this unique configuration, stating that, “[u]nlike conventional telephones which have the engine located above the battery, the configuration of the side-by-side engine/battery allows the battery and the engine to have a practical design thickness and still provide a reduced thickness 24 as compared to conventional flip-phones.” Ex. 1001, 4:2-10; Ex. 2001, ¶59.

Underscoring its focus on solving the problem of device thickness by way of providing a unique configuration of the battery, engine, and user input section, the '602 Patent depicts, in FIG. 13, a configuration where the “battery 130 is about half the width of the tubular housing member 132,” and the “engine 134 comprises a portion 136 located at the lateral side of the battery 130 and another portion 138 located between the battery and the keypad 140.” Ex. 1001, 5:53-58. Ex. 2001, ¶60. The '602 Patent describes, with reference to FIGS. 11-13, a “one-piece metal tubular housing member 118” housing “components 112 [battery], 114 [engine], and 116 [keypad].” Ex. 1001, 5:42-48; Ex. 2001, ¶60.

The '602 Patent also provides that its disclosed configurations “could be used in candy-bar style telephone handsets as well as flip-phone style handsets.” Ex. 1001, 5:58-60; Ex. 2001, ¶61. The '602 Patent provides an example of a candy bar style telephone handset, stating that “[c]andy-bar shaped mobile phones can have smaller thicknesses, such as the Motorola SLIVR...” Ex. 1001, 1:31-33; Ex. 2001, ¶61.

The '602 Patent emphasizes that “the side-by-side positioning of the battery/engine can further allow a reduction in thickness of the handset versus conventional stacked battery/engine handsets.” Ex. 1001, 6:1-4; Ex. 2001, ¶62. Therefore, the '602 Patent disclosed a novel and thinner structure than previously

known or used, which resulted in improved thickness reduction over prior systems.
Ex. 2001, ¶62.

B. Prosecution History

U.S. Patent Application No. 14/612,712 (“the ’712 application”) was filed February 3, 2015, as a continuation in a family of U.S. Patent Application No. 14/067,249 (“the ’249 application,” now U.S. Patent No. 8,953,780) filed October 30, 2013, U.S. Patent Application No. 13/741,781 (“the ’781 application,” now U.S. Patent No. 8,615,077) filed January 15, 2013, U.S. Patent Application No. 12/860,234 (“the ’24 application,” now U.S. Patent No. 8,363,824) filed August 20, 2010, and U.S. Patent Application No. 11/393,510 (“the ’510 application,” now U.S. Patent No. 7,787,618) filed March 29, 2006. Ex. 1002, pp. 2-67; Ex. 2001, ¶63.

Claim 15 of the ’510 application was not limited to a flip-phone configuration, as it recited:

A mobile telephone, comprising:
an engine section comprising a printed circuit board, a transceiver, a processor and a memory;
a battery located adjacent the engine section; and
a user input section comprising a keypad located above the engine section and the battery, wherein the user input section is located directly opposite the battery without a portion of the engine section therebetween.

Ex. 1010, p. 23; Ex. 2001, ¶64.

The '712 application was filed with original claims 1-24, along with a preliminary amendment canceling claims 1-24 and presenting new claims 25-42. Ex. 1002, pp. 20-23, 52-57; Ex. 2001, ¶65. Claim 25 recited “a user input section located above the engine section and a battery, wherein the user input section is located adjacent the battery and the engine section.” *Id.*

A Non-Final Office Action dated September 24, 2015, indicated that the “application [was] being examined under the pre-AIA first to invent provisions,” evidencing that the Examiner afforded the '712 application its original priority date of March 29, 2006. Ex. 2001, ¶66. The Non-Final Office Action included double patenting and antecedent basis rejections. Ex. 1002, pp. 80-85. In response, the Applicant amended the claims to replace “apparatus” in the preamble with “portable electronic device,” and to replace “a hole through a front side of the housing” in the independent claims with “an opening between said exterior lateral sides of said one piece housing of the portable electronic device.” Ex. 1002, pp. 80-85, 103-112; Ex. 2001, ¶67. The Applicant also added claims 43-60, including additional “portable electronic device” dependent claims and a set of claims directed to a “mobile phone.” *Id.* The Applicant asserted that the amendments overcame the double patenting rejections over U.S. Patent No. 8,953,780 and the indefiniteness rejections. *Id.*

A Final Office Action dated March 31, 2016, also indicated that the application was being examined under the pre-AIA first to invent provisions,

further evidencing that the Examiner afforded the '712 application its original priority date of March 29, 2006. Ex. 2001, ¶68. The Final Office Action included double patenting rejections over U.S. Patent No. 8,953,780. Ex. 1002, pp. 667-676. The Final Office Action also included rejections of claims 36, 37, and 40 under pre-AIA 35 U.S.C. § 102(b) over “applicant’s cited reference US 2004/0252220 (Oda et al hereinafter Oda).” *Id.* The Examiner also rejected claims 36, 37, 40 and 41 under pre-AIA 35 U.S.C. § 102(b) over “applicant’s cited reference JP 2002-125031 (Hiroshi).” *Id.* The Examiner also rejected claims 38, 39 and 42 as unpatentable under pre-AIA 35 U.S.C. § 103(a) over Oda US Pub or Hiroshi. *Id.* These references have publication dates in 2002 and 2004, further evidencing that the Examiner afforded the '712 application its original priority date of March 29, 2006. Ex. 2001, ¶68.

The Applicant responded with a terminal disclaimer over U.S. Patent 8,953,780 (*see* Ex. 1002, 703), and amended claim 36 to include:

wherein the battery and engine section are configured to be housed in the housing section such that the user input section is located above the engine section and the battery, and wherein the user input section is located adjacent the battery and the engine section.

Ex. 1002, p. 694. The Applicant pointed to paragraph [0028] of the originally-filed specification as well as Figs. 7-8 for support for the amendment. Ex. 1002, p. 700;

Ex. 2001, ¶69. Paragraph [0028] of the originally-filed Specification, which corresponds to column 4 lines 2-7 of the issued patent, states:

Unlike conventional telephones which have the engine located above the battery, the configuration of the side-by-side engine/battery allows the battery and the engine to have a practical design thickness and still provide a reduced thickness 24 as compared to conventional flip-phones.

Ex. 1002, p. 46, ¶[0028]. The Applicant distinguished over the references by relying on the amended claim language, arguing that “there is no teaching or disclosure in Oda to provide the battery and engine section to be housed in the housing such that the user input section is located *above the engine section and the battery*, and wherein the user input section is located *adjacent the battery and the engine section*.” Ex. 1002, p. 700 (emphasis added); Ex. 2001, ¶69. The Applicant also argued that Hiroshi failed to provide such a teaching or disclosure. Ex. 1002, p. 701. Ex. 2001, ¶69. In light of the amendment and argument, a Notice of Allowance was mailed June 15, 2016. Ex. 1002, pp. 710-734; Ex. 2001, ¶70.

III. PERSON OF ORDINARY SKILL IN THE ART (POSITA)

Patent Owner contends that a person of ordinary skill in the art (“POSITA”) for the ’602 Patent would have had either (1) a bachelor of science in industrial design or mechanical engineering and three years of experience designing mobile phones or (2) a master of science in industrial design or mechanical engineering and

two years of experience in designing mobile phones. Ex. 2001, ¶24. A person with a different degree but with additional relevant experience could still qualify if the additional experience compensates for the different educational background. *Id.* A person with less experience designing mobile phones could still qualify if the person has additional education that compensates for their lesser experience. *Id.*

While Petitioner provides a slightly different definition of a POSITA for the '602 Patent, Patent Owner does not believe the differences in the definition of a POSITA impact the issues presented herein for the purposes of Institution. *See* Petition, p. 16. As such, while Patent Owner reserves all rights to challenge Petitioner's definition of the POSITA in this proceeding, for the purposes of Institution, Patent Owner does not dispute Petitioner's definition.

IV. CLAIM CONSTRUCTION

Petitioner contends that the claims should be construed "in accordance with the ordinary and customary meaning of such claim as understood by a POSITA." Petition, p. 16. While Patent Owner agrees that the claims should be construed according to the ordinary and customary meaning as understood by a POSITA, Patent Owner also reserves the right to address construction of any terms if this proceeding is instituted and/or in any other action involving the '602 Patent. Ex. 2001, ¶73.

Petitioner also proposed constructions for the “housing...” limitations. Petition, p. 17. The Board need not resolve the proper construction of the “housing...” limitations for the purposes of institution because Patent Owner demonstrates that institution should be denied regardless of any construction of the “housing...” limitations. Ex. 2001, ¶73. Indeed, Petitioner does not dispute that “housing” is disclosed in the original application. Patent Owner also reserves the right to address construction of the “housing...” limitations if this proceeding is instituted and/or in any other action involving the ’602 Patent. Ex. 2001, ¶73.

V. THE BOARD SHOULD NOT INSTITUTE *INTER PARTES* REVIEW

A. Petitioner Has Failed to Establish a Reasonable Likelihood that Any Challenged Claim Is Unpatentable under 37 C.F.R. § 42.108(c).

Petitioner has failed to meet its obligations with respect to the challenged claims in the Petition. Pursuant to 37 C.F.R. § 42.108(c), Petitioner must demonstrate a reasonable likelihood “at least one of the claims challenged in the petition is unpatentable” to warrant institution of an *inter partes* review for that claim. Petitioner has not done so.

All three of Petitioner’s grounds rely on the Petitioner’s flawed conclusion that the ’602 Patent is not entitled to a priority date before the effective filing dates of McClure-997 and McClure-998. Petition, pp. 12-13. Both Petitioner and its expert, Dr. Visser, fail to demonstrate that the originally-filed specification of the

'602 Patent would not have reasonably conveyed to the POSITA that the inventor had possession of the claimed invention of the '602 Patent at least as of March 29, 2006.¹ Indeed, Franco Lodato, Patent Owner's expert, explains in detail why the originally-filed specification of the '602 Patent, which discloses one-piece housings having cameras and other components therein and the application of such one-piece housings to PDAs, hand-held gaming devices, and candy-bar style form factors, reasonably conveyed to the POSITA that the inventor had possession of the claimed invention of the '602 Patent. Ex. 2001, ¶¶78, 80. Moreover, even the originally-filed claims of the application filed March 29, 2006, did not limit the invention to a flip-phone housing, contrary to Petitioner's assertions. *See, e.g.*, Ex. 1010, p. 23 (Cl. 15).

Because the '602 Patent is entitled to its earliest priority date of March 29, 2006, and because McClure-997 and McClure-998 were filed in 2011 and published in 2012, McClure-997 and McClure-998 do not qualify as prior art to the '602 Patent.

All of Petitioner's grounds rely on one or both of McClure-997 and McClure-998 for alleged teachings of the limitations of the independent claims and most of the dependent claims of the '602 Patent. Because neither McClure-997 nor McClure-

¹ Neither Petitioner nor its expert address the disclosed PDAs, hand-held gaming devices, and candy-bar style form factors.

998 qualifies as prior art to the '602 Patent, Petitioner has failed to demonstrate a reasonable likelihood that at least one of the challenged claims is unpatentable.

1) The '602 Patent is entitled to the benefit of the filing date of March 29, 2006.

Petitioner asserts that the “shared specification”² of the '602 Patent with “an Original Application filed March 29, 2006” “does not provide written description support for any claims of the '602 Patent.” Petition, p. 9. Petitioner’s assertion fails.

Under 35 U.S.C. § 120, a patent claim is entitled to the benefit of the filing date of a prior-filed application if the original disclosure of the prior-filed application provides written description support for the patent claim as required by 35 U.S.C. § 112, first paragraph. *In re NTP, Inc.*, 654 F.3d 1268, 1276–77 (Fed. Cir. 2011).

² Patent Owner refers to the '602 Patent herein because there is no dispute from Petitioner and Dr. Visser that the '602 Patent shares a specification with the ultimate parent application that resulted in the '618 Patent. In addition, Patent Owner provides references to both the specification of the '602 Patent as well as the originally-filed application that resulted in the '618 Patent (to which the '602 Patent claims priority), which is contained in the file history in Ex. 1010, to demonstrate that the originally-filed application provides written description support for the claimed invention of the '602 Patent.

“[T]he test for sufficiency is whether the specification reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *In re Glob. IP Holdings LLC*, 927 F.3d 1373, 1377 (Fed. Cir. 2019) (internal quotes omitted) (quoting *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010)). “In addition, the parent application need not state the exact same language, or limitation, that is recited and claimed in the later filed application.” *Propel Orthodontics LLC v. Orthoaccel Technologies, Inc.*, IPR2018-00296, Paper 36, 13 (Jun. 10, 2019) (citing *Union Oil Co. of California v. Atl. Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000)); *see also* *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (“[T]o satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.”). Whether a claimed invention is supported by an adequate written description under 35 U.S.C. § 112 is a question of fact. *In re Owens*, 710 F.3d 1362, 1366 (Fed. Cir. 2013).

Because a patent specification is written for a POSITA, and the POSITA comes with the knowledge of what has come before, it is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a POSITA that the inventor possessed the invention and to enable such a person to make and use the invention without undue experimentation. *See Lizardtech, Inc. v. Earth Resource Mapping*, 424 F.3d 1336, 1345 (Fed. Cir. 2005);

see also In re GPAC Inc., 57 F.3d 1573, 1579 (Fed. Cir. 1995); *see also Union Oil Co. v. Atl. Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000) (holding that a claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language).

Here, through a series of continuations, the '602 Patent claims priority to U.S. Patent Application No. 13/741,781, filed on January 15, 2013 (now U.S. Patent 8,615,077)), U.S. Patent Application No. 12/860,234, filed on August 20, 2010 (now U.S. Patent 8,363,824) and U.S. Patent Application No. 11/393,510, filed on March 29, 2006 (now U.S. Patent 7,787,618 (Exhibit 1009)). The thrust of Petitioner's argument is that none of those applications supports "a one-piece housing for the camera, battery, engine, and user input." Petition, pp. 10-14. However, as evidenced by explicit disclosure in the '602 Patent (which shares a specification with all of the applications³) and confirmed by Franco Lodato, each of these applications discloses one-piece housings and the inclusion of each of the claimed features within PDAs, hand-held gaming devices, and candy-bar style form factors. *See, e.g.*, Ex. 1001,

³ Petitioner's expert agrees that all patents in this chain of continuations share the same specification, with the exception of cross-references to related applications. Ex. 1003, ¶19.

5:42-48 (“The components 112, 114, 116 are housed in a one-piece metal tubular housing member 118.”); Ex. 1001, 2:61-64 (“...features of the invention could be used in other types of portable electronic devices, such as a PDA...”); Ex. 1001, 5:58-60 (“The configurations shown in FIGS. 11-13 could be used in candy-bar style telephone handsets as well as flip-phone style handsets.”); Ex. 1010, p. 18, ¶[0035] (“The components 112, 114, 116 are housed in a one-piece metal tubular housing member 118.”); Ex. 1010, p. 12, ¶[0023] (“However, in alternate embodiments, features of the invention could be used in other types of portable electronic devices, such as a PDA or a hand-held gaming device, for example.”); Ex. 1010, pp. 18-19, ¶[0036] (“The configurations shown in Figs. 11-13 could be used in candy-bar style telephone handsets as well as flip-phone style handsets.”); Ex. 2001, ¶80. Indeed, not even the originally-filed claims limited the invention to a flip-phone configuration. *See, e.g.*, Ex. 1010, p. 23 (Cl. 15).

Given that the specification discloses one-piece housings having cameras and other components therein and the application of such one-piece housings to PDAs, hand-held gaming devices, and candy-bar style form factors, the POSITA would have understood that the inventor had possession of the claimed invention. Ex. 2001, ¶¶78, 80.

Petitioner’s assertion is therefore flawed. Worse still, Petitioner’s allegations overlook explicit disclosure in the “Original Application” regarding one-piece

housings having cameras and other components therein and the application of such one-piece housings to PDAs, hand-held gaming devices, and candy-bar style form factors that reasonably conveyed to a POSITA that the inventor had possession of the claimed invention. Ex. 2001, ¶80. The conclusory analysis advanced by Petitioner and its expert, Dr. Visser, which overlooks explicit disclosure in the originally-filed application that provided written support for the claimed invention of the '602 Patent, is insufficient to demonstrate lack of written description. *See Koito Mfg. Co. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1155 (Fed. Cir. 2004) (finding expert's conclusory testimony which ignores disclosed embodiment is insufficient to show failure of written description).

a) The originally-filed specification of the '602 Patent reasonably conveyed to a POSITA that the inventor had possession of the claimed invention at least as of March 29, 2006.

Both Petitioner and Dr. Visser advance a naked assertion that “[s]ince the specification is directed to a flip-phone where the camera is in the second (top) section, the specification does not contain written description for a camera located in the same section or housing as the battery, engine, and user input section.” Petition, 12; Ex. 1003, ¶23. Petitioner and its expert appear to be laser focused on the alleged flip phone embodiment in the specification and fatally overlook that the originally-filed specification explicitly discloses one-piece housings having cameras

and other components therein and the application of such one-piece housings to PDAs, hand-held gaming devices, and candy-bar style form factors. Ex. 2001, ¶80.

The '602 Patent contains written description support for the claims of the '602 Patent because the originally-filed specification of the '602 Patent reasonably conveyed to the POSITA that the inventor had possession of the claimed invention of the '602 Patent. Ex. 2001, ¶78.

Specifically, and ignored by Petitioner and Dr. Visser, the '602 Patent explains that “[t]he components 112, 114, 116 are housed in a one-piece metal tubular housing member 118.” Ex. 1001, 5:43-45; Ex. 1010, p. 18, ¶[0035]. In addition, the specification discloses that the disclosed one-piece housing comprises cameras. *See* Ex. 1001, 4:52-55; Ex. 1010, p. 16, ¶[0031]. Indeed, the '602 Patent discloses one-piece housings having cameras therein and other components and the application of such one-piece housings to PDAs, hand-held gaming devices, and candy bar style form factors. Ex. 2001, ¶80.

Specifically, the '602 Patent states the “features of the invention could be used in other types of portable electronic devices, such as a PDA or a hand-held gaming device.” Ex. 1001, 2:60-67; Ex. 2001, ¶80; Ex. 1010, p. 12, ¶[0023] (“However, in alternate embodiments, features of the invention could be used in other types of portable electronic devices, such as a PDA or a hand-held gaming device, for example.”). The '602 Patent also discloses that “[t]he configurations shown in FIGS.

11-13 could be used in candy-bar style telephone handsets as well as flip-phone style handsets.” Ex. 1001, 5:58-60. Ex. 2001, ¶80; Ex. 1010, pp. 18-19, ¶[0036] (“The configurations shown in Figs. 11-13 could be used in candy-bar style telephone handsets as well as flip-phone style handsets.”). The ’602 Patent also notes that “the invention can be embodied in many alternate forms of embodiments,” and “[i]n addition, any suitable size, shape or type of elements or materials could be used.” Ex. 1001, 2:52-59; Ex. 2001, ¶101; Ex. 1010, p. 12, ¶[0022] (“the invention can be embodied in many alternate forms of embodiments...any suitable size, shape or type of elements or materials could be used.”).

Because the POSITA was familiar with PDA and candy-bar form factors that had a housing for all of its included components (e.g., camera, input section, engine, battery, etc.) and the originally-filed specification discloses components (e.g., camera, input section, engine, battery, etc.) housed in a one-piece housing and applied to PDA and candy-bar form factors, the originally-filed specification of the ’602 Patent contains written description support for the claimed invention of the ’602 Patent. *See Capon v. Eshhar*, 418 F.3d 1349, 1359 (Fed. Cir. 2005) (cited with approval in *Ariad*, 598 F.3d at 1352) (A court may consider “the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the science or technology, [and] the predictability of the aspect at issue.”); *see also Boston Sci. Corp. v. Johnson & Johnson*, 647 F.3d 1353, 1366 (Fed. Cir. 2011)

(holding that because the assessment for written description is made from the perspective of a person of ordinary skill in the art, in some instances, a patentee can rely on information that is “well-known in the art” to satisfy written description); Ex. 2001, ¶100.

In view of the disclosure of the originally-filed specification of the '602 Patent, Petitioner's assertion that the “specification is directed to a flip-phone where the camera is in the second (top) section,” and, as a result, “the specification does not contain written description for a camera located in the same section or housing as the battery, engine, and user input section,” is incorrect.

b) The originally-filed specification of the '602 Patent contains written support for “a one piece housing forming enclosed exterior lateral sides and a rear side,” “a cut out in the rear side of said housing,” and “a camera located in said housing and extending to said cut out at said rear side.”

Petitioner and Dr. Visser allege that there is no disclosure of “a camera that extends to a cutout of the housing that also includes the battery and engine section” in the originally-filed specification of the '602 Patent. Petition, p. 12; Ex. 1003, ¶23. But Petitioner's and Dr. Visser's allegation is based on their fundamental misunderstanding that the '602 Patent is limited to a flip phone form factor. In so doing, both Petitioner and Dr. Visser ignore disclosure related to PDAs and candy-bar phones that undercuts their position. Indeed, a POSITA would not have

considered the '602 Patent to be limited to flip phone form factors. Ex. 2001, ¶79. As such, Petitioner's challenge to priority fails.

i. The '602 Patent discloses a camera in a one-piece housing.

The '602 Patent discloses a camera that extends to a cutout in the rear side of a one-piece housing without limiting the housing to a particular device (e.g., flip phones). Ex. 2001, ¶83. Specifically, the '602 Patent discloses that “[t]he camera 70 extends to the rear side,” and “[t]he camera 70 is housed at an exterior side of the portable electronic device by a junction 98 of a cutout portion.” Ex. 1001, 5:15-19. Ex. 2001, ¶83; Ex. 1010, p. 17, ¶[0033] (“The camera 70 extends to the rear side 76 of the second section 14. The camera is housed at an exterior side of the portable electronic device by a junction 98 of a cutout portion...”). The '602 Patent further discloses “[b]y providing a projecting portion of the housing flush with the camera, this allows the rest of the telephone to have the reduced thickness 24, but still use a standard size camera.” Ex. 1001, 5:21-25; Ex. 2001, ¶83; Ex. 1010, p. 17, ¶[0033] (“By providing a projecting portion of the housing for the camera, this allows the rest of the telephone to have the reduced thickness 24, but still use a standard size camera.”).

The '602 Patent also discloses a one-piece housing having the claimed components. For example, “The components 112, 114, 116 are housed in a one-piece

metal tubular housing member 118.” Ex. 1001, 5:43-45; Ex. 1010, p. 18, ¶[0035]; Ex. 2001, ¶80. Indeed, a camera is disclosed as being in a “second housing member, which “preferably comprises a one-piece member having a general tubular shape.” Ex. 1001, 4:52-55; Ex. 1010, p. 16, ¶[0031]; Ex. 2001, ¶83.

While, in some examples, the components are described with regard to one-piece housing in the flip phone form factor, the '602 Patent, however, is not limited to a flip phone form factors as Petitioner asserts. In fact, the specification is clear that the disclosure is directed to other types of portable electronic devices, such as a PDA, a hand-held gaming device, and a candy-bar form factor. Ex. 1001, 2:60-67; Ex. 2001, ¶81; Ex. 1010, p. 12, ¶[0023] (“However, in alternate embodiments, features of the invention could be used in other types of portable electronic devices, such as a PDA or a hand-held gaming device, for example.”); Ex. 1001, 5:58-60. Ex. 2001, ¶¶80, 86; Ex. 1010, pp. 18-19, ¶[0036] (“The configurations shown in Figs. 11-13 could be used in candy-bar style telephone handsets as well as flip-phone style handsets.”).

ii. The 602 Patent discloses that the features of the invention could be used in a PDA form factor.

As a first example of explicit disclosure in the '602 Patent of a device that was not a flip phone, ignored by Petitioner and Dr. Visser, the '602 Patent states that, “in alternate embodiments, features of the invention could be used in other types of

portable electronic devices, such as a PDA or a hand-held gaming device, for example.” Ex. 1001, 2:61-64; Ex. 2001, ¶81; Ex. 1010, p. 12, ¶[0023] (“However, in alternate embodiments, features of the invention could be used in other types of portable electronic devices, such as a PDA or a hand-held gaming device, for example.”). The POSITA would have been familiar with devices referred to as PDAs (personal digital assistants), that PDAs were not flip-phones (which included multiple housings connected by a hinge) and generally included a housing for all of its components, such as a camera, screen, keyboard, a battery, thus the POSITA would have readily understood that a PDA was a device to which the teachings of a one-piece housing could be applied. Ex. 2001, ¶82. Accordingly, in view of the knowledge of the POSITA at the time and the disclosure in the ’602 Patent that the features of the invention could be applied to a PDA, the ’602 Patent reasonably conveyed to the POSITA the disclosed features of the claimed invention. Ex. 2001, ¶82.

Thus, the explicit disclosure in the ’602 Patent of a PDA and a one-piece housing having a camera that extends to a cutout in the rear side of the housing reasonably conveyed to the POSITA “a one piece housing forming enclosed exterior lateral sides and a rear side,” “a cut out in the rear side of said housing,” and “a camera located in said housing and extending to said cut out at said rear side.” Ex. 2001, ¶84.

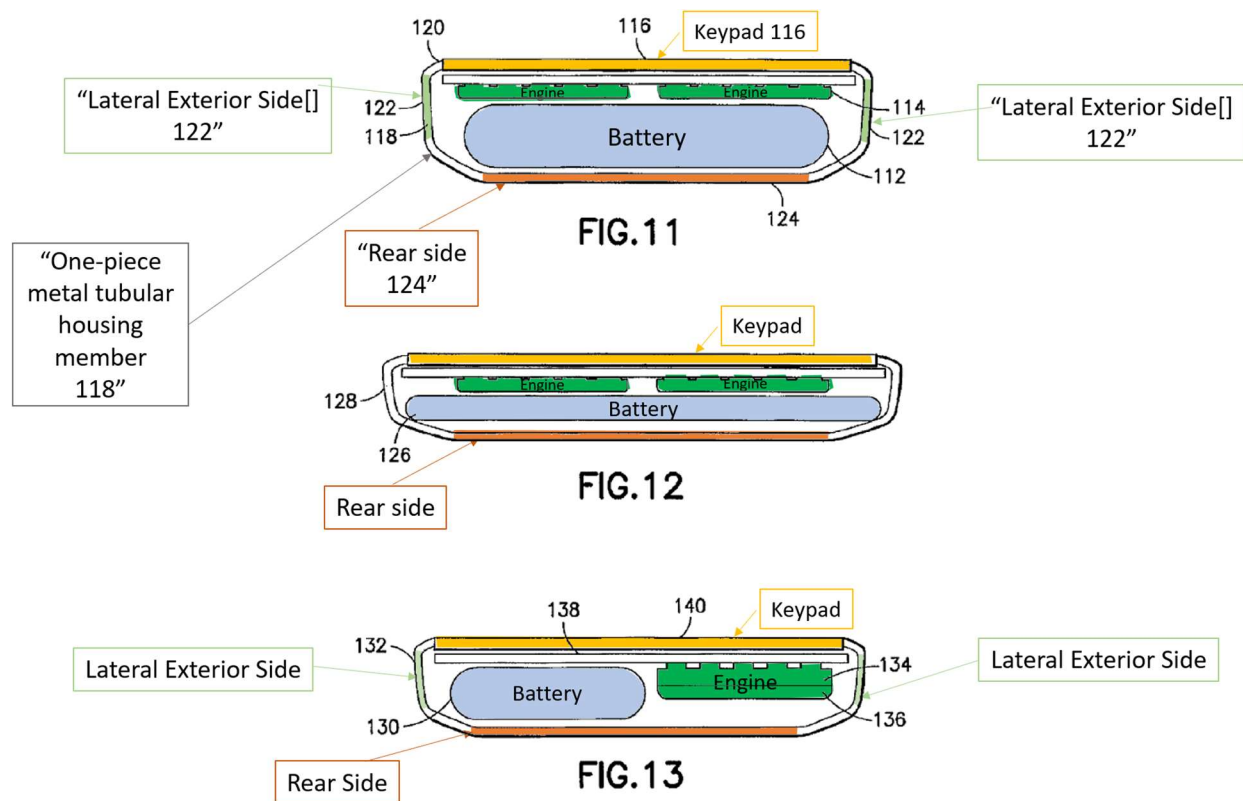
iii. The '602 Patent discloses that the features of the invention could be used in a candy-bar form factor.

But the '602 Patent did not just disclose a PDA, the '602 Patent provides another example stating that, “[t]he configurations shown in FIGS. 11-13 could be used in candy-bar style telephone handsets as well as flip-phone style handsets.” Ex. 1001, 5:58-60; Ex. 2001, ¶86; Ex. 1010, pp. 18-19, ¶[0036] (“The configurations shown in Figs. 11-13 could be used in candy-bar style telephone handsets as well as flip-phone style handsets.”). The POSITA would have been familiar with candy-bar style handsets and would have known that candy-bar style handsets had a housing for all of its included components (e.g., camera, input section, engine, battery, etc.). Ex. 2001, ¶87.

The '602 Patent also explicitly discloses a “one piece housing forming enclosed exterior lateral sides and a rear side” that is explicitly described as being used in the candy-bar form factor. *See* Ex. 1001, 5:58-60; Ex. 1010, p. 18, ¶[0036]; Ex. 2001, ¶95. The '602 Patent discloses, with reference to FIGs. 11-13 below, a “one-piece metal tubular housing member 118” housing “components 112 [battery], 114 [engine], and 116 [keypad].” Ex. 1001, 5:42-48; Ex. 2001, ¶95; Ex. 1010, p. 18, ¶[0035] (“The components 112 [battery], 114 [engine], 116 [keypad] are housed in a one-piece metal tubular housing member 118.”). The '602 Patent also explicitly states that the “keypad is located at a hole through the front side 120 of the housing

member 118,” and that the “housing member 118” “forms enclosed lateral exterior sides 122 and rear side 124.” *Id.*; Ex. 1010, p. 18, ¶[0035] (“The keypad is located at a hole through the front side 120 of the housing member 118. Otherwise, the housing member 118 forms enclosed lateral exterior sides 122 and rear side 124.”). Ex. 2001, ¶95.

Ex. 1001, FIGs. 11-13 (annotated); Ex. 1010, p. 32, FIGs. 11-13



The POSITA would have understood that the configurations shown in FIGs. 11-13 included the same features as FIGs. 1-10 but for a different arrangement of the battery and engine. Ex. 2001, ¶86; *see also* Ex. 1001, 5:40-41 (“FIGs. 11-13 show other alternate embodiments of positioning the battery relative to the engine.”);

Ex. 1010, p. 18, ¶[0035]. Moreover, once applied to the candy-bar form factor, the POSITA would have known that the components (e.g., camera, input section, engine, battery, etc.) would be in the same housing. Ex. 2001, ¶¶86, 92. That is, a POSITA would have understood the '602 Patent to be disclosing a one-piece housing member for housing components for its portable electronic device, and, because the '602 Patent explicitly states that the configurations of FIGS. 11-13 could be used in candy-bar style handsets (which the POSITA understood to have one housing for housing its components), the POSITA would have understood that the inventor had possession of the claimed invention. Ex. 2001, ¶¶86, 98.

Not only would the POSITA have been familiar with devices referred to as candy-bar style telephone handsets (*see* Ex. 2001, ¶87), the '602 Patent provides a specific example of a candy-bar style device, stating that “[c]andy-bar shaped mobile phones can have smaller thicknesses, such as the Motorola SLIVR...” Ex. 1001, 1:31-33; Ex. 2001, ¶88; Ex. 1010, p. 8, ¶[0002] (“Candy-bar shaped mobile phones can have smaller thicknesses, such as the Motorola SLIVR⁴ with a thickness of about

⁴ A POSITA would have understood the reference to “SLIVR” in the specification to be a typo, and that the reference was intended to be to a “SLVR.” Ex. 2001, ¶88, n4.

0.45 inch....”). An example Motorola SLVR from January 2006⁵ is depicted below, and confirms what the POSITA knew at the time – that a candy-bar style device included a housing for all of its components, such as a camera, screen, keyboard, a battery. Ex. 2001, ¶¶88-89.

Ex. 2003



The POSITA would have also known that the Motorola SLVR also had a camera extending to the rear side. Ex. 2001, ¶90. Thus, the POSITA would have understood that a camera was included in candy-bar form factors and would have also known that the camera extended out of the rear side of the housing. Ex. 2001, ¶¶90, 92.

⁵ While the SLVR was released in 2005, the image herein is from 2006.

Ex. 2005 (annotated)



Having a projecting portion of the housing specifically for the camera, rather than making the housing flush with the camera, is an example advantage that the POSITA would understand to apply to candy-bar phones and PDAs. Ex. 2001, ¶91. Moreover, in each description in the '602 Patent, the camera is described as being coupled to the engine and is proximate the display module and the speaker. Ex. 1001, 5:7-9 (“The display module 68, camera 70 and a speaker or sound transducer 88 are coupled to the engine 30 by a flex cable assembly 90 which extends through the hinge 16.”); Ex. 1010, p. 17, ¶[0032] (“The display module 68, camera 70 and a

speaker or sound transducer 88 are coupled to the engine 30 by a flex cable assembly 90 which extends through the hinge 16.”); Ex. 2001, ¶¶90-91. Likewise, in a candy-bar style device, the POSITA would have understood that components would have been coupled in the same manner. Ex. 2001, ¶¶90-91.

Because the ’602 Patent explicitly discloses a one-piece housing with cameras and discloses that such a configuration could be used in candy-bar style handsets, the POSITA would have known that, in a candy-bar form factor, the claimed camera would have likewise extended to a cutout in the rear side of the one-piece housing. Ex. 2001, ¶92.

In view of the knowledge of the POSITA at the time and the explicit disclosures related to cameras and one-piece housings, the disclosure in the ’602 Patent of candy-bar style telephone handsets, as well as the explicit disclosure of a camera extending to a cutout in the rear side of the housing, conveyed to the POSITA “a one piece housing forming enclosed exterior lateral sides and a rear side,” “a cut out in the rear side of said housing,” and “a camera located in said housing and extending to said cut out at said rear side.” Ex. 2001, ¶¶92, 94. The disclosure in the ’602 Patent of candy-bar style devices also conveyed to the POSITA that the ’602 Patent was not limited to flip phone form factors. Ex. 2001, ¶92.

iv. Petitioner and its expert overlook the disclosed form factors.

Dr. Visser and Petitioner fail to address the explicit disclosures in the '602 Patent of one-piece housings. In particular, Dr. Visser and Petitioner fail to provide any explanation as to why the disclosure in the '602 Patent that “in alternate embodiments, features of the invention could be used in other types of portable electronic devices, such as a PDA or a hand-held gaming device, for example,” does not explicitly or inherently disclose the subject limitations to the skilled artisan. Ex. 2001, ¶85. Dr. Visser and Petitioner also fail to provide any explanation as to why the disclosure in the '602 Patent that disclosed configurations “could be used in candy-bar style telephone handsets,” does not explicitly or inherently disclose the subject limitations to the skilled artisan. Ex. 2001, ¶¶93, 99, 101. This oversight by Petitioner is fatal to its case as Petitioner cannot now supplement its Petition to address this critical error. *See Koito Mfg. Co. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1155 (Fed. Cir. 2004) (finding expert’s conclusory testimony which ignores disclosed embodiment is insufficient to show failure of written description).

In view of the disclosure in the originally-filed specification of the '602 Patent, a POSITA would have readily understood that the inventor of the '602 Patent had possession of “a one piece housing forming enclosed exterior lateral sides and a rear side,” “a cut out in the rear side of said housing,” and “a camera located in said

housing and extending to said cut out at said rear side” at least as of March 29, 2006.

Ex. 2001, ¶100.

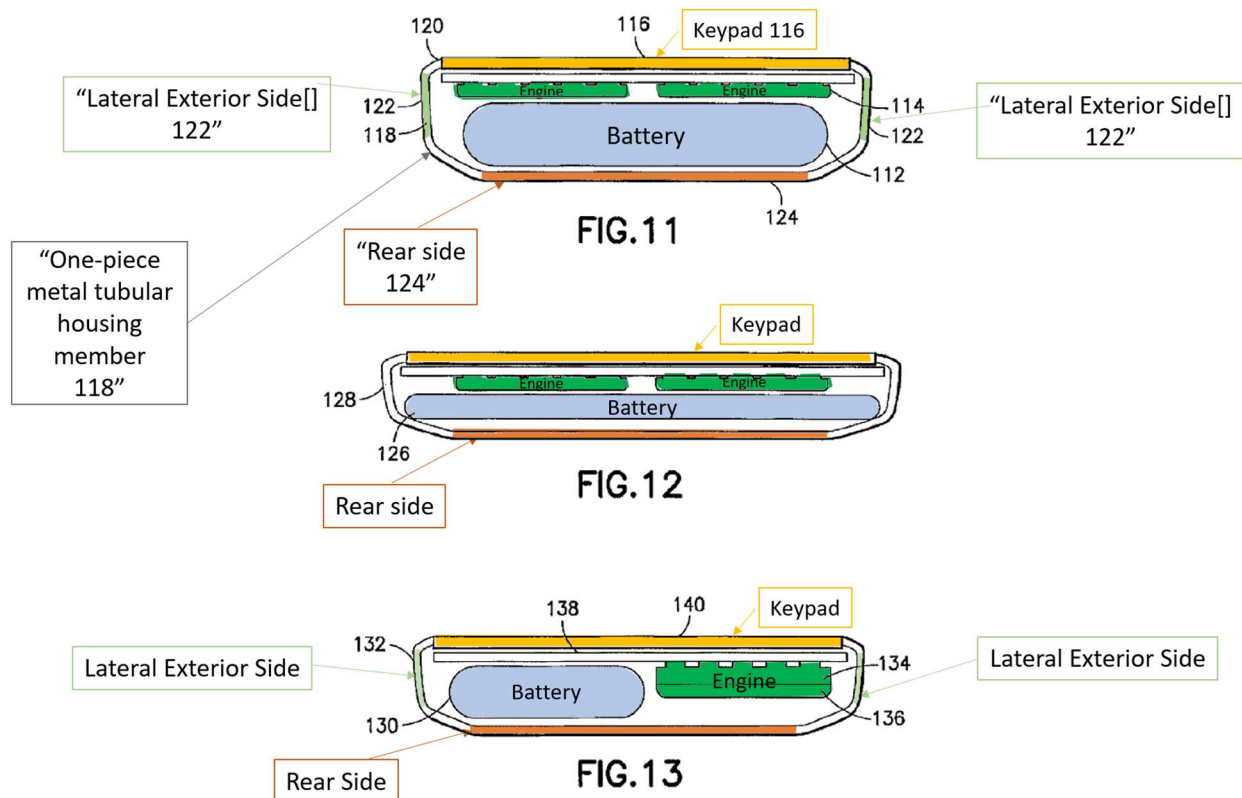
c) The originally-filed specification of the ’602 Patent contains written support for “wherein the battery and engine section are housed in the housing.”

Contrary to Dr. Visser’s statement that “there is no disclosure of a camera that extends to a cutout of the housing that also includes the battery and engine section” (*see* Ex. 1003, ¶25), the ’602 Patent discloses a one-piece housing that houses the components disclosed in the ’602 Patent, including the “engine section,” “battery,” “user input section,” and “camera.” *See* Ex. 1001, 1:51-2:15; Ex. 2001, ¶¶94-95; Ex. 1010, pp. 9-10, ¶[0006]; *see also* Section A.1.b, *supra*.

The ’602 Patent states that the “configurations shown in FIGS. 11-13 could be used in candy-bar style telephone handsets as well as flip-phone style handsets.” Ex. 1001, 5:58-60; Ex. 1010, pp. 18-19, ¶[0036]. As shown in FIGs. 11-13 below, the ’602 Patent explicitly discloses a “one-piece metal tubular housing member 118” housing that houses a battery 112, engine 114, and keypad 116. Ex. 1001, 5:42-48; Ex. 1010, p. 18, ¶[0035] (“The components 112 [battery], 114 [engine], 116 [keypad] are housed in a one-piece metal tubular housing member 118.”). The ’602 Patent also explicitly states that the “housing member 118” “forms an enclosed lateral exterior sides 122 and rear side 124” and that the “keypad is located at a hole through the front side 120 of the housing member 118.” *Id.*; Ex. 2001, ¶¶94-95; Ex.

1010, p. 18, ¶[0035] (“The keypad is located at a hole through the front side 120 of the housing member 118. Otherwise, the housing member 118 forms enclosed lateral exterior sides 122 and rear side 124.”). That is, the ’602 Patent explicitly discloses a one-piece housing with the battery and engine section housed within the one-piece housing. Ex. 2001, ¶¶95-96; *see also* Ex. 1001, 5:58-60 (“The configurations shown in FIGS. 11-13 could be used in candy-bar style telephone handsets as well as flip-phone style handsets.”); Ex. 1010, pp. 18-19, ¶[0036] (“The configurations shown in Figs. 11-13 could be used in candy-bar style telephone handsets as well as flip-phone style handsets.”).

Ex. 1001, FIGs. 11-13 (annotated); Ex. 1010, p. 32, FIGs. 11-13



The disclosure of the '602 Patent that the housing member housed components 112, 114, and 116 reasonably conveyed to the POSITA “wherein the battery and engine section are housed in the housing.” Ex. 2001, ¶97.

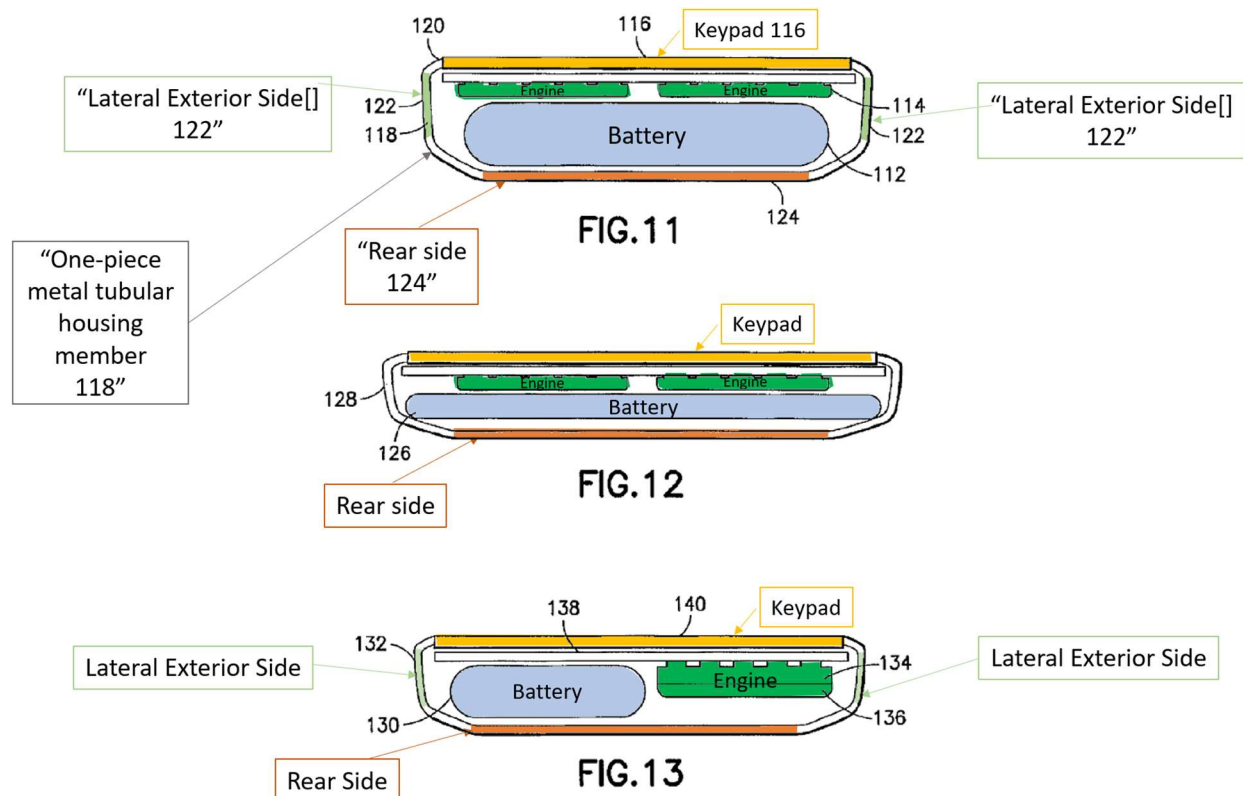
d) The originally-filed specification of the '602 Patent contains written support for “the user input is located in an opening between said exterior lateral sides of said one piece housing of the portable electronic device.”

Contrary to Dr. Visser’s statement that “there is no disclosure of the user input being located in an opening between lateral sides of a housing with a camera” (*see* Ex. 1003, ¶23), the '602 Patent discloses “the user input is located in an opening between said exterior lateral sides of said one piece housing of the portable electronic device.” Ex. 2001, ¶¶96-97, 103-104.

The “configurations shown in FIGS. 11-13 could be used in candy-bar style telephone handsets as well as flip-phone style handsets.” Ex. 1001, 5:58-60; Ex. 1010, pp. 18-19, ¶[0036]. As shown in FIGs. 11-13 below, the '602 Patent explicitly discloses a “one-piece metal tubular housing member 118” housing a battery 112, engine 114, and keypad 116. Ex. 1001, 5:42-48; Ex. 1010, p. 18, ¶[0035] (“The components 112 [battery], 114 [engine], 116 [keypad] are housed in a one-piece metal tubular housing member 118.”). The '602 Patent also explicitly states that the “housing member 118” “forms enclosed lateral exterior sides 122 and rear side 124” and that the “keypad is located at a hole through the front side 120 of the housing

member 118.” *Id.*; Ex. 1010, p. 18, ¶[0035] (“The keypad is located at a hole through the front side 120 of the housing member 118. Otherwise, the housing member 118 forms enclosed lateral exterior sides 122 and rear side 124.”). That is, as shown and disclosed, the user input (keypad 116) is shown as being located in an opening between the lateral exterior sides. Ex. 2001, ¶¶95-96, 104. Thus, the ’602 Patent explicitly discloses a one-piece housing with a user input located in an opening between lateral sides of the housing. Ex. 2001, ¶¶96-97, 103-104.

Ex. 1001, FIGs. 11-13 (annotated); Ex. 1010, p. 32, FIGs. 11-13



Also demonstrated in at least FIG. 13, the '602 Patent provides explicit disclosure for a user input section that is located both above and adjacent an engine section and a battery. Ex. 1001, 4:7-10; Ex. 1010, p. 18, ¶[0034]; Ex. 2001, ¶107.

As discussed above, the POSITA would have understood that embodiments with one-piece housings would have had a housing with the battery, engine, and user input section, as well as the camera. Ex. 2001, ¶97, 110. Accordingly, the '602 Patent discloses “the user input is located in an opening between said exterior lateral sides of said one piece housing of the portable electronic device.” Ex. 2001, ¶¶104, 108.

e) The '602 Patent underscores flexibility.

In addition to the ample and explicit disclosure in the '602 Patent of PDA and candy-bar style form factors, the '602 Patent also discloses flexibility in the design of the inventive devices.

For example, the '602 Patent states that “the invention can be embodied in many alternate forms of embodiments,” and that, “[i]n addition, any suitable size, shape or type of elements or materials could be used.” Ex. 1001, 2:52-59; Ex. 2001, ¶101; Ex. 1010, p. 12, ¶[0022] (“the invention can be embodied in many alternate forms of embodiments...any suitable size, shape or type of elements or materials could be used.”). The '602 Patent also states that “[i]t should be understood that the foregoing description is only illustrative of the invention” and that “[v]arious alternatives and modifications can be devised by those skilled in the art without

departing from the invention.” Ex. 1001, 6:13-16; Ex. 2001, ¶101; Ex. 1010, p. 19, ¶[0039] (“It should be understood that the foregoing description is only illustrative of the invention. Various alternatives and modifications can be devised by those skilled in the art without departing from the invention.”). These statements, along with the remaining disclosure of the ’602 Patent, conveyed to the POSITA that the example embodiments disclosed in the ’602 Patent were not limited, and that various alternatives were contemplated by the inventors. Ex. 2001, ¶101.

Dr. Visser and Petitioner also fail to address the disclosure in the ’602 Patent that “the invention can be embodied in many alternate forms of embodiments,” and that, “[i]n addition, any suitable size, shape or type of elements or materials could be used.” Ex. 1001, 2:52-59; Ex. 2001, ¶101; Ex. 1010, p. 12, ¶[0022]. Also overlooked by Dr. Visser and Petitioner is the disclosure in the ’602 Patent that “[i]t should be understood that the foregoing description is only illustrative of the invention” and that “[v]arious alternatives and modifications can be devised by those skilled in the art without departing from the invention.” Ex. 1001, 6:13-16; Ex. 2001, ¶101; Ex. 1010, p. 19, ¶[0039].

f) Petitioner provides no evidence to support its arguments that the ’602 Patent is not entitled to its earliest priority date.

Petitioner broadly asserts that “the claims of the ’602 patent (filed 2015), are directed to an iPhone or iPad-like form factor with a one-piece housing for the

camera, battery, engine, and user input—a configuration that has no written description in the '602 patent specification and was not contemplated by Nokia in 2006 before the iPhone was announced.” Petition, 10⁶. Dr. Visser’s declaration parrots nearly verbatim the attorney argument in the Petition and provides no additional evidence as to why the originally-filed specification of the '602 Patent did not reasonably convey to a POSITA that the inventor had possession of the claimed invention.

Despite “written description” being a question of fact, and despite Petitioner having its own technical expert, Dr. Visser, Petitioner does not provide any evidence supporting the plain attorney arguments advanced in the Petition (and parroted nearly verbatim by Dr. Visser). *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (“Attorney’s argument in a brief cannot take the place of evidence.”); *In re Owens*, 710 F.3d at 1366; *see, generally*, Ex. 1003 (Dr. Visser declaration). Rather than having Dr. Visser testify, in detail, why the “Original Application” of the '602

⁶ Patent Owner expressly denies Petitioner’s allegations that the configuration of the '602 Patent was “not contemplated by Nokia in 2006 before the iPhone was announced” (Petition, 8), and that Nokia filed a continuation in 2013 that “cited the original 2006 application but copied features of Apple’s form factor into its claims.” Petition, p. 5.

Patent allegedly does not explicitly or inherently disclose the subject limitation to the POSITA, Petitioner and Dr. Visser merely advance nearly verbatim conclusory assertions that there is no written description in the specification, as demonstrated in the example excerpts in the table below.

Petition	Ex. 1003
In contrast, the claims of the '602 patent (filed 2015), are directed to an iPhone or iPad-like form factor with a one-piece housing for the camera, battery, engine, and user input—a configuration that has no written description in the '602 patent specification.... Visser, ¶21. (p. 10)	In contrast, the claims of the '602 patent (filed February 3, 2015), are directed to an iPad-like form factor with a one-piece housing for the camera, battery, engine, and user input—a configuration that has no written description in the specification. (¶21)
Since the specification is directed to a flip-phone where the camera is in the second (<i>top</i>) section, the specification does not contain written description for a camera located in the same section or housing as the battery, engine, and user input section, which are described as being in the first (<i>bottom</i>) section. (p. 12)	Since the specification is directed to a flip phone where the camera is in the second (top) section, the specification does not contain written description for a camera located in the same section or housing as the battery, engine, and user input, which are described as being in the first (bottom) section. (¶23).
Given this lack of written description, a POSITA would not conclude that the inventor had possession of the invention claimed by the '602 patent when the applicant filed the Original Application in 2006. Visser, ¶25. (p. 14)	Given this lack of written description in the '618 patent, a POSITA would not conclude that the inventor had possession of the invention claimed by the '602 patent when the applicant filed for the '618 patent. (¶25).

Petitioner and Dr. Visser fail to explain why the entirety of the “Original Application” does not explicitly or inherently disclose the claimed limitations to the POSITA. *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306–07 (Fed.

Cir. 2008) (explaining that § 112, ¶ 1 “requires that the written description actually or inherently disclose the claim element”). As discussed above, Petitioner and Dr. Visser also specifically ignore explicit disclosure in the “Original Application” of the ’602 Patent that conveyed to the POSITA that the inventor had possession of the claimed invention. Petitioner’s plain attorney arguments cannot take the place of actual evidence. Thus, Petitioner has not carried its burden in demonstrating a lack of written support for the claimed invention.

g) The originally-filed specification of the ’602 Patent contains written support for the remaining limitations of at least the independent claims.

While Petitioner did not argue that the originally-filed specification of the ’602 Patent does not provide written description support for the remaining limitations of at least the independent claims, written description support in the originally-filed specification of the ’602 Patent for the remaining limitations of at least the independent claims is presented herein.

For example, the originally-filed specification of the ’602 Patent discloses “[t]he engine 30 generally comprises a printed circuit board, a transceiver, a processor, and a memory, among other components.” Ex. 1001, 3:63-65, Figure 8; Ex. 2001, ¶102; Ex. 1010, p. 14, ¶[0028] (“The engine 30 generally comprises a printed circuit board, a transceiver, a processor, and a memory, among other components.”). The originally-filed specification of the ’602 Patent discloses “[t]he

user input section generally comprises keymats 50, an EL backlight foil 52, a keymat dome sheet 54 and a keymat stiffener 56” and “in alternate embodiments, any suitable user input section could be provided.” Ex. 1001, 3:54-57, Figure 7; Ex. 2001, ¶¶103-104; Ex. 1010, p. 14, ¶[0027] (“The user input generally comprises keymats 50, an EL backlight foil 52, a keymat dome sheet 54 and a keymat stiffener 56...in alternate embodiments, any suitable user input section could be provided.”).

The ’602 Patent discloses all of the features of the claimed invention and conveyed the same to a POSITA. The ’602 Patent is therefore entitled to at least its earliest priority date of March 29, 2006. Ex. 2001, ¶112.

2) Grounds 1, 2, and 3 fail because McClure-997 and McClure-998 are not prior art to the ’602 Patent.

Petitioner alleges that McClure-997 renders obvious claims 1-8, 11-29, and 32-36 of the ’602 Patent, McClure-997 and McClure-998 render obvious claims 1-8, 11-29, and 32-36 of the ’602 Patent, and McClure-997, McClure-998, and Chiang render obvious claims 1-36 of the ’602 Patent. *See* Petition, p. 19. However, as established in §III.A.1, the ’602 Patent is entitled to at least its earliest priority date of March 29, 2006.

Because the ’602 Patent has an effective filing date of March 29, 2006, which is before March 16, 2013, it is governed by pre-AIA 35 U.S.C. § 102 and pre-AIA 35 U.S.C. § 103. *See*. McClure-997 was filed January 31, 2011, and published

August 2, 2012. Ex. 1004, Cover. McClure-998 was filed January 31, 2011, and published August 2, 2012. Ex. 1005, Cover. These filing and publication dates are not disputed by Petitioner nor Dr. Visser.

To qualify as prior art to the '602 Patent under pre-AIA 35 U.S.C. § 102, a printed publication must have a publication date at least before the invention of the '602 Patent. pre-AIA 35 U.S.C. §102. McClure-997 and McClure-998 were filed and published after the earliest priority date of the '602 Patent and therefore do not qualify as prior art to the '602 Patent under pre-AIA 35 U.S.C. §102.

To qualify as prior art to the '602 Patent under 35 U.S.C. § 102 (AIA), a printed publication must have a publication date at least before the effective filing date of the claimed invention of the '602 Patent. 35 U.S.C. § 102 (AIA). The '602 Patent is not governed by 35 U.S.C. § 102 (AIA), and neither McClure-997 nor McClure-998 has a publication date before the effective filing date of the '602 Patent. Therefore, McClure-997 and McClure-998 do not qualify as prior art to the '602 Patent under 35 U.S.C. § 102 (AIA).

Accordingly, Grounds 1, 2, and 3 fail because Petitioner has not identified alleged teachings of the limitations of at least the independent claims in references other than McClure-997 and McClure-998. For at least this reason, Grounds 1-3 fail.

a) Ground 1 fails at least because McClure-997 is not prior art to the '602 Patent.

It is undisputed that McClure-997 was filed January 31, 2011, and published August 2, 2012. Ex. 1003, ¶60; Ex. 1004, Cover. Established above, the '602 Patent is entitled to a priority date of March 29, 2006, which predates the filing date of McClure-997. Ex. 2001, ¶114.

Ground 1 relies entirely on McClure-997 for alleged teachings of claims 1-8, 11-29, and 32-36 of the '602 Patent. Petition, p. 19; Ex. 1003, ¶31; Ex. 2001, ¶116.

Because McClure-997 is not prior art to the '602 Patent, McClure-997 cannot be used to demonstrate that the challenged claims are unpatentable. Accordingly, Petitioner has failed to establish a reasonable likelihood that it would prevail in showing that any of the Challenged Claims is unpatentable as obvious over McClure-997. Ex. 2001, ¶117.

b) Ground 2 fails at least because McClure-997 and McClure-998 are not prior art to the '602 Patent.

It is undisputed that McClure-998 was filed January 31, 2011, and published August 2, 2012. Ex. 1003, ¶60; Ex. 1005, Cover. Established above, the '602 Patent is entitled to a priority date of at least March 29, 2006, which predates the filing date of both McClure-998 and McClure-997. Ex. 2001, ¶115.

Ground 2 relies on a combination of McClure-997 and McClure-998 for alleged teachings of claims 1-8, 11-29, and 32-36 of the '602 Patent. Petition, p. 19; Ex. 1003, ¶¶50-51; Ex. 2001, ¶116.

Because McClure-997 and McClure-998 are not prior art to the '602 Patent, McClure-997 and McClure-998 cannot be used to demonstrate that the challenged claims are unpatentable. Accordingly, Petitioner has failed to establish a reasonable likelihood that it would prevail in showing that any of the Challenged Claims is unpatentable as obvious over McClure-997 and McClure-998. Ex. 2001, ¶117.

c) Ground 3 fails at least because McClure-997 and McClure-998 are not prior art to the '602 Patent.

Ground 3 relies on a combination of McClure-997, McClure-998, and Chiang for alleged teachings of claims 1-36 of the '602 Patent. Petition, p. 19; Ex. 1003, ¶¶31, 50-51; Ex. 2001, ¶118. Specifically, Ground 3 incorporates the analyses of Grounds 1 and 2 for the independent claims and relies on Chiang for purported teachings of “a cut-out portion around the camera that projects outward from the housing,” for dependent claims 9-10 and 30-31. Petition, pp. 89-96.

Because McClure-997 and McClure-998 are not prior art to the '602 Patent, McClure-997 and McClure-998 cannot be used to demonstrate that the challenged claims are unpatentable. Accordingly, Petitioner has failed to establish a reasonable likelihood that it would prevail in showing that any of the Challenged Claims is

unpatentable as obvious over McClure-997, McClure-998, and Chiang. Ex. 2001, ¶119.

VI. PETITIONER FAILS TO DEMONSTRATE WHY MORE THAN ONE PETITION IS WARRANTED

Institution of review is discretionary. 35 U.S.C. § 314(a); *SAS Inst. Inc. v Ianco*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *see also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). “[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). If the Board institutes review at all, it is required to institute review on all challenged claims on all challenged grounds. *SAS Inst.*, 138 S. Ct. at 1359–60; Trial Practice Guide Update (July 2019), <https://www.uspto.gov/TrialPracticeGuide3> (“In instituting a trial, the Board will either (1) institute as to all claims challenged in the petition and on all grounds in the petition, or (2) institute on no claims and deny institution.”).

Petitioner’s explanations fail to demonstrate a genuine need to file two petitions against the same claims of the same patent. According to the Trial Practice Guide, “if a petitioner files two or more petitions challenging the same patent, then

the petitioner should” identify “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).” Consolidated Trial Practice Guide (“CTPG”), pp. 59-60. Petitioner has not satisfied this burden.

The CTPG states that when there is a dispute about priority date, “two petitions by a petitioner may be needed, although this should be rare.” CTPG, p. 59. The statement does not convey that whenever a priority issue is involved, Petitioner is entitled to file two petitions against the same claims of the same patent. Indeed, the operative phrase is “may be needed, although this should be rare.” *Id.* In this particular instance and based on the fact that Petitioner failed to meet its requirements, Petitioner has failed to demonstrate that this is one of the rare circumstances requiring the filing of two petitions. Petitioner contends that two petitions are necessary due to its concerns relating to potential arguments Patent Owner may raise regarding the priority date of the. Petitioner’s Statement Regarding Multiple Petitions (“SRMP”), p. 4 (“Nokia will, inevitably, attempt to dispute the priority date.”). That is, the only difference Petitioner identifies between the two petitions is that Patent Owner may dispute whether the references in IPR2024-00798 qualify as prior art based on the priority date of the ’602 Patent. SRMP, p. 4.

However, Petitioner has not demonstrated anything unique in this case that differentiates Petitioner's strategic choices from strategic choices faced by all petitioners. A petitioner must always weigh the pros and cons of using art reliant upon a priority challenge, and Patent Owner has a right to challenge prior art. *See, e.g., Pfenex, Inc. v. GlaxoSmithKline Biologicals SA*, IPR2019-01027, Paper 12 at 13–14 (PTAB Nov. 13, 2019) (“[T]he mere fact that Petitioner may have had additional art to assert, including a different statutory basis for asserting that art, does not, on these facts, justify the additional burden of a second petition directed to the same claims.”).

The Board considers whether a petitioner could have asserted *at least one* ground of unpatentability for each challenged claim, not whether it could assert *all* potential grounds in one petition. *Fantasia Trading LLC v. Cognipower LLC*, IPR2021-00070 Paper 21 at 10-11 (P.T.A.B. May 20, 2021); *see also Samsung Elecs. Co., Ltd. v. Lynk Labs, Inc.*, No. IPR2022-00150, Paper 15 at 10 (P.T.A.B. July 5, 2022).

Indeed, the Board routinely declines to institute multiple petitions, even where there is a priority date dispute. *See, e.g., Comcast Cable Commc'ns., LLC v. Rovi 2 Guides, Inc.*, IPR2019-01354, Paper 10 at 6 (PTAB Jan. 27, 2020) (denying institution of two of three petitions where a potential priority dispute existed); *Dropbox, Inc. v. Whitserve LLC*, IPR2019-01018, Paper 13 at 8–9 (PTAB Nov. 1,

2019) (denying institution of a second petition where parties disputed the priority date of multiple prior art references); *Comcast Cable Comm'ncs, LLC v. Rovi Guides, Inc.*, IPR2019-00279, Paper 10 at 6–7 (PTAB July 1, 2019) (declining to institute four of five filed petitions where a potential priority dispute existed).

Here, the Board should fault the Petitioner based on what it failed to do. Petitioner provides no meaningful explanation as to why the number of challenged claims justifies the Board's review of both petitions. Petitioner asserts that "two petitions are necessary because of the large number of challenged claims (36)." SRMP, p. 5. Petitioner's only justification is that, "[e]ven accounting for similar claims, the number of distinctive claim limitations still exceeds twenty." *Id.* However, Petitioner provides no additional explanation or analysis regarding the "number of distinctive claim limitations," nor why the alleged "number of distinctive claim limitations" could not have been addressed in a single petition. Petitioner's justification is merely an unsupported conclusion and should be rejected.

VII. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION

The Petition fails to demonstrate a likelihood of success with respect to a single claim. Indeed, Patent Owner has demonstrated that the grounds are facially deficient. As a result, Petitioner fails to demonstrate that any of the challenged claims are likely found to be unpatentable. For at least these reasons, the Board should exercise its discretion and deny institution.

VIII. CONCLUSION

For the above-stated reasons, Patent Owner requests that the Board deny institution of the Petition.

Dated: October 30, 2024

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CERTIFICATE OF WORD COUNT

Under the provisions of 37 C.F.R. § 42.24, the undersigned hereby certifies that the word count for the foregoing Patent Owner Preliminary Response totals 10,410 words, which is less than the 14,000 allowed words under 37 C.F.R. § 42.24(a)(1)(i),(b)(1).

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** and accompanying exhibits were served electronically via e-mail on October 30, 2024, in its entirety on the following counsel of record for Petitioner:

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