Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

RESONANT SYSTEMS, INC.,
Patent Owner.

Case No. IPR2024-00806
U.S. Patent No. 9,941,830

PATENT OWNER'S PRELIMINARY SUR-REPLY

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I. The Preliminary Response Correctly Demonstrated the Petition's Failure to Satisfy the District Court's—and Any Correct—Construction of "Control Component"

Patent Owner's Preliminary Response addressed the district court's construction of the term "control component" in the litigation between Patent Owner and Apple. (POPR at 8–11.) Petitioner's Preliminary Reply does not dispute Patent Owner's characterization of that claim construction. In particular, the Reply does not dispute that the district court's construction—and any correct construction of "control component"—should require at least the step to "provide a corresponding output to the power supply," corresponding to step 762 of Figure 7C of the '830 patent. The Reply also appears to acknowledge that the Petition fails to demonstrate this step of the "control component" is satisfied for Grounds 1A-1F.

The Reply alleges that this step was shown to be obvious in the Petition for Grounds 2A–2C at pages 71–72. (Reply at 3.) But as argued in the Preliminary Response, this is incorrect. For the "power supply" of limitation [1c] and "processor" of limitation [1f], these grounds rely on the same disclosures of the prior art as in Ground 1A. (Petition at 63–64.) The Preliminary Response addresses these disclosures in depth. (POPR at 15–18.) Based upon these disclosures, the Preliminary Response explains that: "the petition fails to explain how the prior art disclosed a 'power supply' that can receive an

output from the 'control component' or the actual outputting of such an output to the 'power supply,' and further fails to explain how a POSITA would have been motivated to modify the prior art to satisfy these requirements of the claims." (POPR at 18.)

II. Statements in the Petition Cited in the Preliminary Reply Are Conclusory, Unsupported, and Improperly Seek to Incorporate Arguments by Reference from the Expert Declaration

Nothing in the Preliminary Reply or the materials it cites rebuts this argument. The Preliminary Reply asserts that step 762 "is expressly discussed in the Petition," citing pages 71–72 of the Petition. (Reply at 3.) But the sole "discussion" pertaining to this step to be found there is a conclusory sentence: "Particularly, the software executing on the microprocessor outputs a corresponding control signal to the power supply in accordance with the user unput [sic]." (Petition at 72.)

The sentence is accompanied by a citation to three paragraphs of an expert declaration. But an IPR cannot be instituted based on evidence cited and arguments presented solely in the expert declaration to a petition that itself is within 10 words of the 14,000-word limit. 37 C.F.R. § 42.24(a)(1)(i) (petition limited to 14,000 words); 37 C.F.R. § 42.22(a)(1)(2) (petition must include "full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts"); 37

C.F.R. § 42.6(a)(3) ("Arguments must not be incorporated by reference from one document into another document."); *see 3M Company v. Evergreen Adhesives, Inc.*, 860 Fed.Appx. 724, 728 (Fed. Cir. 2021) (affirming PTAB decision to exclude arguments made in expert testimony where the corresponding arguments in the petition and reply were "skeletal at best").

Even if the Board were to consider arguments incorporated from the expert declaration, those arguments are themselves conclusory and unsupported. Indeed, they amount to little more than the unsupported sentence: "In particular, the software executing on the microprocessor outputs a corresponding control signal to the power supply in accordance with the user unput [sic]." (Ex. 1003, ¶ 260.) This sentence not only shares a typographical error with the petition that relies upon it; it also shares a lack of any citations to evidence or explanations of why this conclusion flows from the evidence or from the knowledge of an expert. Nothing in the Petition or in the expert declaration shows that the prior art teaches a microprocessor that "outputs a corresponding control signal to the power supply" or even attempts to explain how the proposed combination of prior art would include this feature.

For these reasons and for the other reasons set forth in the Preliminary Response, institution should be denied.

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CERTIFICATE OF SERVICE

I hereby certify that "Patent Owner's Preliminary Sur-Reply" was served on October 2, 2024 by email sent to:

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