UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

THETA IP, LLC,
Patent Owner.

Case IPR2024-00817
U.S. Patent No. 10,129,825

PATENT OWNER THETA IP LLC'S MOTION TO STRIKE PETITIONER'S NEW REPLY ARGUMENTS AND EVIDENCE

TABLE OF CONTENTS

I. The Reply Declaration (EX1042) Presents Improper New Evidence on New Theories of Invalidity. 2

A. In Reply, Apple changed its assertion concerning the component alleged to be dynamically altered—from swapped low-pass filters to a larger box containing them, and seeks to offer new evidence. 2

B. In Reply, Apple asserted a new theory with respect to alleged obviousness of the claimed signal strength indications. 6

II. Conclusion 8

TABLE OF AUTHORITIES

Cases

Apple Inc. v. e-Watch, Inc.,
IPR2015-00412, Paper 50, 2016 WL 2640534 (P.T.A.B. May 6, 2016) 5

Belden Inc. v. Berk-Tek LLC,
805 F.3d 1064 (Fed. Cir. 2015).....5

Gemtron Corp. v. Saint-Gobain Corp.,
572 F.3d 1371 (Fed. Cir. 2009).....5

Harmonic Inc. v. Avid Tech., Inc.,
815 F.3d 1356 (Fed. Cir. 2016).....1

Icon Health and Fitness, Inc. v. Strava, Inc.,
849 F.3d 1034 (Fed. Cir. 2017).....5

Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.,
821 F.3d 1359 (Fed. Cir. 2016).....5

KSR Int'l. Co. v. Teleflex Inc.,
550 U.S. 398 (2007).....8

Toshiba Corp. v. Optical Devices, LLC,
PR2014-01447, Paper 34, 2016 WL 931824 (P.T.A.B. Mar. 9, 2016) 4

Toyota Motor Corp. v. Am. Vehicular Scis. LLC,
IPR2013-00424, Paper 50 (P.T.A.B. Jan. 12, 2015).....2

TransWeb, LLC v. 3M Innovative Props. Co.,
812 F.3d 1295 (Fed. Cir. 2016).....7

Xerox Corp. v. Bytemark, Inc.,
IPR2022-00624, Paper 9, 2022 WL 3648989 (P.T.A.B. Aug. 24, 2022).....8

Statutes

35 U.S.C. § 316(e) 1

5 U.S.C. § 556(d) 5

Regulations

37 C.F.R. § 42.104 1

37 C.F.R. § 42.22 1

37 C.F.R. § 42.23 ..... 2, 4

M.P.E.P. § 715.07 7

M.P.E.P. §2145 5

Pursuant to the Federal Rules of Evidence, 37 C.F.R. § 42.23(b), and 37 C.F.R. § 42.64(b)(1), Patent Owner Theta IP LLC ("Theta") submits this authorized Motion to Strike Exhibit 1042, the Supplemental Declaration of Dr. Asad Abidi (the "Reply Declaration") submitted by Petitioner Apple on June 20, 2025 with Petitioner's Reply, and portions of Apple's Reply Brief (Paper 17) that discuss Exhibit 1042. *See* July 10, 2025 Email authorizing motion. Theta timely objected to this new declaration evidence on June 27, 2025 (Paper 18). For the reasons set forth in Theta's objection and this motion, Petitioner's new Reply Declaration evidence (EX1042) and the portions of Apple's Reply that rely on it (Reply at 6-8, 23-27) should be stricken, or in the alternative, excluded from consideration.

The petition must identify how a challenged claim is to be construed, and "specify where each element of the claim is found in the prior art patents or printed publications relied upon." 37 C.F.R. § 42.104(b)(3)-(4). And it must identify all evidence relied upon, including to "state its relevance or to identify specific portions of the evidence that support the challenge." 37 C.F.R. § 42.104(b)(5); *see also* 37 C.F.R. § 42.22 ("detailed explanation of the significance of the evidence"); 35 U.S.C. §316(e); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) ("the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable").

Theta's briefing—both in preliminary proceedings and in its Patent Owner Response—identified evidentiary gaps in the Petition for (amongst others) the dynamic adjustment and measurement aspects of the challenged claims. These evidentiary failures are confirmed by Apple's attempt to gap-fill with new testimony via Reply Declaration. But new testimonial ***evidence*** that could have been included in the Petition is improper, particularly since Theta cannot submit rebuttal testimony. *See* 37 C.F.R. § 42.23; CTPG at 74-75 ("It is also improper for a reply to present new evidence (including new expert testimony) that could have been presented in a prior filing …."); *Toyota Motor Corp. v. Am. Vehicular Scis. LLC*, IPR2013-00424, Paper 50, at 21 (P.T.A.B. Jan. 12, 2015) ("[Petitioner] cannot rely belatedly on this evidence in its Reply … to make up for the deficiencies in its Petition.").

I. The Reply Declaration (EX1042) Presents Improper New Evidence on New Theories of Invalidity.

A. In Reply, Apple changed its assertion concerning the component alleged to be dynamically altered—from swapped low-pass filters to a larger box containing them, and seeks to offer new evidence.

Apple's presentation of a Reply Declaration here attempts to attach its expert's endorsement to the unsupported attorney argument Apple presented on Preliminary Reply—after its original theory of what is "dynamically adjusted" in the asserted *Behbahani* Papers was debunked via a simple distinction, between swapping components and changing the parameters of a component. *See* Preliminary Sur-Reply (Paper 10) at 1-4.

In the Petition and Original Declaration, Apple and Dr. Abidi identified the high- and low-power, ***low-pass filter portions*** of the design disclosed in the *Behbahani* papers as the components being dynamically adjusted. Petition (Paper 1) at 48-49 ("switching from *Behbahani's* high-power filter to its low-power filter changes … a component (i.e., the filter) in the signal path"); EX1003 (Original Declaration), ¶135 ("switching from *Behbahani's* high-power filter to its low-power filter"); *see also* IPR2024-00816, Paper 1 at 25 ("a low-pass filter, satisfying the filter component").

Beginning in its Preliminary Response, Theta demonstrated a lack of proof based on the identified *Behbahani* filter swap (e.g., switching one whole filter component for another did not establish dynamically adjusting the internal parameters of a filter component). *See, e.g.*, Preliminary Response at 34-43; Response at 44-46, 47-63.

On Reply, however, Apple seeks to draw a bigger box around a larger portion of the circuit—and say for the first time that, the whole "Variable BW Adaptive DR BPF" does not just ***include*** the alleged dynamically altered components, but rather it ***is*** the dynamically altered component. *See* Reply, 6-7 ("this variable filter block is dynamically adjusted"). But there is no evidentiary support for this in the Petition. Dr. Abidi never analyzed (or even mentioned) a band pass "filter block" as the changed component. *See* EX1003. The absence of such evidence is confirmed by Apple's need to supply it here with its Reply. *See* EX1042, ¶¶4-6. After institution, Apple

improperly directed its witness through testimony to this effect. *See* Response at 58 (*citing* EX2021, 95:24-96:9). Now, Apple has put this testimony into an improper new declaration. *See* EX1042, ¶¶4-6 ("Variable Bandpass Filter Block ***Is*** A 'Component'…") (emphasis added), ¶10 ("within a filter block").

This is improper and should be stricken. *See, e.g.*, 37 C.F.R. § 42.23(b); *Toshiba Corp. v. Optical Devices, LLC*, IPR2014-01447, Paper 34, 2016 WL 931824, at *15 (P.T.A.B. Mar. 9, 2016) ("[Section 42.23(b)], however, does not authorize or otherwise provide a means for supplementing the evidence of record."); CPTG at 74, 80-81.

Apple was obligated to present its invalidity theory with specificity in the Petition, but did ***not*** identify the ***filter block*** as "the component" at issue. *See, e.g.*, *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369-70 (Fed. Cir. 2016) (Board did not abuse its discretion in refusing to consider reply brief arguments advocating a "new theory" of unpatentability under 37 C.F.R. § 42.23(b)); *Apple Inc. v. e-Watch, Inc.*, IPR2015-00412, Paper 50, 2016 WL 2640534, at *22 (P.T.A.B. May 6, 2016) ("'Respond,' in the context of 37 C.F.R. § 42.23(b), does not mean embark in a new direction with a new approach as compared to the position originally taken in the Petition. Accepting such belatedly presented new arguments would be unjust to the Patent Owner and we decline to do so."). While counsel may be afforded leeway to argue consistent with a Petition's disclosures, attorney argument

is not evidence. *See, e.g.*, *Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1380 (Fed. Cir. 2009) ("[U]nsworn attorney argument . . . is not evidence and cannot rebut . . . other admitted evidence . . . ."); *Icon Health and Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017) ("Attorney argument is not evidence."); M.P.E.P. §2145 ("arguments of counsel cannot take the place of factually supported objective evidence"). Apple's attempt to create a new evidentiary record to support its new arguments is contrary to the Board's rules and precedents and due process. *See, e.g.*, *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015) ("A patent owner … is undoubtedly entitled to notice of and a fair opportunity to meet the grounds of rejection"); 5 U.S.C. § 556(d) (party "is entitled to" … "submit rebuttal evidence, … as may be required for a full and true disclosure of the facts.").

The Board should strike—or alternatively exclude from consideration—the new evidence, and any arguments in the Reply Brief premised thereon. *See, e.g.*, EX1042, ¶¶4-6;[1] Reply, 6-8.

While the Institution Decision noted that the entire "Band-Pass Filter" is mentioned in the Petition (see Paper 11 at 40 n.11), it was not cited for these elements, and the Reply goes well beyond this. Apple, and Dr. Abidi, never said prior to Reply that it was the ***entire*** bandpass filter that was the altered component—instead

[1] Paragraphs 7-11 of the Reply Declaration interpret an article by Theta's inventor that is not part of Apple's Ground. *See* EX1042. Paragraphs 12-16 are addressed below.

identifying the two internal low-pass filters that are swapped. IPR2024-00816, Paper 1 at 25 ("includes a low-pass filter, satisfying the filter component"); Petition (Paper 1) at 48-49 ("switching from *Behbahani's* high-power filter to its low-power filter changes … a component (i.e., the filter)"). Apple's new theory is not consistent with the Petition or Professor Abidi's original declaration. Apple has violated the rules and precedent concerning proper Reply.

Petitioner should have, and could have, introduced and supported this argument in the Petition—but failed to do so. *See* 37 C.F.R. § 42.104(b); 37 C.F.R. § 42.23(b). Simply mentioning the larger bandpass filter—as an introduction to identifying the actual components within it that the Petition identifies as allegedly performing the required function of the claims—is not presentation of the bandpass filter ***itself*** as the alleged changed component. The latter is a new theory, improperly presented and supported with new evidence for the first time here in Reply.

B. In Reply, Apple asserted a new theory with respect to alleged obviousness of the claimed signal strength indications.

Apple also improperly attempts on Reply to gap-fill its sparse Petition treatment of the signal strength elements of the challenged claims—with new unsupported testimony from Dr. Abidi. EX1042, ¶¶12-16. This is because—and the Reply Declaration admits—the *Behbahani* Papers ***do not disclose*** details of signal strength measurement. EX1042, ¶13; *see also* Response at 67-70 (identifying deficiencies). That evidentiary gap cannot be filled with self-serving and unsupported testimony

about what was ***intended*** to be conveyed. *See, e.g.*, EX1042, ¶¶12-13 ("It was our intent, which a POSITA would have understood, to include…"). Indeed, supplying an author's unstated intent is *a fortiori* a submission of new evidence. Separately, an inventor's uncorroborated testimony would not be credited, nor is the word of one claiming prior inventorship. *See, e.g.*, *TransWeb, LLC v. 3M Innovative Props. Co.*, 812 F.3d 1295, 1302 (Fed. Cir. 2016) (discussing problems of uncorroborated testimony by interested parties); M.P.E.P. § 715.07. This is particularly problematic given Dr. Abidi's dual role as an author of the *Behbahani* Papers and as Apple's retained expert—blending new fact testimony about what authors "intended" over 20 years ago, with what a "POSITA" would supposedly have understood.[2]

The Reply Declaration is also improper because it offers new testimony about what a person of ordinary skill in the art would allegedly understand from the *Behbahani* Papers. *See, e.g.*, EX1042, ¶¶12-13 ("It was our intent, which a POSITA would have understood, to include…"), ¶14 ("A POSITA would therefore understand …"), ¶15 ("I believe a POSITA would have considered using a simplified version …"). This new, conclusory testimony—that a POSITA would find the use of certain circuitry obvious, from their knowledge or from his intent concerning the identified papers—improperly adds new evidence not found or directly discussed in the Petition. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 2022 WL 3648989, at *6

[2] Dr. Abidi is the last-named author on each *Behbahani* Paper.

(P.T.A.B. Aug. 24, 2022) (noting "particularly problematic" nature where expert testimony is offered to supply a missing limitation) (designated precedential Feb. 10, 2023); *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) ("factfinder ... must be cautious of arguments reliant upon ex post reasoning"); *see also* Response at 67-70. Such gap-filling testimony and related arguments (EX1042, ¶¶12-16; Reply, 23-27) should be stricken or otherwise excluded.

II. Conclusion

For all of the foregoing reasons, Apple's improper Reply Declaration (EX1042) and portions of the Reply relying on it (Reply at 6-8, 23-27), should be stricken from the record and not considered by the Board. Alternatively, and for the same reasons, (including as stated in Theta's objections), the Board should exclude the Reply Declaration and the portions of Apple's Reply Brief that rely on it.

Dated: July 24, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Petitioners have consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on July 24, 2025, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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