

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

RESONANT SYSTEMS, INC.,
Patent Owner.

Case No. IPR2024-00983
U.S. Patent No. 11,152,882

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST

<i>Exhibit No</i>	<i>Description</i>
2001	Court's Claim Construction Order (<i>Resonant Systems, Inc. v. Apple Inc.</i> , Case No. 23-cv-00077-ADA (W.D. Tex.), Dkt. 91)
2002	Claim Construction Memorandum and Order (<i>Resonant Systems, Inc. v. Apple Inc.</i> , Case No. 23-cv-00077-ADA (W.D. Tex.), Dkt. 103)
2003	Order Modifying Scheduling Order (<i>Resonant Systems, Inc. v. Apple Inc.</i> , Case No. 23-cv-00077-ADA (W.D. Tex.), Dkt. 57)
2004	Amended Scheduling Order (<i>Resonant Systems, Inc. v. Apple Inc.</i> , Case No. 23-cv-00077-ADA (W.D. Tex.), Dkt. 95, Ex. 1)
2005	Federal Court Management Statistics, Western District of Texas, 2018-2023
2006	Excerpt of Defendant's Final Invalidity Contentions (<i>Resonant Systems, Inc. v. Apple Inc.</i> , Case No. 23-cv-00077-ADA (W.D. Tex.))

I. INTRODUCTION

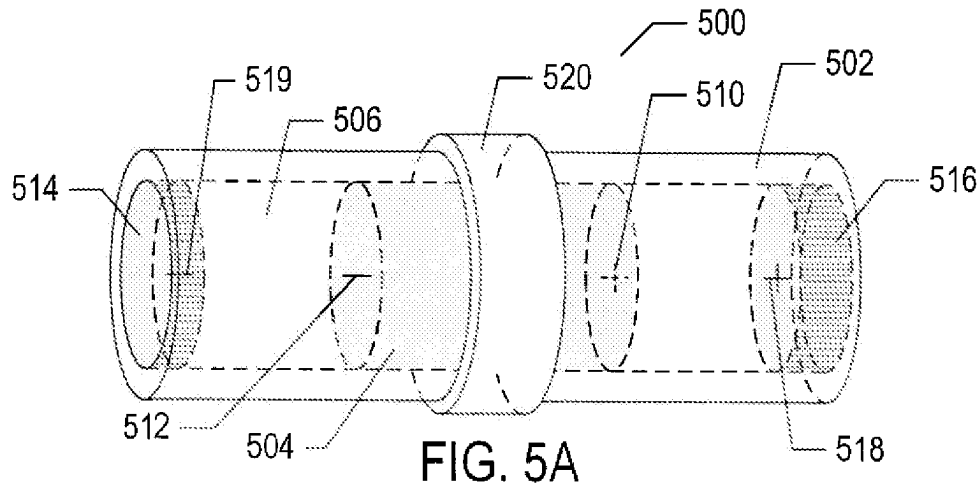
Apple unreasonably delayed filing an IPR petition challenging the '882 patent, waiting just eight days short of a year after it was served with a complaint asserting the patent before doing so. As a result of this delay, the court and the parties have already invested substantial work into resolving 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 just 52 days from completion. Trial in district court is scheduled to begin more than four 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.

II. BACKGROUND

A. Background to the '882 Patent

Many electronic devices such as mobile phones and game controllers make use of components that produce vibrational forces. The '882 patent

teaches and claims improved vibration modules with features suitable for such applications:



(Ex. 1001 at 7.) Compared to prior art solutions, the inventions of the '882 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(f). Even were a claim does not utilize the word “means,” § 112(f) 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

A. “control component...”

Petitioner contends that phrases involving the term “control component” are means-plus-function limitations subject to 35 U.S.C. § 112(f), under *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2014). (Paper 3 at 2–7.) Patent Owner agrees that the “control component...” terms are subject to § 112(f).

In the district court case between Patent Owner and Apple, the court has adopted a claim construction that is similar to Apple’s IPR (and district court) construction, identifying the following as the corresponding structure:

a microcontroller, a processor, a microprocessor, or a CPU that performs the algorithm shown in Figure 45 or the algorithm described in the corresponding text, See, e.g., 31:19–32:13, and equivalents thereof

(Ex. 2001 at 10–12, Ex. 2002 at 40, 43.)

Patent Owner does not believe it is necessary to construe “control component” to decide whether to institute this IPR, but to the extent the term is construed it should be found to be subject to § 112(f).

B. Claim Preambles

As the district court noted in its claim construction order, Patent Owner and Apple agreed in the district court case that the term “oscillating resonant module[s]” in the preambles of claims 1 and 10 is limiting. (Ex. 2001 at 10.)

Patent Owner does not believe it is necessary to decide whether this term is limiting to decide whether to institute this IPR, but to the extent the Board addresses the issue it should find that this term in the preambles is limiting.

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 IP*”); 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 trial is scheduled to begin more than four 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 complete overlap in the claims and substantial overlap in the art at issue in this proceeding and in the district court; Petitioner has not made a *Sotera* stipulation to address the concerns of inefficiency and inconsistent rulings. For Factor 5, Petitioner is defendant in the parallel litigation. And for Factor 6, not only did Petitioner 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 '882 Patent and involving the Petitioner, the district court has not granted a stay pending IPR. Further, there is no evidence that a stay will be granted. Moreover, Petitioner's motion to transfer to the Northern District of California has been denied (*Resonant Systems, Inc. v. Apple Inc.*, Case No. 23-cv-00077-ADA (W.D. Tex.), Dkt. 83), as has the petition to the Federal

Circuit seeking a writ of mandamus on transfer that Petitioner refers to. *In re Apple Inc.*, Case No. 2024-129, 2024 WL 3886316 (Fed. Cir. Aug. 21, 2024).

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. 2003 at 2, Ex. 2004 at 1), and the court has entered its claim construction order (Ex. 2001) and supporting memorandum (Ex. 2002). And by the time the Board's institution decision is due in this proceeding (December 16, 2024), just 52 days will remain in fact discovery, and trial will be less than eight months away. (Ex. 2004 at 1–2.) Trial is currently set for August 4, 2025—more than four months before the earliest deadline for a final written decision in this IPR. (Ex. 2004 at 2.)

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 trial will occur more than four 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 December 16, 2025, which may be extended to June 16, 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 2.) The timeframe set by the district court is consistent with the Federal Court Management Statistics for the Western 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 2; *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 ***more than four months*** before the deadline for a final written decision, and possibly ten 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 2 at 76. But the Petition presents no evidence that the trials will not proceed on the set date, which, as noted above, is consistent with the most current time-to-trial statistics for the Western 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 more than four 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 just 52 days away. (Ex. 2004 at 1–2.) 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 May 30, 2024, 358 days after being served with the first district court complaint on June 7, 2023, and a mere 8 days short of the one-year statutory deadline. (*Resonant Systems, Inc. v. Apple Inc.*, Case No. 23-cv-00077-ADA (W.D. Tex.), Dkt. 15; 35 U.S.C. § 315(b).) 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 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 2 (challenging claims 1–6, 10, 17, 19, and 20) *with* Ex. 2004 at 2 (identifying claims 1–6, 10, 17, 19, and 20 as the asserted claims of the ’882 patent)). Second, Petitioner asserts each of the references relied upon in this Petition as a prior art reference in its district court invalidity contentions. (Ex. 2006 at 131–138 (identifying Alexander, Cosper, Gregorio, and Fuller as anticipating ’882 patent), 189 (identifying Cosper in view of Alexander as rendering ’882 patent obvious), 191 (identifying Gregorio in view of Fuller, Ramsay, and Muramatsu as rendering ’882 patent obvious).)

In short, the Petition challenges the same claims asserted in the parallel litigation, and Petitioner relies on each of its IPR references—in the same combinations—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 is 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 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).

As Petitioner acknowledges, the examiner cited Alexander and relied upon Alexander in rejecting pending claims during prosecution. (*E.g.*, Ex. 1002 at 166.) In response, the applicant argued that “Alexander does not provide an enabling description of anything related to determining either the positions or the velocities of an oscillating mass within an ORM.” (Ex. 1002 at 153.) In the notice of allowability, the examiner was silent on Alexander. (Ex. 1002 at 122–125.) The natural conclusion is that the examiner found the applicant’s arguments concerning enablement of the claimed features persuasive. The Petition does not address this enablement issue, other than to cite to

its own “Analysis of [1c].” (Petition at 73, 75.) But that “analysis” does not actually address enablement or establish that the examiner made an error in accepting the applicant’s arguments during prosecution. (Petition at 20–22.) As to Cospir, the Petition does not identify any way in which the sensors of Cospir are materially different from, or otherwise non-cumulative of, the sensors of Alexander. (Petition at 16–31.) Accordingly, Ground 1 does not support institution. *See* 35 U.S.C. § 325(d).

As for the Gregorio-based grounds, the petition resorts to eight different combinations of references, Grounds 2A–2H. For two of these combinations of references, the petition provides a mere five lines of text, with zero substantive analysis. (Petition at 71.) 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.

VII. CONCLUSION

For the reasons set forth above, the petition fails to establish a reasonable likelihood that Petitioner would succeed in showing that the prior art discloses or renders obvious the properly construed claims, and the Board should deny institution on that basis. Alternatively, 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.

Dated: September 16, 2024

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CERTIFICATE OF WORD COUNT

I certify that there are 3,527 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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Case No. IPR2024-00983
U.S. Patent No. 11,152,882

CERTIFICATE OF SERVICE

I hereby certify that “Patent Owner’s Preliminary Response” was served on
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