UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner

v.

HAPTIC, INC.

Patent Owner

Case IPR2024-01476

U.S. Patent 9,996,738

PATENT OWNER'S RESPONSE TO PETITIONER'S NOTICE OF RANKINGS AND EXPLANTION OF DIFFERENCES BETWEEN PETITIONS

"One petition should be sufficient to challenge the claims of a patent in most situations," and multiple parallel petitions "may place a substantial and unnecessary burden on the Board and the patent owner." Consolidated Trial Practice Guide (Nov. 2019) ("TPG"), 59. Institution of parallel petitions is thus reserved for "rare" occasions. *id.* There is nothing "rare" about the circumstances here.

Petitioner has a track record of filing parallel petitions against small numbers of distinct claim sets from the same patent, on the alleged basis that all claims could "could not reasonably be addressed in a single petition." *Apple Inc. v. Koss Corp.*, IPR2021-00686, Paper 12 at 12-13 (Oct. 12, 2021). The Board has routinely rejected these efforts, finding for example that it "strains credibility" that "20 claims is a quantum of claims that could not be addressed in a single petition." *Id.; Apple Inc. v. Seven Networks, LLC*, IPR2020-00254, Paper 13 at 9-10 (July 28, 2020); *Apple Inc. v. Speir Techs. Ltd.*, IPR2023-00543, Paper 8 at 9-10 (Aug. 8, 2023).

Petitioner's position that it could not address ***thirteen (13)*** claims in a single petition likewise strains credibility. "The Board routinely receives petitions challenging more than 18 claims. Indeed, the basic filing fee … contemplates challenging up to 20 claims." *Koss*, IPR2021-00686 at 13. The Board has previously rejected Petitioner's attempt to justify a parallel petition where only 14 claims were issue. *Apple Inc. v. Resonant Systems, Inc.*, IPR2024-00808, Paper 11 at 10 (Oct. 15,

2024). Indeed, Petitioner has managed to challenge ***50 claims*** in a single petition—nearly four times the number here. *Seven Networks,* IPR2020-00254, Paper 13 at 9.

Even beyond the small number of claims at issue, there is also a considerable amount of claim overlap. For example, independent (system) claim 1 largely mirrors independent (method) claim 10, claim 6 mirrors claim 12, and claim 11 mirrors claim 13. Petitioner itself admits that independent claim 10 "corresponds substantially to the limitations of claim 1" and relies on its analysis of claim independent 1 for all but two limitations of claim 10 in both petitions. IPR2024-01475, Paper 3 ("the '475 Petition") at 37, 43, 64; IPR2024-01476, Paper 3 ("the '476 Petition") at 52-53, 62-63, 87-88. Petitioner also relies largely on its analysis of claim 6 to address claim 12. '476 Pet. 53-55. Given this overlap, the number of distinct claims is fewer than 13 and the "1,296 words" that Petitioner complains of is, in practicality, fewer than 800 words. *See DexCom, Inc. v. Abbott Diabetes Care Inc.*, IPR2023-01252, Paper 9 at 14 (Feb. 5, 2024) (finding nothing rare about 30 challenged claims roughly 1,300 words in length).

That all 13 claims could have been addressed in a single petition is even more apparent given the significant overlap between petitions. Grounds 1A-1C of the '476 Petition rely exclusively on the same combinations of Murakoshi, Stewart, Sachs and Orr that are exclusively relied on in Grounds 1A-1C of the '475 Petition. *Compare* '476 Pet. 10 *with* '475 Pet. 10. And those combinations are applied in the same manner against the independent claims in each petition. *Compare* '476 Pet. 10-36 (Murakoshi-

Stewart), 56-60 (Murakoshi-Stewart-Sachs), 64-84 (Murakoshi-Stewart-Sachs-Orr) *respectively with* '475 Pet. 10-35 (Murakoshi-Stewart), 38-42 (Murakoshi-Stewart-Sachs), 44-64 (Murakoshi-Stewart-Sachs-Orr). Both petitions also rely on the same claim constructions. '476 Pet. 6-9; '475 Pet. 5-9. Thus, all 13 claims could have easily been challenged in a single petition. *See Google LLC v. Uniloc 2017 LLC*, IPR2020-00448, Paper 11 at 8 (July 9, 2020) ("The highly duplicative nature of these two petitions and the small number of claims at issue further indicates that one petition should have been sufficient."). Indeed, "these petitions do not fall under either example circumstance supporting the need for parallel petitions set forth in the [TPG]." *See Speir Techs.*, IPR2023-00543, Paper 8 at 10. The parallel petitions are instead the sole product of Petitioner's strategic desire to dedicate more words to the asserted claims. *Id.* (discretionarily denying parallel petition where, "[a]t most, Petitioner argues that … Petitioner filed this Petition just in case Patent Owner asserts additional claims").

Even if Petitioner could not have included all asserted grounds in a single petition, discretionary denial is still warranted. The '475 Petition includes Grounds 1A-1C and Grounds 2A-2B, which independently challenge claims 1-2, 4-5 and 8-11. However, Grounds 1A-C challenge *all of those claims* under *Haptic's and Apple's proposed constructions*. Alternative Grounds 2A-2B were thus unnecessary. Petitioner cannot justify the '476 Petition given that it could have omitted Grounds 2A-2B from the '475 Petition so that all 13 claims could be challenged in that petition based on

Grounds 1A-1C, which are common to both petitions. Nor does Petitioner cite any authority for the notion that it is entitled to assert *alternative* invalidity grounds when the petition ***already has grounds addressing the same challenged claims*** under all claim constructions. *See WhatFix Inc. v. WalkMe Ltd.*, IPR2023-01443, Paper 11 at 13 (Mar. 20, 2024) ("Petitioner provides no explanation as to why … alternative challenges were necessary…."). Indeed, Petitioner clearly *could have* addressed all 13 claims in a single petition, but elected to include an unnecessary alternative ground.

Petitioner "first" argues that it was "forced to challenge all claims" because Haptic "refuses" to enter a stipulation. But it is *Petitioner's* burden to first demonstrate that rare circumstances exist justifying a parallel petition. *Intex*, IPR2023-00488, Paper 12 at 13; *Square*, IPR2019-01653, Paper 9 at 50-51. Petitioner fails to demonstrate that the 13 claims could not have reasonably been challenged ***in a single petition***. And because they easily could have been, it irrelevant whether a stipulation exists.

Petitioner "second" argues that parallel petitions are appropriate because they allegedly "address mutually exclusive groups of non-overlapping claim sets" and "materially different challenges." But as explained above, the claims are much "more similar than Petitioner suggests" and there is "a high degree of overlap between the grounds in each petition." *See Speir Techs.*, IPR2023-00543, Paper 8 at 9-10. The only reason for "mutually exclusive groups" is that Petitioner strategically divided them that way, which could be done in most IPRs to fabricate an excuse for parallel petitions.

Petitioner's "third" argument about word count is undermined by the considerable overlap of the claims. Indeed, Petitioner complains that claim 10 is 335 words, but admits in its petitions that it "corresponds substantially to the limitations of claim 1." Further, in *Visa* "a relatively high number of claims" existed (i.e., 33 claims), whereas here there are only 13 claims. *See Visa,* IPR2024-00486, Paper 8 at 2, 41; *see also Samsung Elecs. Co., Ltd. v. Maxell, Ltd.*, IPR2024-00777, Paper 12 at 7-9 (Nov. 8, 2024) (parallel petition justified where ***27*** challenged claims took up ***six*** columns).

Petitioner's "fourth" and "fifth" arguments are that the means-plus-function limitations and difference in the parties' interpretation of the claims justifies two petitions. However, both rely on the *same* constructions as applied to the *same* combinations of art in Grounds 1A-C in *the same* way. Petitioner's excuse is illogical, as the '476 Petition does not alternatively address these issues. The '476 Petition simply replicates and applies the analysis from the '475 Petition to ***5 dependent claims***.

Petitioner contends that it has "worked to fit as many claims as possible" but provides no explanation for why it could not have proceeded with Grounds 1A-1C against *all* claims in a single petition, omitting alternative Grounds 2A-2B. Petitioner's "efficiency" argument also fails, as "[i]t is beyond dispute that instituting a second IPR proceeding will result in additional burden on Patent Owner and the Board." *PainTEQ, LLC v. Orthocision, Inc.*, IPR2023-00477, Paper 7 at 11 (July 12, 2023). "Rare" circumstances do not exist—the '476 Petition should be discretionarily denied.

Dated: January 10, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4), the undersigned certifies that on January 10, 2025, the foregoing document was served via electronic mail on the following attorneys of record at the indicated e-mail address, which Petitioner has consented to electronic service for:

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