

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple Inc.,

Petitioner,

v.

LS Cable & System Ltd.

Patent Owner.

CASE: IPR2025-01141

U.S. PATENT NO. 8,013,568

PATENT OWNER'S ARGUMENT FOR DISCRETIONARY DENIAL

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE PETITION SHOULD BE DISCRETIONARILY DENIED	2
a.	Discretionary Denial Is Appropriate Under the “Relevant Considerations” Identified in the Guidance.....	3
1.	The Parties’ Expectations for the 14-Year Old ’568 Patent.....	3
2.	The PTO Affirmed the Patentability of the Challenged Claims During <i>Ex Parte</i> Reexamination	5
b.	Discretionary Denial is Appropriate Under 35 U.S.C. § 325(d)	6
c.	The <i>Fintiv</i> Factors Also Favor Discretionary Denial.....	15
1.	Petitioner Has Not Sought a Stay, Favoring Denial.....	15
2.	Proximity of the Court’s Trial Date Is Neutral.....	16
3.	The Advanced Parallel Proceeding Favors Denial.....	17
4.	Petitioner’s <i>Sotera</i> -type Stipulation Favors Denial or is Neutral.....	17
5.	The Parallel District Court Proceeding Favors Denial.....	19
6.	The Additional Factors Outlined Herein Favor Denial.....	19
III.	CONCLUSION	19

TABLE OF PATENT OWNER EXHIBITS

Exhibit No.	Description
2001	LS Cable's Complaint in <i>LS Cable & System Ltd v. Apple Inc.</i> , 4:24-cv-09194 (N.D. Cal.) (Dkt. No. 1)
2002	Information Disclosure Statement dated April 14, 2019, in Application No. 16/258,464
2003	Information Disclosure Statement dated May 26, 2021, in Application No. 16/983,866
2004	Correspondence from Apple Counsel K. Grewal dated July 13, 2020
2005	Korean Patent No. KR950005819 to Hong Chung-Sik
2006	English translation of Korean Patent No. KR950005819 to Hong Chung-Sik
2007	Non-final Office Action dated June 30, 2021, rejecting claims as anticipated and obvious over <i>Chung-Sik</i>
2008	Final Office Action dated March 3, 2022, rejecting claims as anticipated and obvious over <i>Chung-Sik</i>
2009	Notice of Intent to Issue Reexamination Certificate
2010	Joint Claim Construction & Prehearing Statement in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.) (Dkt. No. 39)
2011	Joint Case Management Statement in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.) (Dkt. No. 31)
2012	Order setting case deadlines in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.) (Dkt. No. 32)
2013	Certificate of Service of Party Discovery in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.)

Exhibit No.	Description
2014	Proof of Service of Party Discovery in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.)
2015	Notice of Service of Party Discovery in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.)
2016	Proof of Service of Party Discovery in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.)
2017	Notice & Subpoena to Third Party Alticor in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.)
2018	Notice & Subpoena to Third Party Epson America in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.)
2019	Notice & Subpoena to Third Party Amway in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.)
2020	Notice & Subpoena to Third Party Fulton Innovation in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.)
2021	Notice & Subpoena to Third Party Gillete Co. in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.)
2022	Notice & Subpoena to Third Party P&G in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.)
2023	Notice & Subpoena to Third Party Phillips North America in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.)
2024	Notice & Subpoena to Third Party Amway in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.)
2025	Apple's Patent Local Rules 3-3 and 3-4 Disclosures in <i>LS Cable & System Ltd. v. Apple Inc.</i> , 3:24-cv-09194 (N.D. Cal.)

Patent Owner LS Cable & System Ltd. (“LS Cable” or “PO”), submits this Paper regarding discretionary denial pursuant to the Board’s guidance on “Interim Processes for PTAB Workload Management,” dated March 26, 2025 (“Guidance”).

I. INTRODUCTION

U.S. Patent No. 8,013,568 (the “’568 Patent”) issued over fourteen years ago and was subsequently the subject of *Ex Parte* Reexamination Control No. 96/000,355 (the “Reexam Proceeding”), where certain claims were amended and re-allowed after careful scrutiny by the United States Patent & Trademark Office (“PTO”). PO first brought the ’568 Patent to Petitioner’s attention over six years ago, in 2019. Ex. 2001, ¶¶ 33-34. Apple has cited the ’568 Patent and the publication leading to the ’568 Patent during prosecution of its own patents since at least January 2019. Apple chose not to challenge the ’568 Patent until now.

Under the prior discretionary denial standards (including the standards under 37 C.F.R. §42.104(b)(3) regarding claim construction burdens), and pursuant to the new factors in the Guidance (and cases decided under the Guidance: *Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025) and *iRhythm Technologies, Inc. v. Welch Allyn*, IPR2025-00363, -00374, -00376, -00377, -00378, Paper 10 (P.T.A.B. June 6, 2025)), the Petition should be denied to better allocate resources elsewhere. The heavy burden that the Petition’s

multiple challenges to 57 claims of the '568 Patent place on the PTO warrant the Director exercising discretion to deny the Petition. Additionally, the Petition does not present new or substantially different prior art or arguments compared to what was previously considered by the PTO during the Reexam Proceeding. Therefore, under 35 U.S.C. § 325(d), discretionary denial is warranted.

Further, as detailed below, the precedential decision of *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) favors utilizing the discretionary power of the Director to deny institution.

Finally, while Petitioner filed a *Sotera* stipulation (Paper 5), this IPR proceeding is not a “true alternative” to the district court proceeding where Petitioner’s invalidity arguments are more expansive and include combinations of the prior art asserted here with unpublished system prior art.

PO respectfully submits that the Petition is not a good use of the Board’s time and resources. To maintain statutory deadlines in existing proceedings, and the workload needs of the PTAB, the Petition should be denied so resources can be allocated to petitions that better adhere to the Trial Practice Guide’s framework.

II. THE PETITION SHOULD BE DISCRETIONARILY DENIED

The Board’s Guidance provides that “to facilitate [the] bifurcated approach, the USPTO will permit parties to file separate briefing on requests for discretionary

denial of institution.” Guidance, 2. The Guidance allows Patent Owners to address grounds for discretionary denial including: (a) “relevant considerations” now identified in the Guidance; and (b) “discretionary considerations enumerated in existing Board precedent.” *Id.* PO respectfully submits that discretionary denial is appropriate under both sets of considerations. Last, as addressed in Section (b) below, the *Fintiv* factors also favor discretionary denial of the Petition.

a. Discretionary Denial Is Appropriate Under the “Relevant Considerations” Identified in the Guidance.

Several of the Guidance’s considerations support a denial here, including the: (1) settled expectations of the parties, such as Petitioner’s long-standing awareness of the ’568 Patent; (2) PTO’s issuance of the reexamination certificate affirming the patentability of the ’568 Patent; and (3) strength of the unpatentability challenge.

1. The Parties’ Expectations for the 14-Year Old ’568 Patent.

The ’568 Patent issued in 2011 and claims priority to 2005. Ex. 1001, Cover. The ’568 Patent’s reexamination certificate issued on September 28, 2023, confirming the patentability of amended and allowed Claims 1, 3-24, and allowing new Claims 25-58. Ex. 1002.

As of the filing of the Petition, the ’568 Patent had been in force for fourteen years. *See Dabico*, IPR2025-00408, Paper 21 (*sua sponte* denying institution where challenged patent was in force 7+ years). This alone is a basis to deny institution.

The '568 Patent's early priority date allowed it to serve as prior art to many patent applications in the industry, including Petitioner's own filings. Despite unequivocally knowing of the '568 Patent and its subject matter for at least 6.5 years, Petitioner did nothing, creating an expectation between the parties. This is underscored by the fact that in March 2019, PO sent a letter notifying Apple that certain of its wireless charging products infringed the '568 Patent. Ex. 2001, ¶ 33.

Shortly after receiving this letter, and at least by April 14, 2019, Petitioner began listing the '568 Patent in information disclosure statements ("IDS") in its then-pending applications, such as U.S. Patent Application No. 16/258,464, indicating Petitioner's awareness of the '568 Patent. Ex. 2002, 1 (IDS at entry No. 1). After *ex parte* reexamination was ordered for the '568 Patent, Petitioner submitted an IDS citing the '568 Patent during prosecution of a different application, Application No. 16/983,866. Ex. 2003, 1 (IDS at entry No. 32).

Petitioner responded to PO's March 2019 letter, but neither ceased its infringing activity nor filed an IPR at that time. Then, in 2020 PO provided Petitioner a claim chart outlining Petitioner's infringement of certain claims of the '568 Patent. Ex. 2001, ¶ 34. Still, Petitioner did not file an IPR. This specific awareness sets this case apart from the *sua sponte* decision in *Dabico*, IPR2025-00408, Paper 21, where the mere age of the patent was sufficient to deny institution.

Here, direct documentary evidence shows Petitioner knew of the '568 Patent and took no action regarding it, resulting in a long period of awareness and not challenging the '568 Patent. By delaying at least six and a half years from the date it first learned of the '568 Patent (not to mention the full fourteen years since the '568 Patent's issuance), Petitioner created an implicit expectation between the parties: an acquiescence to the '568 Patent's patentability. The delay from the '568 Patent's issuance favors exercising discretion and denying this Petition.

2. The PTO Affirmed the Patentability of the Challenged Claims During *Ex Parte* Reexamination

Petitioner seeks to re-hash what the PTO already affirmed: the patentability of the '568 Patent's claims. The PTO affirmed the patentability of the challenged claims during reexamination and issued a reexamination certificate. Ex. 1002.

One relevant consideration under the Guidance is “whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims.” Guidance, 2. The challenged claims were determined to be patentable during the Reexam Proceeding over prior art that Apple itself identified. Ex. 1002; Ex. 2004. The Supreme Court has characterized “district court challenges, *ex parte* reexaminations, and IPRs as different forms of the same thing—reexamination.” *See Celgene Corp. v. Peter*, 931 F.3d 1342, 1361 (Fed. Cir. 2019). PO initiated the supplemental examination that led to the Reexam Proceeding

because it was the proper post-grant patent correction vehicle for affirming the '568 Patent's patentability—not this untimely IPR.

The amendments made during reexamination were substantively minor and did not fundamentally alter the scope of the challenged claims. Ex. 1002. Petitioner contends that “the challenged claims are invalid under any reasonable interpretation” (though, Petitioner does not actually provide any claim construction analysis), demonstrating that the clarifying amendments made during reexamination do not materially alter the core subject matter of the claims.

The totality of circumstances, including the Petitioner's prior knowledge of the '568 Patent and the nature of the amendments made during reexamination of the '568 Patent, should guide the exercise of discretion to grant discretionary denial and deny institution of the Petition.

b. Discretionary Denial is Appropriate Under 35 U.S.C. § 325(d)

Each ground rest on a prior art reference—*Baarman*-878 (Grounds 1 and 2) and *Baarman*-267 (Ground 3)—that is cumulative of the prior art already overcome during the Reexam Proceeding. *Baarman*-878 and *Baarman*-267 are not substantively different than Korean Patent No. KR950005819 to Hong Chung-Sik (Ex. 2005; Ex. 2006) (“*Chung-Sik*”), which the Examiner used to rigorously evaluate the '568 Patent's claims. *See, e.g.*, (Ex. 2007, 2008, 2009).

The Petition should be denied because all three grounds are based on “substantially the same prior art or arguments’ previously presented to the [Patent] Office.” *Adv. Bionics LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 9 (P.T.A.B. Feb. 13, 2020) (quoting 35 U.S.C. § 325(d)). *Baarman-878* and *Baarman-267* are each cumulative of *Chung-Sik*, as detailed in the table below, which provides examples of the cumulative nature of the references.

Comparison: Petition’s Cited Art vs. Art Cited During Reexam Proceeding	
<i>(1) Contactless Charging Systems Using Inductive Coupling</i>	
<i>Baarman-878 (Ex. 1007)</i>	<i>Chung-Sik (Ex. 2006)</i>
“This invention relates generally to <i>contactless power supplies</i> , and more specifically to contactless power supplies capable of communicating with any devices receiving power from the contactless power supplies. Contactless energy transmission systems (CEETS) <i>transfers electrical energy from one device to another without any mechanical connection.</i> ” Ex. 1007, 1:33-39 (emphasis added). ¹	“The present invention relates to a <i>contactless charge system</i> of a radio-telephone for charging a battery in a portable device without contact between <i>a charger of a radio-telephone and a voltage terminal of the portable device.</i> ” Ex. 2006, 8-1.
“One kind of CEETS <i>uses magnetic induction to transfer energy.</i> ” Ex. 1007, 1:52-53.	“Another objective of the present invention is to provide a system for <i>charging a battery in a portable device by inductively coupling a voltage from a charger to a portable device.</i> ” <i>Id.</i> at 8-2.
“Contactless power supply 305 is <i>inductively coupled</i> to remote device 306.” <i>Id.</i> at 7:24-25.	“[A]n electromagnetic field output from the <i>induced voltage generating unit of the</i>
<i>Baarman-267</i>	
“This relates generally to electronic devices, and more specifically to the <i>contactless supply of power and communication to an electronic device.</i> ” Ex. 1014, 1:25-27.	

¹ All emphasis added unless noted otherwise.

<p>“When the adaptive power interface has an adjustable element, then the contactless power supply will be set to an optimal setting for the adjustable element. If the adjustable element is a variable inductor, and the step of determining an optimal setting for the adjustable element comprises determining the optimal inductance setting for the variable inductor.” <i>Id.</i> at 3:19-25.</p> <p>“FIG. 6 illustrates an adapter for connection to a remote device. As shown, three coils 202, 204, 206 are connected in parallel to the load. The three coils could be orthogonally configured, as described in patent application Inductive Coil Assembly, assigned to the assignee of this application, and filed on the same day as this application. Capacitors 206, 208, 210 and diodes 212, 214, 216 are connected in series with each coil 200, 202, 204. The values of the various components are selected to provide a resonant frequency. The power induced within each of coil 202, 204, 206 is combined at the input of power regulator 218. Alternatively, diodes 212, 214, 216 can be eliminated from the circuit 680 to provide AC power to power regulator 218. Power regulator 218 regulates the voltage and current available at terminals 220, 222. Terminals 220, 222 are for connection to the power input of a remote device.” <i>Id.</i> at 6:1-16.</p>	<p>charging device is inductively coupled to the induced voltage rectifying unit within the portable device when the portable device is placed on the charging device.” <i>Id.</i></p>
(2) Primary and Secondary Coil Implementation	
Baarman-878	Chung-Sik
<p>“One kind of CEETS uses magnetic induction to transfer energy. Energy from a primary winding in the power supply is transferred inductively to a secondary winding in the chargeable device. Because the secondary winding is physically spaced from the primary winding, the inductive</p>	<p>“[W]hen the two devices are coupled to each other, the induced voltage generating unit 46 of the power transmitter 28 and the induced voltage detecting unit 81 of the</p>

coupling occurs through the air.” Ex. 1007, 1:51-57.	contactless charging unit 38 are <i>inductively coupled to each other in the manner that primary and secondary circuits of a general transformer are inductively coupled to each other.</i> ” Ex. 2006, 8-3.
Baarman-267	
<p>“FIG. 6 illustrates an adapter for connection to a remote device. As shown, three coils 202, 204, 206 are connected in parallel to the load. The three coils could be orthogonally configured, as described in patent application Inductive Coil Assembly, assigned to the assignee of this application, and filed on the same day as this application. Capacitors 206, 208, 210 and diodes 212, 214, 216 are connected in series with each coil 200, 202, 204. The values of the various components are selected to provide a resonant frequency. The power induced within each of coil 202, 204, 206 is combined at the input of power regulator 218. Alternatively, diodes 212, 214, 216 can be eliminated from the circuit 680 to provide AC power to power regulator 218. Power regulator 218 regulates the voltage and current available at terminals 220, 222. Terminals 220, 222 are for connection to the power input of a remote device.” Ex. 1014, 6:1-16.</p>	<p>“AC flowing in the coil 77 in the induced voltage generating unit 46 changes over time, and thus, an AC voltage depending on a time change ratio of flux linkage is induced at both terminals of the coil 79 in the induced voltage detecting unit 81. That is, according to the principle of inductive coupling, an AC voltage in the coil 77 is inductively output to opposite ends of the coil 79 in the induced voltage detecting unit 81. The AC voltage output from the opposite terminals of the coil 79 is applied to an AC voltage terminal of a bridge diode 80, and is output with full-wave rectification. The DC voltage which is full-wave rectified at the bridge diode 80 is smoothened out by a capacitor 82 and is output as a ripple current voltage (IDC). In this case, the rectified voltage IDC is input to a first voltage splitter 89, simultaneously limited to a</p>

<p>also determined based primarily on the characteristics of the load.” <i>Id.</i> at 6:17-30.</p> <p>“[C]oils 270, 272, 274 are connected in parallel to power regulator 276 through an arrangement of diodes 278, 280, 282, 284, 286, 288, 290, 292, 294, 296, 298, 300. In this embodiment, the value of each diode 278, 280, 282, 284, 286, 288, 290, 292, 294, 296, 298, 300 is determined based primarily on the characteristics of power regulator 276. Power regulator 276 provides a relatively constant voltage and current output at terminals 271, 273. Additionally, each capacitor 302, 304, 306 is connected in series between one side of the respective coil 270, 272, 274 and the corresponding diodes 282, 284, 290, 292, 296, 300. The value of each capacitor 302, 304, 306 is determined based primarily on the characteristics of power regulator 276. Power regulators 218, 246, 276 are able to provide at their respective output terminals a constant voltage and constant current, even when the power derived from the coils is operating at different frequencies. CPS 10 may provide power at different frequencies. Thus, the current and voltage induced in the respective coils of the adapter could also have different currents and voltages. Power regulators 218, 246, 276 are designed to accommodate the difference in the current and voltage produced by the coils.” <i>Id.</i> at 6:31-44.</p>	<p>predetermined level through the resistor 84 and the diode 86, then applied to the battery 32. That is, the battery 32 is charged. In the above case, the resistor 84 is a current limiter resistor, and the diode 86 is a diode for preventing countercurrent when the voltage IDC is lower than a voltage of the battery 32.” <i>Id.</i> at 8-4.</p>
<i>(3) Microprocessor-Based Control</i>	
<i>Baarman-878</i>	<i>Chung-Sik</i>
<p>“The adaptive inductive ballast 10 generally includes <i>a microprocessor 12 that controls operation of the circuit</i>[.]” Ex. 1007, 4:2-3.</p> <p>“In general operation, <i>the microprocessor 12 is programmed to receive input from the current</i></p>	<p>“48 is a first <i>microcomputer for providing the control signal (SCTL) to a control terminal</i> of the voltage switching unit 44 <i>in response</i></p>

<p><i>sense subcircuit 18</i>, which is indicative of the current applied to the primary 14. The <i>microprocessor 12 is programmed to separately adjust the capacitance switch 20 and the inductance switch 22</i> to cycle through the range of capacitance values and inductance values available to the circuit. The microprocessor 12 continues to monitor the input from the current sense circuit 18 while adjusting the capacitance and inductance values to determine which values provide optimum current to the primary 14. The microprocessor 12 then locks the adaptive ballast into the optimum settings.” <i>Id.</i> at 4:42-52.</p> <p>“The capacitance switch 20 generally includes two banks of capacitors and a plurality of switches, such as transistors, that are selectively actuatable by the microprocessor 12 to control the values of the two capacitor banks.” <i>Id.</i> at 4:14-17.</p> <p>“The inductance switch 22 generally includes a multi-tap primary 14 and a plurality of switches, such as transistors, that are selectively actual by the microprocessor 12 to control the values of the inductance of the primary 14.” <i>Id.</i> at 4:29-32.</p> <p>“Circuit sensor 324 is coupled to the output of tank circuit 314. Circuit sensor 324 is also coupled to controller 326. Circuit sensor 324 provides information regarding the operational parameters of the power supply.” <i>Id.</i> at 7:56-59.</p>	<p><i>to input of a hand-set status signal (HSS)</i> of the aforementioned charge switch 30, and <i>blocking output of the control signal (SCTL)</i> according to a <i>heat detection signal of the thermostatic switch 74</i>. Reference numeral 50 is an induced voltage rectifying unit ... includ[ing] an induced voltage detecting unit 81 that is inductively coupled to the induced voltage generating unit 46[.]” Ex. 2006 at 8-3.</p> <p>“The induced voltage rectifying unit 50 includes a core 78 and a coil 79 wound around the core 78, and includes an induced voltage detecting unit 81 that is inductively coupled to the induced voltage generating unit 46, and a rectifier 80 for rectifying a voltage output from the coil 79 of the induced voltage detecting unit 81.” <i>Id.</i> at 8-3.</p>
<p style="text-align: center;"><i>Baarman-267</i></p>	
<p>“Adapter 14 contains adapter controller 38. <i>Adapter controller 38 controls the various components of adapter 14. Adapter controller 38 could be any one of a multitude of commonly available microcontrollers</i> programmed to perform the functions hereinafter described, such</p>	<p>“[T]he second microcomputer 56 that scans the output VDL of the comparator 96 and searches for whether or not the charge voltage is normal determines that the charge voltage of the battery 32 is normal. That is, a voltage of</p>

<p>as the Intel 8051 or the Motorola 6811, or any of the many variants of those microcontrollers. Adapter controller 38 could have a ROM (read only memory) and RAM (random access memory) on the chip. Adapter controller 38 could have a series of analog and digital outputs for controlling the various functions within adapter 14. Adapter controller 38 is connected to contactless power interface 40. Alternatively, <i>adapter controller 38 could be a microprocessor in association with a microcontroller.</i> Ex. 1014, 3:52-65.</p>	<p>the battery 32 is determined to be completely charged to a set voltage level, and a charge completion alarm signal is output through line 37 in operation 122. The charge completion alarm signal through line 37 is transmitted to the base unit 12 through the audio and logic unit 36 and the radio unit 34, and the radio unit 25 and the audio and logic unit 24 of the base unit 12 receive and demodulate the signal and input the signal to the first microcomputer 48 through the line 49. The first microcomputer 48 that receives a data signal through the line 49 determines that the charge completion signal is received from the portable device 18 in the aforementioned operation 110 of FIG. 3A (the portable device is normal), and performs operation 112.” <i>Id.</i> at 8-5.</p>
<i>(4) Communication Between Charger and Device</i>	
<i>Baarman-878</i>	<i>Chung-Sik</i>
<p>“[T]he system allows the optimization of both the power supply as well as the device attached to the power supply. The contactless power and remote devices operate by each remote device sending power usage information to the controller and then adapting the contactless power supply in response</p>	<p>“[T]he first microcomputer 48 which has performed the aforementioned operation 104 of FIG. 3A reads a state signal of the thermostatic switch 74 which is input to input port P2,</p>

<p>to the power usage information.” Ex. 1007, 3:9-14.</p> <p>“[C]ontactless power supply 305 determines whether the status of any device has changed. Step 410. For example, remote device 338 could have a rechargeable battery. When the rechargeable battery is fully charged, remote device 338 would no longer need power. Thus, its status would change from “Charging” to “Off.” If the status of the device changes, then the remote device list is updated. Step 412. Contactless power supply 305 then determines if any devices are present. Step 414. If so, then the remote device list is updated. Step 416. The remote device list is then checked. Step 418. If the list was not updated, the system then polls the devices again, and the process restarts. Step 402.” <i>Id.</i> at 10:38-49.</p> <p>“The adaptation of the contactless power supply includes changing the duty cycle, the inverter frequency, the resonant frequency, or the rail voltage. The power supply could also determine whether the contactless power supply is capable of supplying power to the plurality of remote devices. If not, some of the remote devices could be turned off.” <i>Id.</i> at 3:14-20.</p>	<p>and searches for whether or not the temperature is normal. In this case, the thermostatic switch 74 is a switch that is switched by detecting heat generated by the induced voltage generating unit 46. When the induced voltage generating unit 46 is overloaded, the temperature increases to a predetermined temperature, causing the internal switch to be opened. When the thermostatic switch 74 is opened, the input port P2 of the first microcomputer 48 is converted to a ‘high’ state level from ‘low.’” Ex. 2006, 8-5.</p> <p>“[A] battery begins to be charged from a time point when the portable device 18 operated at an operating voltage of the battery is installed on the base unit 12, and the charge operation may be automatically stopped either by communication between devices or overheating of the devices. As described above, according to the present invention, a battery may be charged with a voltage through a configuration based on inductive coupling, thereby preventing loss of charge function, which may occur in a</p>
<i>Baarman-267</i>	
<p>“At this time, charging information is obtained from remote device 12. Step 108. Charging information could include amount of charge remaining within rechargeable power source 20, the time to recharge the rechargeable power source 20, the voltage requirements of remote device 12 to charge rechargeable power source 20, and the current requirements of remote device 12 to charge rechargeable power source 20. Adapter 14 then provides this charging information to CPS 10. Step</p>	<p>may be automatically stopped either by communication between devices or overheating of the devices. As described above, according to the present invention, a battery may be charged with a voltage through a configuration based on inductive coupling, thereby preventing loss of charge function, which may occur in a</p>

110. CPS 10 then calculates the optimal setting for contactless power interface 40. Step 112. CPS 10 could provide that information to adapter 14. Alternatively, adapter 14 could retrieve similar information from remote device 12. Step 114. Adapter controller 38 then configures contactless power interface 40. Step 116. It could be that rechargeable power source 20 is charged or cannot be charged. In that case, CPS 10 would configure adapter 14 to supply no power to remote device 12.” Ex. 1014, 5:1-17.	charging method involving electric contacts, and preventing risk of electric shock, allowing for stable charging.” <i>Id.</i> , 8-5. “The second microcomputer 56 that receives the power information transmitted from the first microcomputer 48 of the base unit 12 reads the output VDL of the comparator 96 and searches for whether or not a charge voltage of the battery 32 is normal in an operation 120[.]” <i>Id.</i> , 8-4.
--	---

As shown, the primary references relied upon by the Petitioner were effectively already evaluated and addressed by the Examiner during reexamination, supporting denial under 35 U.S.C. § 325(d). While the Petition’s references were not themselves part of any rejection, the Petition undertakes no effort to explain why its *Baarman*-878 and *Baarman*-267-based challenges are not cumulative of the information that has already been considered during reexamination. *Gardner Denver v. Utex Indus., Inc.*, IPR2020-00333, Paper 12 at 13-14 (P.T.A.B. Aug. 5, 2020) (denying institution upon finding newly asserted references no more relevant than references presented during prosecution); *Roku, Inc. v. Universal Elecs., Inc.*, IPR2019-01619, Paper 11, 16-17 (P.T.A.B. April 2, 2020) (denying institution

upon finding newly applied reference cumulative to previously presented reference, despite previous reference addressing different limitations).

The Petition makes no attempt to show any error made by the Examiner in issuing the reexamined claims over the art to which the Petition's relied-upon references are cumulative. The Petition's failure to do so cannot be cured through additional papers *ex post facto*.

c. The *Fintiv* Factors Also Favor Discretionary Denial.

1. Petitioner Has Not Sought a Stay, Favoring Denial.

This factor, unaddressed in the Petition, is either neutral (as the PTAB must speculate whether a stay would be granted to the extent asked for) or favors using discretion to deny the Petition (as no stay has been sought). The underlying district court litigation, filed in December 2024, has been pending for over eight months.

Regardless, should the Board require background on court issued stays, California courts have denied motions to stay where the patent owner would be prejudiced due to the district court case's posture. *See, e.g., Maxell, Ltd. v, LG Elecs. Inc.*, No. 5:24-cv-04972-NW, at *6-*8 (N.D. Cal. Apr. 25, 2025) (finding prejudice for patent owner and denying motion to stay where petitioner filed motion three days after filing petition because district court case was far into discovery and in the midst of claim construction). The parties have exchanged over 510,000 pages of

documents. The parties have also exchanged infringement, invalidity, and damages contentions, exchanged requests for production and interrogatories (Exs. 2013-2016), filed their Joint Claim Construction and Prehearing Statement (Ex. 2010), and completed claim construction discovery (Ex. 2011). Like *Maxell*, PO here would be prejudiced if a stay were entered in the district court case.

If the Director is unpersuaded regarding whether a stay would or would not be granted where no stay has been sought, any evidence on this factor is at best neutral. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (P.T.A.B. May 13, 2020) (precedential), cautions against speculating whether the district court would grant a stay if one were requested.

2. Proximity of the Court's Trial Date Is Neutral.

The court has not set a date for trial as it has only approved the agreed-upon case deadlines in the parties' Joint Case Management Statement ("JCMS") through December 2025. Ex. 2012. The parties submitted competing proposals for the trial date, including September 28, 2026 (PO's proposal) and March 15, 2027 (Petitioner's proposal). Ex. 2011. As *Fintiv* outlines, "if the court's trial date is at or around the same time as the projected statutory deadline ... or even significantly after the projected statutory deadline, the decision whether to institute will likely implicate other factors." IPR2020-00019, Paper 15 at 9. This factor is neutral.

3. The Advanced Parallel Proceeding Favors Denial.

As discussed above, even at this pre-institution decision stage, both parties have served and pursued discovery in the district court proceeding. Exs. 2013-2016. Petitioner has pursued extensive third-party discovery. *See, e.g.*, Exs. 2017-2023. By the time the institution decision is due, the Claim Construction Hearing will have passed, and the completion of fact discovery will be one to two months away. Ex. 2011. Petitioner's (not insignificant) efforts in the district court case imply that the district court has become Petitioner's preferred venue for this dispute. To date, the parties have expended significant time and resources, favoring discretionary denial.

4. Petitioner's *Sotera*-type Stipulation Favors Denial or is Neutral.

While Petitioner filed a *Sotera*-type² stipulation, the stipulation does not “materially reduce[] overlap between the” IPR and the district court case rendering this factor neutral or favoring denial. USPTO, Interim Director Discretionary Process, § I.D., <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process> (updated Aug. 22, 2025). This is because “[P]etitioner is relying on corresponding system art in [the] co-pending proceeding[,]” as well as “several other

² *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-0109, Paper 12 (P.T.A.B. Dec. 1, 2020).

invalidity theories,” and therefore the “stipulation [is] not [] particularly meaningful because the efficiency gained by any AIA proceeding will be limited.” *Id.*

Petitioner admits that it intends to raise other invalidity theories in the district court proceeding that “cannot be raised in an IPR,” including, for example, invalidity under 35 U.S.C. § 112. Petition, 3. Petitioner ignores that it also relied on at least ten additional prior art references in its invalidity contentions, as well as “Applicant Admitted Prior Art,” that are not relied on in the Petition. Ex. 2024, 5-7. Petitioner also included invalidity theories based on prior art sales and public use of at least five prior art systems. Ex. 2025, 6-7. Petitioner’s district court invalidity theories, which include over one million proposed obviousness combinations, “are more expansive and include combinations of the prior art asserted in these proceeding with unpublished system prior art, which Petitioner’s stipulation is not likely to moot.” *See Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, -01206, -01207, 01208, Paper 19 (P.T.A.B. Mar. 28, 2025) (granting patent owner’s discretionary denial request where petitioner’s stipulation reduced but did not eliminate other inefficiencies weighing against institution).

Because the parallel district court action remains a viable option for Petitioner to address the validity of the ’568 Patent, and because its *Sotera*-type stipulation does not move the needle, this factor favors discretionary denial or is neutral.

5. The Parallel District Court Proceeding Favors Denial.

Petitioner here is the defendant in the parallel district court litigation, this factor favors denial of institution under § 314(a). *See Sotera Wireless, Inc.*, IPR2020-01019, Paper 12 at 19. Moreover, “proceeding in parallel with the district court litigation is an inefficient use of our time and resources.” *NHK Spring Co., LTD., v. Intri-plex Techs., Inc.*, IPR2018-00752, Paper 8 at 11 (P.T.A.B. Sept. 12, 2018) (precedential).

6. The Additional Factors Outlined Herein Favor Denial.

Fintiv provides for the analysis of “other factors,” including those outlined in detail above. Given these “other factors” favor discretionary denial, so too does this factor of the *Fintiv* analysis. As Factor 3, 4, 5, and 6 favor denial, Factor 2 is neutral, and Factor 1 either favors denial or is neutral, the *Fintiv* analysis favors discretionary denial. Even if Factors 2 and/or 3 are found to weigh against the Director’s discretion to deny the Petition, the overall balance of the factors still favor denial.

III. CONCLUSION

Under the factors set forth in the Guidance, including those articulated in *Advanced Bionics*, *Fintiv*, and *NHK*, Patent Owner respectfully requests that the Petition be denied as an inefficient use of the Board’s time and resources.

Dated: September 8, 2025

Respectfully submitted,

By: /Erik J. Halverson/
Erik J. Halverson
Reg. No. 73,552
K&L GATES LLP
Four Embarcadero Center, Suite 1200
San Francisco, CA 94111
T: (415) 882-8238
F: (415) 882-8220

Counsel for Patent Owner

Certification of Word Count Under 37 C.F.R. § 42.24(d)

The undersigned hereby certifies that the foregoing contains 5,202 words according to the word count of the word-processing software used to prepare the foregoing and accounting for the words in the figures as required by the Trial Practice Guide.

By: /Erik J. Halverson/
Erik J. Halverson
Reg. No. 73,552
K&L GATES LLP
Four Embarcadero Center, Suite 1200
San Francisco, CA 94111
T: (415) 882-8238
F: (415) 882-8220

Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on September 8, 2025, I caused a true and correct copy of the foregoing to be served on the following counsel of record for Petitioner by electronic mail to the following addresses:

MORRISON & FOERSTER LLP

Alex S. Yap
Registration No.: 60,609
707 Wilshire Boulevard, Suite 6000
Los Angeles, CA 90017
Tel: (213) 892-5688
Fax: (213) 892-5454
Email: AYap@mofo.com
Email: Apple-LSCable-IPR@mofo.com

Mehran Arjomand
Registration No.: 48,231
707 Wilshire Boulevard, Suite 6000
Los Angeles, CA 90017
Tel: (213) 892-5630
Fax: (213) 892-5454
Email: MArjomand@mofo.com

Bryan Blumenkopf
Registration No.: 73,282
12531 High Bluff Drive, Suite 200
San Diego, CA 92130
Tel: (213) 892-5269
Fax: (213) 892-5454
Email: BBlumen@mofo.com

By: /Erik J. Halverson/
Erik J. Halverson
Reg. No. 73,552