

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2020-00200

U.S. Patent No. 10,084,991

**PATENT OWNER'S REDACTED SUR-REPLY IN *INTER PARTES*
REVIEW OF U.S. PATENT NO. 10,084,991**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
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Case IPR2020-00200
Patent No. 10,084,991
Patent Owner's Sur-Reply

PATENT UPDATED OWNER'S EXHIBIT LIST

Description	Exhibit #
October 9, 2018 Notice Letter from Maxell to Apple	2001
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May 31, 2019 Scheduling Order	2003
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January 8, 2020 Minute Order	2005
March 18, 2020 Markman Order	2006
August 28, 2019 Minute Order	2007
September 17, 2019 Minute Order	2008
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Apple's Final Election of Prior Art	2011
Apple's Invalidity Contentions	2012
Asmussen Chart from District Court Action	2013
March 6, 2017 Scheduling Order from Maxell v. ZTE	2014
March 19, 2018 Scheduling Order from Maxell v. ZTE	2015
Docket from District Court Action	2016
Standing Order re COVID-19	2017
April 20, 2020 Scheduling Order from District Court Action	2018
Declaration of Tiffany A. Miller	2019
Transcript of September 28, 2020 Deposition of Dr. Lippman	2020
Declaration of Dr. Maja Bystrom	2021
U.S. Patent No. 7,864,051	2022

I. INTRODUCTION

Apple's Reply fails to tackle the flaws in the prior art and motivations to combine the references set forth in the Petition.

Regarding the "network interface" limitation in claim 1(a), Apple fails to demonstrate that Asmussen discloses this limitation alone. Apple's expert, Dr. Lippman does not address key technical issues that undercut his opinions that receiver 750 of Figure 30 could be integrated with tuner 603 (in Figures 11a or 12) to meet the network interface limitation. Nor should the Board consider Apple's belated "Asmussen in combination with Lindstrom" Ground demonstrating claim 1(a) is met as such ground was not raised in the Petition.

Regarding the "rendering the camera operative" limitation in claim 1(e), Apple fails to demonstrate that Asmussen alone or in combination with Bear disclose this limitation. Indeed, the Board preliminarily determined that Asmussen alone does not disclose the "rendering the camera operative" limitation. *See* Institution Decision, at 64. Moreover, as to the Asmussen and Bear combination, the proposed motivations to combine are hindsight reconstructions that use the '991 Patent "as a guide through the maze of prior art references" and should be rejected.

Finally, Apple's arguments as to Marley are either moot (claim 1(c)) or rely on its expert's opinions rooted in hindsight, which should be accorded no weight (claim 5).

Accordingly, for the reasons discussed herein and in Patent Owner's Response, Apple has failed to carry its burden to show that any challenged claim of the '991 Patent is unpatentable.

II. APPLE FAILS TO SHOW THAT ASMUSSEN ALONE OR COMBINED WITH BEAR AND LINDSTROM RENDERS OBVIOUS THE CLAIMED "NETWORK INTERFACE"

A. Asmussen Alone Does Not Disclose a "Network Interface"

Asmussen alone does not render the network interface limitation obvious. Apple has misconstrued Patent Owner's response to the mapping of the limitation in the Petition, and Dr. Lippman does not explain how it would be possible, much less obvious to a POSITA, to combine receiver 750 together with tuner 603 in Asmussen Fig. 12a or Fig. 11 to form a network interface. *See* Reply at 1-10; Ex. 1003, ¶¶109-119; *see also* Institution Decision 46-53.

For example, Dr. Lippman states:

Figure 12a is an exemplary embodiment of how the receiver 750 and the transmitter 730 would be integrated into the set top terminal. Figure 12a is generally referring to the level A, B and C hardware upgrades (*see Asmussen*, 5:24-25), but Fig. 12a's disclosure of

including receiver components 601 indicates to me that *Asmussen* recognizes the set top terminal may be upgraded to include certain functionality and associated hardware, such as receiver components 601. Thus, Fig. 12a illustrates an exemplary way a receiver 750 and transmitter 730 would be integrated into the STT. *Asmussen* teaches that the receiver components 601 and transmission components 604 are representative of “various” components that perform the same functions. *Asmussen*, 26:57-63. Additionally, Fig. 12a depicts the tuner and receiver components 601 as receiving signals from the CATV network, which includes both video program information and videocall information when the video call information is transmitted to the set top terminal via the cable television network. Additionally, there are other embodiments, such as Fig. 11, that also depict the hardware components of a tuner and receiver as receiving signals from the cable television network.

Ex. 1003, ¶116.

As the primary basis of his opinion on integrating receiver 750 into the set top terminal, Dr. Lippman states that “*Asmussen* teaches that the receiver components 601 and transmission components 604 [of Fig 12a] are representative of ‘various’ components that perform the same functions [as receiver 750 and transmitter 730].” *See id.* However, Dr. Lippman misreads *Asmussen* and provides only conclusory opinions regarding the alleged functional sameness. *See*

Ex. 2021, ¶¶89-94.

Comparing Figure 11—which Dr. Lippman also points to in explaining his opinion—with Figure 12a, the correspondence between the processing circuitry block 340 (Figure 11) and the receiver components block 601 (Figure 12a) is readily seen. Processing circuitry block functionality and components are described as follows:

- Processing circuitry 340 (Figure 11) is describes as: “All cable signals intended for reception on the subscriber's TV are accessed by the tuner **603** and subsequently processed by the processing circuitry **340**. This processing circuitry **340** typically includes additional components for descrambling, demodulation, volume control and remodulation on a Channel 3 or 4 TV carrier.” Ex. 1004, 26:6-11.
- Receiver components block 601 (Figure 12a) is described as: “As seen in the figure, CATV input signals are received by the set top terminal **220** using a tuner **603** and various receiver components described above (but denoted generally at **601** in FIGS.12a and 12b).” *Id.* at 26:57-60. And the “various receiver components described above” phrase is referring to earlier in column 26, which describes processing circuitry 340 and the descrambling, demodulation, volume control and

remodulation operations.

None of these operations, however, include a “receiver” operation as needed for receiver block 750. In other words, when reading column 26, “receiver components 601” is not an undefined black box that receiver 750 can be dropped into according to Dr. Lippman. *See* Ex. 1003, ¶¶116. Thus, Figure 12 does not “illustrate[] an exemplary way a receiver 750 and transmitter 730 would be integrated into the STT.” *See* Ex. 1003, ¶116.

Moreover, Dr. Lippman further explains that “Fig. 12a depicts the tuner and receiver components 601 as receiving signals from the CATV network, which includes both video program information and videocall information when the video call information is transmitted to the set top terminal via the cable television network.” Ex. 1003, ¶116. While tuner 603 does “tune to the proper frequency of the channel or program desired” (Ex. 1004, 26:26-27) it also must “subsequently instruct the processing circuitry 340 to begin descrambling of this channel or program.” *Id.* at 26:27-29. Thus, the functionality of block 340 (in Figure 11) and hence block 601 (in Figure 12a), cannot simply be replaced by the functionality of receiver 750, since receiver 750 is not (nor comprises the functionality of) a descrambler. Thus, if receiver 750 and transmitter 730 were inserted in place of blocks 601 and 604 (i.e., Dr. Lippman’s “same functions” assertion, Ex. 1003,

¶116), respectively, Figure 12a would not function as described.

Nor has Dr. Lippman described how or why a POSITA would be motivated to integrate the separate signal processing functions (channel decoder 755, decryptor 760, demultiplexer synchronizer 765 and decoders 770 and 775) of Fig. 30 (Ex. 1004, 50:44-53) into Figure 12a. In fact, these operations can be significantly different than the descrambling, demodulation, volume control and remodulation of processing circuitry 340 (Figure 11) and receiver components 601 (Figure 12a).

Finally, merely because Asmussen contemplates different hardware modifications to the set top box does not provide the required motivation to combine. Apple and Dr. Lippman have failed to demonstrate that there is an “express motivation” to modify Figures 11 or 12a with the receiver 750 for video calls. See Reply, at 9-10. Figure 30 is labeled “Set Top Terminal 220” and described as “a block diagram of a set top terminal with video calling capabilities” (Ex. 1004, 6:1-2, Fig. 30). But Figure 30 and the corresponding description is completely silent as to what other hardware components are in this embodiment of the set top box. And, although Asmussen states that “the set top terminal 220 is augmented with additional features, as shown in Fig. 30,” (*id.* 49:43-46), this disclosure alone does not allow Apple or Dr. Lippman to cherry-pick which other

hardware components or embodiments of the set top box to use to put forward an obviousness case. There must be reasoning for such combinations and why the combinations would be obvious to a POSITA. Such reasoning is absent here.

Thus, Asmussen alone (or in view of Bear, which Apple does not rely on for claim 1(a)) does not disclose the claimed “network interface.”

B. Apple Failed to Provide Any Motivation to Combine Asmussen, Bear, and Lindstrom.

Despite Apple unambiguously asserting that Ground 4 comprises the three-reference combination of Asmussen, Bear, and Lindstrom, Apple failed to properly set forth motivations to combine all three references. Accordingly, Apple has not shown that the Asmussen, Bear, and Lindstrom combination discloses claim 1(a).

Apple attempts to shortcut the process by relying on its motivations to combine Asmussen and Lindstrom to show that the “network limitation” is met, but Bear is unambiguously absent from this discussion.¹ See Petition, at 20-29 (no

¹ Apple cannot rely solely on motivations to combine Asmussen and Lindstrom without Bear because Apple did not forward that ground in its Petition and is precluded from doing so now. See 35 U.S.C. 311-319. Indeed, the Federal Circuit has made it clear that the **Board** cannot institute a petition on grounds not presented, and the same applies to Petitioners. See *Sirona Dental Systems GmbH v. Institut Straumann AG*, 892 F.3d 1349, 1356 (Fed. Cir. 2018); *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1135-36 (Fed. Cir. 2020).

discussion of Bear regarding claim 1(a) in Ground 1), 37-39 and 41-45 (discussing Bear only with respect to claims 1(e) and 1(g)); Reply, at 10-13.

Apple claims that Patent Owner is employing a “‘gotcha’ argument with a feigned ignorance or confusion that is pointless.” Reply at 13. Putting aside the unnecessary invective, Patent Owner is doing no such thing.

Rather, the fact remains that neither Apple nor Dr. Lippman presented any motivations to combine all three references—Asmussen, Bear, and Lindstrom—for Ground 4. *See Artic Cat Inc. v. Polaris Indus.*, 795 Fed. Appx. 827, 832-34 (Fed. Cir. 2019) (affirming the Board's conclusion that Arctic Cat failed to prove that there was a motivation to combine the prior art references Sundahl, Suzuki, and Brown and thus failed to prove that the '501 patent was unpatentable as obvious”); *InTouch Techs., Inc. v. VGo Communs., Inc.*, 751 F.3d 1327, 1349-53 (Fed. Cir. 2014) (reversing the district court's judgment of invalidity noting, in part, that defendant's expert “also succumbed to hindsight bias in her obviousness analysis” who “failed to address why one of ordinary skill in the art *at the time of the invention*, which was 2001, would be motivated to combine these three references.”) Thus, the Board should reject any arguments relating to “Asmussen in view of Lindstrom” (see Petition at 69-73; Reply at 10-13; Ex. 1003, at ¶¶188-

198), and consider that Apple never submitted motivations to combine all three of the references as a whole for the claimed “network interface” limitation.

III. ASMUSSEN ALONE OR IN COMBINATION WITH BEAR DOES NOT TEACH CLAIM 1(E)’S “RENDERING THE CAMERA OPERATIVE” LIMITATION

Apple misstates and mostly ignores Patent Owner’s arguments that conclusively show that Asmussen alone does not teach claim 1(e), a conclusion reached also by the Board. *See* Institution Decision, at 64. Patent Owner’s arguments rely on the plain text of Asmussen and are fully supported by expert testimony regarding how a POSITA would also read Asmussen. *See* Ex. 2021, ¶¶102-126. Apple’s Reply, on the other hand, relies on Dr. Lippman to conjure straw man arguments and provide unsupported and conclusory opinions that are divorced from the text of Asmussen and Dr. Bystrom’s actual opinions. Similarly, Apple cannot show that the combination of Asmussen and Bear discloses claim 1(e), and Dr. Lippman’s motivations to combine Asmussen with Bear are rooted in hindsight. Thus, the Board should uphold the patentability of claim 1 over the combination of Asmussen and Bear.

A. Asmussen Alone Does Not Teach Claim 1(e)

Contrary to Apple’s assertions in its reply, Patent Owner rebutted Apple’s “central argument” and demonstrated that Asmussen alone does not disclose the

“rendering the camera operative” limitation. *See* Patent Owner Response, at 15-28; *see also* Patent Owner Preliminary Response, at 29-40; Ex. 2021, ¶¶102-122. Indeed, the Board agreed with Patent Owner and did not find that Asmussen **alone** teaches claim 1(e). *See* Institution Decision at 64 (“Based on this preliminary record...the combined teachings of Asmussen **and** Bear meet the recited limitation.” (emphasis added)). Apple ignores much of Patent Owner’s arguments demonstrating Asmussen’s failure to teach claim 1(e) and misreads the arguments that it did include in its Reply.

For example, Apple claims that Patent Owner’s “discussion of the ‘pause’ mapping is confusingly non-responsive to the Petition’s mapping” when the opposite is true. *See* Reply, at 14. Apple is, again, trying to read in the automatic pausing disclosures in other parts of Asmussen to the default state of the video camera passage, in relation to the video call options menu, which it relies on for this limitation. *See id.*; *see also* Petition, at 34-37; Ex. 1004, 21:34-42. When looking at that passage, Asmussen specifically included the word “automatic” with respect to the program pausing feature **and** instances when calls shall be messaged. Asmussen did not, however, associate “automatic” (i.e., without further user input)

to the changing state of the camera when an inbound video call is received.² *See* Ex. 1004, 21:34-42. Asmussen knew how to describe his ideas in the context of “automatic” and did not state in column 21 what Apple believes he did.

Moreover, in response to Patent Owner's arguments and Dr. Bystrom's declaration (Ex. 2021, ¶¶102-122), Apple relies on an unsupported and conclusory supplemental declaration from Dr. Lippman. *See* Reply, at 14-15; Ex. 1054, ¶¶3-10. Dr. Bystrom's opinions are simply how a POSITA reads the disclosure, what it actually says and not “proposed modifications” as Apple claimed. *See* Reply at 14. As Dr. Bystrom explained, given Apple and Dr. Lippman's arguments about the “on” state of the camera, a natural reading of Asmussen is that if the camera is “on” in the default state, it is on at all times. *See generally* Ex. 2021, ¶¶102-122.

Dr. Lippman opines, on Reply, that such a configuration is undesirable and would require unnecessary processing and waste resources. Reply, at 14-15; Ex.

² Similarly, Apple's response regarding Patent Owner's discussion of the caller ID functionality in Asmussen is nonsensical. Reply at 16. Patent Owner is not arguing that claim 1(e) requires the video to be displayed on the display upon receipt of the video call. *See id.* Patent Owner's highlighting of the caller ID feature merely underscores that, at place in Asmussen where one would expect some evidence that the camera is rendered operative upon receipt of the videocall, Asmussen is silent. *See* Patent Owner Response, at 19-23.

1054, ¶3-10. But cameras are, and have been, designed to be left “on.” For example, Bear—which Apple relies on for multiple grounds in its Petition—contemplates this very scenario

Because the state of the capture button **308** may not be readily apparent to a user, a camera indicator light **306** such as an LED may be used in conjunction with the capture button **308**. The camera indicator light **306** may be adjacent the camera lens **304** or integrated into the capture button **308**. The camera indicator light **306** may indicate state via various colors and flash patterns, e.g., steady state unlit when the camera is off, steady state red when video capture is taking place, a slowly blinking red indicator light when there is an incoming video call, or ***steady state green when the camera is used for proximity detection.***

See Ex. 1005, 7:50-60 (emphasis added). Thus, Bear itself refutes Dr. Lippman's claim that Dr. Bystrom's opinions are “without any basis in the prior art.” See Ex. 1054, ¶3.

Dr. Lippman's unnecessary consumption of power counter-argument is not grounded in fact and should be accorded no weight. See Ex. 1054, ¶¶4-7. Nowhere does Dr. Bystrom claim that a POSITA would rely on batteries to power the camera in Asmussen—this is a straw man argument that Dr. Lippman has created. Compare Ex. 2021, ¶109 with Ex. 1054, ¶¶4-5. And Dr. Lippman ignores

the undisputed fact that individuals keep countless everyday items plugged in an AC outlet at all times—e.g., televisions, printers, ovens, microwaves, and, set top boxes—and those items consume power even though the user is not actively using those items. [REDACTED] *see also* Ex. 2020, 60:15-61:22

(Dr. Lippman testifying that he did not understand what is meant by a “wake-up” function—i.e., on but not operative—in the context of electronic devices). [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Similarly, Dr. Lippman's counter-argument regarding unnecessary consumption of computational resources (i.e., processing) is equally unavailing. Ex. 1054, ¶8; *see also* Reply, at 14-15. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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³ Dr. Lippman repeats his position regarding lag time, but his supplemental declaration provides no support for his positions, does not provide a basis to find that Asmussen discloses this limitation (when it does not), and, thus, should be accorded no weight. *Compare* Ex. 1003, ¶141 *with* Ex. 1054, ¶¶9-10.

In sum, as demonstrated in Patent Owner's Response (pp. 19-23) and herein, Asmussen alone simply does not disclose the 'rendering the camera operative' limitation of claim 1(e). Apple's Reply—heavy on overstatements and a misreading of Patent Owner's arguments—does not change the written words (or lack thereof) in Asmussen.

B. Asmussen in Combination With Bear Does Not Teach Claim 1(e)

First, Patent Owner's argument are not based on "bodily incorporation" as Apple claims. *See* Reply, at 16-19. Rather, Patent Owner's description of Bear's disclosure merely illustrates that nearly all of Bear's disclosure relates to video capture applications using a camera with a lens cover. *See* Patent Owner Response, at 26-27.

Second, regarding Petitioner's motivation to combine arguments in its Reply, Petitioner correctly states that the invention in Bear "can be used in multiple computing systems and environments," including a set top box. *See* Reply, at 19. But context is important. The set top box "environment" is among a laundry list of environments as follows:

The invention is operational with numerous other general purpose or special purpose computing system environments or configurations.

Examples of well-known computing systems, environments, and/or configurations that may be suitable for use with the invention include, but are not limited to: personal computers, server computers, handheld or laptop devices, tablet devices, headless servers, multiprocessor systems, microprocessor-based systems, set top boxes, programmable consumer electronics, network PCs, minicomputers, mainframe computers, distributed computing environments that include any of the above systems or devices, and the like.

Ex. 1005, 3:66-4:9. And this is the only reference to a set top box in fourteen columns worth of disclosure in Bear, which primarily relates to PC-based teachings. *See generally id.* at Abstract, Figures 1-2, 4-11 (and corresponding disclosure).

But nowhere does Bear address or suggest solving the problems identified by the '991 Patent. *See* Patent Owner Response, at 28-34. Apple attempted to reframe the problems solved by the '991 Patent to make Bear appear more relevant and to obscure Dr. Lippman's reliance on hindsight, claiming that it is "pertinent to a problem to be solved by the claimed invention in the '991 Patent," that being "controlling a camera." Petition at 12; Ex. 1003, ¶¶64-65; *see also* Petition at 39. Apple's reframing of Bear continues in its Reply, claiming that Bear "is directed to the problem of providing user control (e.g., answering a phone call and interacting

with communications and media applications).” Reply, at 20. Apple and Dr. Lippman are wrong.

The '991 Patent does not solve such generic “user control” problems as Apple suggests, but rather specific problems associated with answering video calls while watching digital content on another display screen:

In the prior known technique as disclosed in JP-A-5-56190, the TV receiver and the videophone are arranged so that these are discrete devices which operate independently of each other. Upon receipt of an incoming telephone call at the videophone during watching a TV broadcast program by the TV receiver, a message which notifies arrival of such phone call is displayed on the TV receiver's display screen so that a user easily knows that there is an incoming phone call. In this event, the user must walk to a place at which this videophone is put and perform manual operations for startup of talking with a caller on the videophone. This is a time-consuming and troublesome work for the user who is watching his or her preferred TV broadcast program.

In the case of not only starting a telephone call but also ending the phone call, the user is required to perform a manual operation for the phone call completion (e.g., putting a transceiver handset on a base unit or “cradle”). This operation also is performed at the location in which the videophone is placed.

In this way, traditionally, when there is an incoming phone call during watching a TV broadcast program by TV receiver, the user must move from a place at which he or she was there until then and perform manual operations for startup and completion of the phone call. These operations are time-consuming and troublesome works to the user.

Ex. 1001, 2:7-31.

Bear, however, is wholly silent on solving any of these problems. See Patent Owner Response, at 28-34. Thus, Dr. Lippman's focus on the passing mention of set top boxes and launch of the A/V application in response to a phone call in Bear, to the exclusion of the numerous other environments and the actual problems Bear solves, is divorced from any suggestion that Bear is solving the problems set forth in the '991 Patent. Such myopic focus further underscores Dr. Lippman's hindsight-driven analysis to combine the PC-based system in Bear with the set top system in Asmussen. See, e.g., *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) ("A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning."); *In re NTP*, 654 F.3d 1279, 1299 (Fed. Cir. 2011) (reversing Board's obviousness rejections and finding that it had "improperly relied on hindsight reasoning to piece together elements to arrive at the claimed invention"); *Polaris Indus. v. Artic Cat, Inc.*, 882 F.3d 1056, 1068 (2018) (reversing the Board's obviousness determination

in part because the “the Board’s approach invited the ‘distortion caused by hindsight bias’ into the fold”); *Grain Processing Corp. v. American-Maize Prods. Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988) (“Care must be taken to avoid hindsight reconstruction by using ‘the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.’”) (citation omitted).

Moreover, Bear is silent as to comprising a processor, and rendering the camera operative, in the full context of Claims 1 and 8 (i.e., rendering the camera operative when a processor receives an inbound videophone call notice while displaying the first digital information on the display and pauses the first digital information). See Ex. 2021, ¶¶128-144. Apple largely regurgitates Dr. Lippman’s arguments in its Reply. See Reply, at 20-22 (citing Ex. 1003, ¶¶140-141). But Dr. Lippman’s arguments for combining Asmussen with Bear—reducing lag time, eliminating the need for manual operation of the camera (which is primarily what Bear is actually about and not solving problems identified in the ’991 Patent), simplification of the Asmussen system, and requiring simple processing techniques (Ex. 1003, ¶141)—reads like a textbook example of the improper use of hindsight. See, e.g., *KSR*, 550 U.S. at 421; *In re NTP*, 654 F.3d at 1299; *Polaris Indus.*, 882 F.3d at 1068; *Grain Processing*, 840 F.2d at 907.

For example, as Dr. Bystrom explained, Dr. Lippman does not explain how a POSITA would implement the personal computer-based application of *Bear* in a set top box system like *Asmussen*, nor provide any support for what “simple programming techniques” entail. *See* Ex. 2021, ¶133. And incorporating different functionalities into a processor cannot simply be chalked up to “simple programming techniques” without any quantification or descriptions of the work. *See id.*

[REDACTED]

In sum, Dr. Lippman is improperly using the ’991 Patent as a roadmap in an attempt to invalidate the challenged claims. The Board should reject Dr. Lippman’s conclusions—adopted by Apple—regarding motivations to combine *Asmussen* with *Bear* as to claim 1(e).

* * *

Accordingly, claim 1 is patentable over Apple's obvious combination.

IV. MARLEY'S TEACHINGS

A. Apple's Arguments Regarding Claim 1(c) Are Moot.

Apple states that in "Ground 2, Claim 1 relies on Marley as alternatively teaching Claim 1(c) should Patent Owner contend the claimed communication apparatus must include both the display and other components packaged together within a single housing. Patent Owner does not appear to assert such." Reply at 22. Patent Owner is not asserting such an argument. Thus, the entirety of Apple's Reply as to Marley and claim 1(c) is moot and should be disregarded as irrelevant. *See id.* at 22-24.

B. Apple's Arguments Regarding Claim 5 Are Unpersuasive.

Contrary to Apple's position on Reply, Patent Owner did, in fact, respond to Apple's mapping, and Apple forwards no new arguments other than reliance on Dr. Lippman's hindsight-driven analysis. *See* Reply, at 24-25 (citing Ex. 1003, ¶¶176-177); *see also* *KSR*, 550 U.S. at 421; *In re NTP*, 654 F.3d at 1299; *Polaris Indus.*, 882 F.3d at 1068; *Grain Processing*, 840 F.2d at 907. As such, the Board should accord Dr. Lippman's no weight and conclude that claim 5 is patentable over the Asmussen, Bear, and Marley combination (Ground 2).

V. CONCLUSION

As Petitioner has not shown obviousness by preponderance of the evidence, the Board should confirm the patentability of the challenged claims of the '991 Patent.

Dated: March 4, 2021

Respectfully submitted,

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Case IPR2020-00200
Patent No. 10,084,991
Patent Owner's Sur-Reply

CERTIFICATE OF SERVICE

I hereby certify that on this 4th day of March, 2021, a copy of the attached **PATENT OWNER'S REDACTED SUR-REPLY** was served by electronic mail to the attorneys of record, at the following addresses:

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Date: March 4, 2021

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/Robert G Pluta Reg No 50970/

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CERTIFICATION PURSUANT TO 37 C.F.R. § 42.24(d)

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that **PATENT OWNER'S SUR-REPLY IN *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,084,991** complies with the type-volume limitation of 37 C.F.R. § 42.24(b). The word count application of the word processing program used to prepare this paper states that the Response contains 4,620 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a)(1) and 42.24(b).

Respectfully submitted,

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