

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

Case No. IPR2022-01389
U.S. Patent No. 11,190,633

PATENT OWNER PRELIMINARY RESPONSE

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Exhibit	Description
2001	Kastrenakes, Jacob, “Apple Watch release date is April 24th, with pricing from \$349 to over \$10,000,” THE VERGE (Mar. 9, 2015), available at https://www.theverge.com/2015/3/9/8162455/apple-watch-price-release-date-2015
2002	Plaintiff Mullen Industries LLC’s Response Claim Construction Brief, Dkt. No. 45, September 9, 2022, in <i>Mullen Industries LLC v. Apple Inc.</i> , No. 6:22-cv-00145-ADA (W.D. Tex. 2022)
2003	U.S. Pub. No. 2004/0204044A1 to Pinsky <i>et al.</i>
2004	<i>Continental Intermodal Group–Trucking LLC v. Sand Revolution LLC et al.</i> , 7:18-cv-00147 (W.D.Tex. Jul. 22, 2020)
2005	Plaintiff Gesture Technology Partner LLP’s Response to Apple Inc.’s Motion to Stay Pending Resolution of <i>Inter Partes</i> Review of the Asserted Patents, Dkt. No. 39, in <i>Gesture Tech. Partners, LLC v. Apple, Inc.</i> , No. 6:21-cv-00121 (W.D. Tex. Dec. 29, 2021)
2006	Standing Order Governing Proceedings (OGP) 4.1—PATENT CASES, Dkt. No. 21, dated in April 14, 2022, <i>Mullen Industries LLC v. Apple Inc.</i> , No. 6:22-cv-00145-ADA (W.D. Tex. 2022)
2007	Agreed Scheduling Order, Dkt. No. 30, dated May 28, 2022 in in <i>Mullen Industries LLC v. Apple Inc.</i> , No. 6:22-cv-00145-ADA (W.D. Tex. 2022)
2008	Davis, Ryan, “Albright Says He’ll Rarely Put Cases On Hold For PTAB,” IPLaw360 (May 11, 2021), available at https://www.law360.com/articles/1381597/albright-says-he-ll-very-rarely-put-cases-on-hold-for-ptab

I. INTRODUCTION

Mullen Industries LLC (“Patent Owner”) submits this Preliminary Response to the Petition for *Inter Partes* Review (“Petition”) of U.S. Patent No. 11,190,633 (“the ’633 Patent”) filed by Apple Inc. (“Petitioner”). The Petition should be denied in its entirety as failing to meet the threshold burden of proving there is a reasonable likelihood that at least one challenged claim is unpatentable.

* * *

As a threshold procedural matter, the Board should exercise its discretion to deny institution under 35 U.S.C. § 314(a). The parallel litigation involving the same parties is already past claim construction, raises overlapping issues and trial is scheduled to conclude four months before the final written decision in this proceeding and six months before the final written decisions in *eleven* other IPRs filed against other patents in the litigation.

Although denial is independently warranted under 35 U.S.C. § 314(a) and the Board need not reach the substantive merits of the Petition, Patent Owner analyzes Grounds 1-4 because “weakness on the merits” or even a “closer call” also favors discretionary denial. Petitioner fails to establish even a reasonable likelihood (let alone a “compelling” case) that it would prevail on any of the ’633 Patent claims at least because the Petition does not establish (1) why skilled artisans would have been motivated to combine Vock with either of Narayanaswami or Fujisawa, (2) that *any*

of the cited references, taken alone or together, disclose “a watch band; a second watch band; a buckle, where said buckle is coupled to said second watch band”; (3) that Narayanaswami discloses receiving “second wireless communication signals associated with a second event from said mobile telephonic device”; (4) that Narayanaswami discloses “motion sensing operable to distinguish between a plurality of different types of motion”; or (5) that Vock combined with Fujisawa discloses “motion sensing operable to distinguish between a plurality of different types of motion.”

II. RELATED PROCEEDINGS

The '633 Patent is involved in *Mullen Industries LLC v. Apple Inc.*, No. 6:22-cv-00145-ADA (W.D. Tex. 2022) (the “Litigation”), along with eight other U.S. patents issued to Jeffrey Mullen and owned by Patent Owner and for which Petitioner has recently filed petitions, as follows:

U.S. Patent No.	IPR No.	Filing Date
11,109,218	IPR2023-00087	October 20, 2022
11,122,418	IPR2023-00090	October 20, 2022
9,204,283	IPR2023-00091	October 20, 2022
11,096,039	IPR2023-00096	October 21, 2022
8,374,575	IPR2023-00097	October 21, 2022
9,635,540	IPR2023-00098	October 21, 2022
11,234,117	IPR2023-00115	October 26, 2022
	IPR2023-00116	October 26, 2022

U.S. Patent No.	IPR No.	Filing Date
	IPR2023-00117	October 26, 2022
11,246,024	IPR2023-00148	November 2, 2022
	IPR2023-00149	November 2, 2022

Of these eleven additional petitions, eight have been accorded filing dates that put decisions on institution due in mid-May 2023. The remaining three petitions do not yet have filing dates as of this Response. Trial in the Litigation is set for shortly thereafter, in November 2023.

III. THE INVENTION OF THE '633 PATENT

In March 2003, inventor Jeffrey Mullen disclosed in U.S. provisional application no. 60/455,218 his design of a watch that wirelessly communicates with a mobile phone to receive notifications of incoming calls, missed calls, calendar appointments, text messages, voice messages, location-based alerts and even distinguish between phone vibrations and human movements—*12 years before* Petitioner released the Apple Watch in April 2015. Ex. 2001.

The Petition fairly describes Mullen's inventive watch as disclosed and claimed in the '633 Patent. Pet., 3-7.¹

¹ At this preliminary stage, and before submission of expert testimony, Patent Owner neither disputes nor consents to Petitioner's definition of a person of ordinary skill in the art. Pet., 11-12.

IV. PETITIONER ADVANCES AN OVERBROAD CONSTRUCTION OF “FIRST EVENT AND SECOND EVENT ARE DIFFERENT”

The Petition states that no claim terms require construction. Pet., 12. Petitioner posits two diverging interpretations, however, of the “first event and second event are different” limitation in arguing against “Claim 1b” in Grounds 1 and 3. Pet., 29. 51. Here, as in the Litigation, Petitioner contends that this term “does not require events of different types, i.e., the “first event” and “second event” can be satisfied by serial incoming phone calls as allegedly disclosed in the cited art. *Id.* Should the Board construe this limitation, its plain and ordinary meaning applies.² Petitioner’s position that the first and second events can be different *or the same* type contradicts the intrinsic record. Ex. 2002, 31-34.

Petitioner’s interpretation misconstrues the plain language of claim 1, which requires ***both*** (i) the existence of a “first event” and a “second event” (i.e., they are not the same event) and (ii) that the first event and second event are “different.” *Id.*, 31. This supports Patent Owner’s position that the claim does not cover first and second event that are, for example, both text messages or both incoming calls. To hold otherwise would ignore and conflate these two separate and distinct

² Claim construction is fully briefed in the Litigation and a hearing before Judge Albright is scheduled for December 20, 2022. The Court will thus likely issue a claim construction order well before the March 8, 2023 date for the Board to rule on institution. Patent Owner expects to inform the Board of the claim construction order upon its issuance.

requirements of the claim. Dependent claim 27 likewise requires each of first, second, and third events (i.e., they are not the same event) and separately that each such event is “different.” Only by conflating these two separate and distinct requirements can Petitioner argue that the claim is broad enough to cover the situation where the “first event” and “second event” can be “a first call (first event) and a second call (second event).” Pet., 29. 51.

The specification also supports this plain reading of the claims. For example, the specification refers to “different” events as events that are associated with different “type[s] of alert[s].” Ex. 1001, 5:32-36. The specification also refers to an incoming call and a calendar notification as “different” alerts. *Id.*, 2:41-44. Conversely, nowhere does the specification refer to two text messages as “different” events, or two to incoming calls as “different” events.

The prosecution history is also highly instructive. On March 19, 2019, applicant amended independent claim 15 (later renumbered as independent claim 1 in the '633 Patent) to require (i) a “first event” and a “second event” and to further require (ii) that “said first event and second events are different.” Ex. 1002, 322. On April 16, 2019, the Examiner mailed an Office Action rejecting the claims. *Id.*, 326-336. The Examiner stated that the primary reference, Chihara U.S. Pub. No. 2002/0068600A1, disclosed a first event corresponding to an incoming call. *Id.*, 329-330. However, importantly, the Examiner held that the fact that such reference

disclosed receiving notifications of various incoming calls over time did *not* mean that Chihara disclosed “first” and “second” events where such events were “different,” as Petitioner argues now. Rather, the Examiner expressly held that Chihara did *not* disclose “a second event ... wherein said first event and second events are different.” *Id.* The Examiner relied instead on secondary reference, Pinsky U.S. Pub. No. 2004/0204044A1, for this feature. *Id.*, 330. Critically, the cited portion of Pinsky refers to notifications corresponding to “different” events—i.e., incoming phone calls, e-mails, and appointment reminders. Ex. 2003, ¶ [0019]. The prosecution history thus makes clear that the “different” first and second events in claim 1 cannot all be, for example, incoming calls or text messages as Petitioner urges.

Accordingly, the Board should reject Apple’s proposed interpretation of this term.

V. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION

As a threshold and dispositive issue, discretionary denial is warranted under 35 U.S.C. § 314(a). Institution would be an inefficient duplication of the Litigation, which will go to trial in less 11 months and more than six months before resolution of 11 of the 12 IPR proceedings brought against the asserted patents. Discretionary denial is particularly appropriate here where Petitioner has refused to stipulate to

estoppel under 35 U.S.C. § 315(e), and the merits of the Petition fail to advance a compelling case of unpatentability.

Institution of *inter partes* review is discretionary. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (stating “§ 314(a) invests the Director with discretion on the question *whether* to institute review”) (emphasis in original); *see also Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

In *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), the Board discussed potential applications of *NHK Spring Co., Ltd. v. Intrix-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential) and a number of other cases concerning discretionary denial under 35 U.S.C. § 314(a) and identified six non-exclusive factors to consider when a related district court action exists:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;

5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv, IPR2020-00019, Paper 11, 5-6. In evaluating these factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review. *Id.*, 6.

Director Vidal provided further *Fintiv* guidance earlier this year, indicating that the Board should not deny institution under *Fintiv* if (i) a petition presents a “compelling case of unpatentability”³ or (ii) petitioner agrees not to pursue in the litigation any grounds that he raised or reasonably could have raised in the petition. Ex 1017. The Director also reiterated that, while Factor 2 supports denying institution when the trial date is before the final written decision date, this fact is not dispositive where there is reason to believe that the trial date may change.

Under this guidance and Board precedent, the circumstances here favor discretionary denial.

³ A “compelling” case exists when the evidence, if unrebutted, “plainly” leads to a conclusion that at least one claim is unpatentable by a preponderance of the evidence. Ex 1017, 3-5. If petitioner only establishes a “reasonable likelihood” that at least one claim is unpatentable, the Board may deny institution under *Fintiv* Factors 1-5. *Id.*

A. Factor 1—Judge Albright Will Not Likely Stay the Litigation

Under the first *Fintiv* factor, the Board considers whether a stay has been granted or will be if an IPR is instituted. *Fintiv*, Paper 11, 6. ***The facts here support denial.*** The litigation has not been stayed, no party has requested a stay and the Court is highly unlikely to grant one.

Judge Albright does not stay cases in view of pending IPRs when trial is set to occur before final written decisions are due, claim construction is complete and/or significant discovery has occurred—as is the case here. Claim construction is fully briefed, a hearing is set for December 20, 2022 and an order will issue soon thereafter. The parties have already exchanged infringement and invalidity contentions and final contentions are due January 31, 2023. Ex. 2007. The parties have also conducted 14 fact depositions, exchanged comprehensive written discovery, and produced thousands of pages of documents, i.e., Patent Owner has produced over 10,000 pages of documents and Petitioner has produced over 34,000 pages of documents. Patent Owner’s expert has also already conducted a weeklong source code review of Petitioner’s source code, and Petitioner has produced source code printouts.

The 14 fact depositions that have already taken place included: a deposition of the named inventor, Jeffrey Mullen; a deposition of an Apple employee that writes and maintains Apple’s How-To or “HT” documents regarding the accused infringing

products; a deposition of an Apple employee with knowledge of AppleCare employees who generate consumer inquiry records regarding the accused products; a deposition of an Apple employee concerning Apple's third-party manufacturer that manufactures, develops, tests and ships Apple accused products in the Western District of Texas; a deposition of an Apple employee concerning Apple's testing of accused products in the Western District of Texas; a deposition of an Apple employee regarding Apple's marketing of the accused products; a deposition of an Apple employee with knowledge regarding damages for Apple's infringement; depositions regarding Apple employees who work on source code-related aspects of the accused products; and a deposition of an Apple employee with knowledge of Apple's document collection and e-discovery practices. In addition, Apple itself has noticed three additional third-party depositions for December 2022, of two former Apple employees and one additional individual, and also issued document requests to such third parties.

As of this Response, Judge Albright has ruled on 13 opposed motions to stay pending IPR filed post-institution and denied all eight that involved these circumstances.⁴ *See mCom IP, LLC v. Cisco Sys., Inc.*, No. 6:22-cv-00261, 2022 U.S. Dist. LEXIS 220116 (Oct. 20, 2022) (denying stay even though no claim

⁴ Judge Albright has publicly stated that only in rare circumstances will he put his patent cases on hold. Ex. 2008.

construction hearing had occurred, no trial date was set and Defendant did not agree to 35 U.S.C. § 315(e) estoppel); *mCom IP, LLC v. Bank of Am. Corp.*, No. 6:22-cv-00256, 2022 U.S. Dist. LEXIS 220115 (Oct. 20, 2022) (same); *Sonrai Memory Ltd. v. Kingston Tech. Co. et al.*, No. 6:21-cv-01284, Dkt. No. 94 (Oct. 18, 2022) (denying stay where claim construction was complete, significant discovery had occurred, and trial was set for one month before any final written decision dates); *Sonrai Memory Ltd. v. LG Elecs. Inc et al.*, No. 6:21-cv-00168, Dkt. No. 55 (Jun. 27, 2022) (same); *US Well Servs., Inc. et al. v. Halliburton Co. et al.*, No. 6:21-cv-00367, 2022 U.S. Dist. LEXIS 92708 (W.D.Tex. May 20, 2022) (denying stay where claim construction was complete, trial was set for one month before the first final written decision date, final contentions were served and significant discovery had occurred); *Ravgen, Inc. v. Lab. Corp. of Am. Holdings*, No. 6:20-cv-00969, 2022 U.S. Dist. LEXIS 15600 (W.D.Tex. Jan. 28, 2022) (denying stay where claim construction was complete and IPR was instituted on one of two asserted patents); *USC IP Partnership, L.P. v. Facebook, Inc.*, No. 6:20-cv-00555, 2021 U.S. Dist. LEXIS 249095, at *1 (Aug. 5, 2021) (denying stay where claim construction was complete, trial was set for five months before any final written decision dates, and fact discovery was closed); *Continental Intermodal Group–Trucking LLC v. Sand Revolution LLC et al.*, 7:18-cv-00147 (W.D.Tex. Jul. 22, 2020) (denying stay where “(1) The Court strongly believes the Seventh Amendment, (2) This case has been

pending since 2017 and staying the case would only further delay its resolution, (3) Denying the stay would allow the Parties to obtain a more timely and complete resolution of infringement, invalidity, and damages issues, and (4) Plaintiff opposes the stay”) (Ex. 2004).

Those five motions granted by Judge Albright all involved final written decisions issuing *before* trial—facts not present here. *See Sonrai Memory Ltd. v. Western Digital Techs., Inc.*, No. 6:21-cv-01168, Dkt. No. 104 (Aug. 4, 2022) (granting stay where final written decision would issue before trial and IPRs were instituted on all asserted claims of all patents); *Xylon Licensing LLC v. Lone Star Nat’l Bancshares-Texas, Inc.*, No. 6:21-cv-00302, 2022 U.S. Dist. LEXIS 103060, at *1 (Jun. 8, 2022) (granting stay where IPR petition was filed two weeks before the complaint was filed, no claim construction or discovery had occurred, no trial date was set and trial was projected to occur after final written decisions); *Gesture Tech. Partners, LLC v. Apple, Inc.*, No. 6:21-cv-00121 (Dec. 29, 2021) (granting stay where IPRs were instituted on all grounds against all claims of all patents, fact discovery had not started, claim construction was pending, final infringement and invalidity contentions were not served and no trial date was set) (Ex. 2005); *Kirsch Research and Development, LLC v. IKO Indus., Inc et al.*, No. 6:20-cv-00317, 2021 U.S. Dist. LEXIS 191684, at *1 (Oct. 5, 2021) (granting stay where final written decision would issue before trial and four grounds were instituted against the only

two asserted claims in the case); *Kirsch Research and Development, LLC v. IKO Indus., Inc et al.*, No. 6:20-cv-00318, Dkt. No. 62 (Oct. 4, 2021) (same).

Accordingly, Judge Albright will likely deny any motion to stay filed by Petitioner in the Litigation, where claim construction will be complete, final contentions will be served, significant fact discovery will have occurred and trial is set for 4-6 months before the final written decision dates.

B. Factor 2—Trial will Likely Occur at Least Four Months before the Final Written Decision

The second *Fintiv* factor considers the proximity of the trial date to the final written decision date. *Fintiv*, IPR2020-00019, Paper 11, 6. ***This factor also supports denial*** because trial in the Litigation will precede the final written decision in this proceeding by *four* months and any final written decisions in the other eleven IPRs by *six* months.

Institution under these circumstances would not be consistent with the “objective of the AIA ... to provide an effective and efficient alternative to district court litigation.” *NHK Spring*, IPR2018-00752, Paper 8, 20 (denying institution where trial date set to occur six months before final written decision) (quoting *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 16-17 (PTAB Sept. 6, 2017)); *see also Ericsson, Inc. et al. v. Godo Kaisha IP Bridge I*, IPR2022-00726, Paper 11, 10 (Nov. 2, 2022) (“At the time [Godo Kaisha] filed its

Preliminary Response [on August 4, 2022], the jury selection in the Texas case was scheduled for October 3, 2022” and trial would likely “be set for December 5, 2022”); *F5 Networks, Inc. v. WSOU Investments, LLC*, IPR2022-00238, Paper 11, 8 (PTAB May 19, 2022) (“[Trial] is over six months before the expected date of our final written decision. Thus, we find that the second *Fintiv* factor favors exercising authority to deny institution.”).

Petitioner attempts to characterize the November 2023 trial date as a throw away date. According to Judge Albright, quite the opposite is true:

After the trial date is set, the Court will not move the trial date except in extreme situations. If a party believes that the circumstances warrant continuing the trial date, the parties are directed to contact the Court’s law clerk.

Ex. 2006, 9, ¶ 5. The Board will also “generally take courts’ trial schedules at face value absent some strong evidence to the contrary.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 13 (May 13, 2020). The evidence cited by Petitioner to allege that the November trial date will likely slip by *four to six months* is *far* from strong and is mere attorney argument unsupported by fact or law.

First, Petitioner’s reliance on *In re Apple, Inc.*, 979 F.3d 1332 (Fed. Cir. 2020) is misplaced. That decision concerned Apple’s *motion to transfer*, not a motion to stay or any *Fintiv* analysis. The panel was addressing the relevance of Judge Albright’s ability to “set a fast-paced schedule” to the “administrative difficulties

flowing from court congestion” factor of the venue transfer analysis. *Apple*, 979 F.3d at 1344. Nothing in that Order suggests that Judge Albright will move the November 2023 trial date here by up to six months. If anything, the Federal Circuit in *In re Apple* confirmed that Judge Albright remains committed to a “fast-paced schedule” and simply found that fact not relevant to its transfer analysis. Petitioner’s statement that the “Federal Circuit found error in the **Board’s** reliance on the case’s scheduled trial date” is incorrect. Pet., 67-68 (emphasis added). *In re Apple* did not concern a Patent Trial and Appeal Board proceeding.⁵

Second, Petitioner relies on data from an online article published over two years ago during the COVID-19 pandemic and that makes no specific mention of Judge Albright or his *current* practices. Pet., 68. The source of the data is not identified, and the Petition fails to substantiate why that years-old information is indicative of *current* trial date trends in the Western District of Texas or Judge Albright’s scheduling. *Id.* Pet. 68. Putting these issues aside, the data in fact shows a 23-month average time to trial, putting trial here at January 2023, *still* two months before the final written decision in this IPR and four months before any final written decisions in the other eleven IPRs even if Judge Albright moved the trial date.

⁵ The *Dish Network* decision is also not persuasive. The Board found that *Fintiv* factor 2 favored *denying* institution where a motion to stay was pending and trial was set to occur three months before a final written decision. *Dish Network L.L.C. v. Broadband iTV*, IPR2020-01280, Paper 17, 16-18 (PTAB Feb. 4, 2021).

Third, Petitioner’s reliance on *Sand Revolution* and *Koss* is misplaced. In *Sand Revolution*, the parties moved the trial date multiple times and evidence showed that it would move again because of the COVID-19 pandemic and the “or as available” qualifier in the court’s scheduling order. *Sand Revolution II LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24, 8-9 (Jun. 16, 2020). In *Koss*, the Board focused on “proximity” as “a proxy for the likelihood that the trial court will reach a decision on validity issues before the Board reaches a final written decision” and found that, because trial was “scheduled for less than two months before the final decision” and “persuasive evidence that delays are possible” existed, *Fintiv* factor 2 only minimally favored denial. *Apple Inc. v. Koss Corp.*, IPR2021-00255, Paper 22, 10-12 (Jun. 3, 2021). In contrast here, neither the parties nor the court have extended any deadline affecting the trial date (as in *Sand Revolution*) and the November trial date will occur well before (i.e., 4-6 months before) any final written decisions.

C. Factor 3—The Litigation Will Have Progressed Through Claim Construction, Final Contentions and Significant Fact Discovery

The third *Fintiv* factor considers “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*, IPR2020-00019, Paper 11, 9. For example, “[i]f, at the time of the institution decision, the district court has issued substantive orders related

to the challenged patent, such as a claim construction order, this fact weighs in favor of denial.” *Ericsson*, IPR2022-00726, Paper 11, 10. ***The third Fintiv factor favors denial here.***

By the time of a decision on institution in March 2023, investment in the Litigation by the parties and the court will have been significant, including the issuance of a claim construction order from Judge Albright that, as noted above, will bear directly on the viability of arguments in the Petition. *See supra* Section IV. Infringement and invalidity contentions will also have been finalized and served as of January 31, 2023, significant fact discovery, including depositions, will have taken place and pleadings will have been finally amended. Ex. 2007. Fact discovery closes on May 25, 2023 and, thus, will be effectively complete by the time of the decisions on institution in the other eleven IPR proceedings.

The Board also considers under the third *Fintiv* factor whether Petitioner unreasonably delayed in filing the Petition. *F5 Networks*, IPR2022-00238, Paper 11, 10; *see also Fintiv*, IPR2020-00019, Paper 11, 11-12 (failure to file “the petition expeditiously, such as promptly after becoming aware of the claims being asserted” is a fact favoring denial). Despite being well aware of Judge Albright’s “fast-paced schedule,” Petitioner did not file the Petition until six months after the Litigation commenced, three months after learning which ’633 Patent claims were asserted and two months after learning of the November 2023 trial date.

D. Factor 4—All Issues in the Petition Overlap with the Litigation, and Petitioner has Not Agreed to 35 U.S.C. § 315(e) Estoppel

Under the fourth *Fintiv* factor, the Board considers the “overlap between issues raised in the petition and in the parallel proceeding.” *Fintiv*, IPR2020-00019, Paper 11, 12. For example, “if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Id.* This is indeed the case here. In the Litigation, Patent Owner accuses Petitioner of infringing all 39 claims of the ’633 Patent and, conversely, Petitioner challenges the validity of all 39 claims using the same prior art combinations advanced in the Petition. *See Sand Revolution II, LLC v. Continental Intermodal Group–Trucking LLC*, IPR2019-01393, Paper 12, 17-18 (PTAB Feb. 5, 2020) (informative). ***The fourth Fintiv factor thus also favors denial.***

Further supporting denial, Petitioner only stipulates “that if the Board institutes the Petition, then Apple will not seek resolution in the District Court of any ground of invalidity relied upon herein.” Pet., 70. A stipulation limited only to “any ground of invalidity relied upon” in the Petition does not, however, prevent the duplication of resources and move the fourth *Fintiv* factor away from favoring denial. Petitioner has not offered to withdraw all grounds/combinations based on the cited references, as in *F5 Networks* where petitioner’s stipulation more broadly

“include[d] *any* grounds involving Gourley and Zisapel, and not just the grounds asserted in the Petition.” *F5 Networks*, IPR2022-00238, Paper 11, 11-12 (emphasis added).

Nor has Petitioner offered the *Sotera* stipulation endorsed by Director Vidal, where “petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition” to “mitigate[] concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB.” Ex. 1017, 7-8 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 18-19 (PTAB Dec. 1, 2020) (precedential)).

The stipulation in the Petition is instead the same narrow stipulation criticized in *Sand Revolution* (see *Sand Revolution*, IPR2019-01393, Paper 24, 12 n.5) and means that Petitioner would not be precluded from asserting the same references in other combinations or asserting other combinations of prior art, including highly-similar obviousness theories, in the Litigation. Under these circumstances, denial is favored. See *Google LLC v. Ikorongo Tech. LLC*, IPR2021-00205, Paper 13, 7-13 (PTAB Jun. 7, 2021) (rejecting stipulation and denying institution where stipulation did not cover all potential grounds that reasonably could have been raised and covered only those grounds in the petition); *Samsung Elecs. Co. v. Ancora Techs., Inc.*, IPR2020-01184, Paper 11, 18-22, 27-28 (PTAB Jan. 5, 2021) (rejecting

stipulation and denying institution where stipulation did not cover all potential grounds that reasonably could have been raised).

E. Factor 5—The Parties are the Same

The fifth *Fintiv* factor considers “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, IPR2020-00019, Paper 11, 5-6, 13-14. The Petition admits that the “Parties are the same in the ... Litigation” but suggests that weighing this factor against institution would be unfair. Pet., 70. Conversely, the Board in *Sand Revolution* explained (in an opinion designated “Informative”) “this factor weighs in favor of discretionary denial” where “a petitioner in inter partes review and defendant in a parallel district court proceeding are the same.” *Sand Revolution*, IPR2019-01393, Paper 24, 12–13. *The fifth Fintiv factor thus favors denial.*

F. Factor 6—Petitioner’s Grounds are Not “Compelling”

The Board should also deny institution under *Fintiv* unless the petition presents a “compelling” case of unpatentability. Ex. 1017, 4. As Director Vidal explained in *OpenSky*:

To be clear, a compelling merits challenge is a higher standard than the reasonable likelihood required for the institution of an IPR under 35 U.S.C. § 314(a). A challenge can only “plainly lead to a conclusion that one or more claims are unpatentable” if it is highly likely that the petitioner would prevail with respect to at least one challenged claim.

OpenSky Indus., LLC v. VLSI Tech. LLC, IPR2021-01064, Paper 102, 49–50 (PTAB Oct. 4, 2022) (precedential). Indeed, “if the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present.” *Fintiv*, IPR2020-00019, Paper 11, 15 (citations omitted).

As demonstrated below, the Petition fails to establish even a reasonable likelihood (much less a “compelling” case) that Petitioner will prevail with respect to at least independent claim 1 of the ’633 Patent. *The sixth Fintiv factor therefore also favors denial.*

VI. PETITIONER FAILS TO ESTABLISH A REASONABLE LIKELIHOOD THAT IT WILL PREVAIL WITH RESPECT TO AT LEAST CLAIM 1

Petitioner fails to establish a reasonable likelihood that it would prevail on demonstrating the unpatentability of any ’633 Patent claim because the Petition does not show as to independent claim 1 (1) why skilled artisans would have been motivated to combine Vock with either of Narayanaswami or Fujisawa, (2) that any of the cited references, taken alone or together, disclose “a watch band; a second watch band; a buckle, wherein said buckle is coupled to said second watch band”; (3) that Narayanaswami discloses receiving “second wireless communication signals associated with a second event from said mobile telephonic device”; (4) that Narayanaswami discloses “motion sensing operable to distinguish between a

plurality of different types of motion”; and (5) that Vock in view of Fujisawa discloses “motion sensing operable to distinguish between a plurality of different types of motion.”

A. Petitioner Has Failed to Establish that Skilled Artisans at the Time of the Invention would Have Combined Vock with Narayanaswami or Fujisawa

1. The Cited References are Not Analogous—They Are in Different Fields of Endeavor and Solve for Different Problems

Contrary to Petitioner’s assertion, Vock is not analogous art to Narayanaswami or Fujisawa. Pet., 21, 24. “Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *Donner Tech., LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353, 1359 (Fed. Cir. 2020) (quoting *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004)).

Narayanaswami specifically concerns a watch having improved display and alarm clock functionality and wireless communication capability. Fujisawa more narrowly concerns putting the functionality of a mobile telephone into a separate wireless device. Vock is far afield of both – and involves installing a power sensing

unit on sports equipment or on a user of that equipment to quantify sports movements.

a. Narayanaswami—“Alarm Interface for a Smart Watch”

Narayanaswami seeks to provide “increased PC desktop-like functionality” in the form factor of a wristwatch. Ex. 1005, 1:1-31. The **field of endeavor** of Narayanaswami is wearable computing devices with display screens and alarm clock and wireless communication capabilities. *Id.* Narayanaswami identifies various alleged shortcomings of then-current devices:

More recently there have been attempts to incorporate some of the capabilities of the above devices into wrist watches. However, today, only special wearable watch devices are available that, besides time keeping functions, may possess a compass, or a Global Positioning System (GPS), or barometer, heart rate monitor, Personal Handy System (PHS) phone, pager, etc. There are shortcomings in these existing special function watches in that most of them are bulky, are mostly unconnected to the Internet or other PC/network devices, have limited battery life, and, are difficult to use. These currently available special function wrist watches additionally have user interfaces that are quite limited in what they can display.

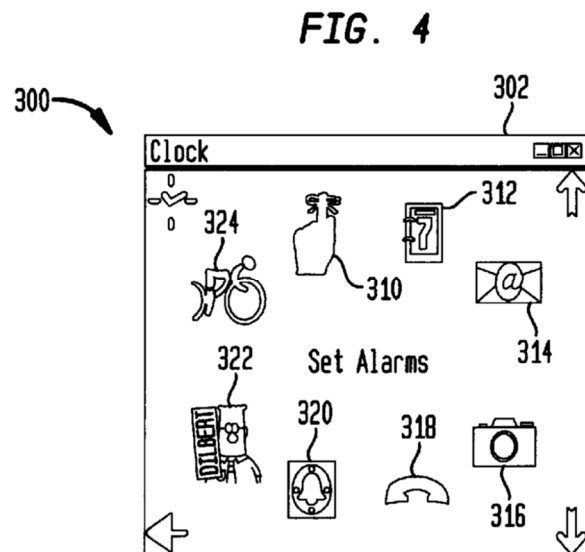
Id., 1:31-44. Narayanaswami describes the **particular problems** with which its alleged invention is involved as “fitting components and power supplies such as batteries into such a small volume” and “the limited screen size of watches.” *Id.*, 1:55-60.

To address these issues, Narayanaswami purports to disclose watch embodiments capable of:

- “wirelessly accessing information and equipped with an interactive user interface and high resolution display for providing a variety of desktop PC-like functions”; and/or
- “providing time-keeping/alarm functions and equipped with an interactive user interface for enabling the setting of the various time-keeping/alarm functions in a manner requiring minimal effort and concentration from the user.”

Id., 1:66-2:9.

Figure 4 depicts a “main menu” interface with various icons for “Personal Information Management (PIM) applications,” similar to a “PC desktop”:



Id., Fig. 4. In addition to these basic applications, Narayanaswami states the watch may be implemented with software for receiving information from the internet:

Other applications may include those enabling the receipt of excerpts of personalized data, such as traffic information, weather reports, school closings, stock

reports, sports scores, etc., from the world wide web. These excerpts may be received as notifications or alarms on the Wrist Watch system 10.

Id., 7:58-63. Narayanaswami also describes adding software to the wristwatch for displaying the screen of another device:

Inter-device interaction software applications are included to permit the watch display to become the display for another device such as a GPS located in a concealed location, (e.g., a bag), or a thermostat on the wall, etc. Thus, this application software enables communication between the other device and the Wrist Watch by receiving/displaying the data and transmitting back information sent from the Wrist Watch. As a further example, caller Id information may be displayed on the Wrist Watch display when the cell phone that belongs to that person rings.

Id., 7:63-8:5.

The remaining figures in Narayanaswami – Figures 5A-5D, 6A-6C, 7A-7C, 8A-8C, 9A-9C and 10 – and accompanying descriptions concern alarm clock embodiments. *Id.*, 8:36-14:11.

b. Fujisawa—“Mobile Telephone and Radio Communication Device Cooperatively Processing Incoming Call”

Fujisawa concerns the **field of endeavor** of wireless devices that communicate with mobile phones. Ex. 1006, ¶ [0002]. Fujisawa explains that “small and lightweight mobile telephones are widely used, and ... often put in bags when carried by their users” and that “users have to take the mobile telephone from the

bag to answer the telephone.” *Id.* Fujisawa thus addresses the **particular problem** of answering a mobile telephone without taking it out of the bag.

The alleged invention of Fujisawa is a “radio communication device” that wirelessly communicates with a mobile telephone. *Id.*, ¶ [0003]. Fujisawa states the radio communication device can be shaped like a watch. *Id.*, ¶ [0006]. The specification describes three main embodiments directed to the radio communication device communicating with a mobile telephone. A “First Embodiment” of Fujisawa involves the radio communication device receiving an “incoming call notification signal” from a mobile telephone and providing a notification of an incoming call on a display of the device, as well as producing a sound, vibrating or emitting a light. *Id.*, ¶¶ [0154]-[0156].

Fujisawa discloses a “Second Embodiment” that involves a radio communication device and communication protocol similar to the “First Embodiment” but with additional disclosures about recording “please wait” and “please leave a message” instructions for a third-party caller, sending those instructions to that caller and recording and playing back a voice message left by the caller:

[A]ccording to the second embodiment, by using the watch-shaped information processing device 12A, the user can request the “please wait message” and a “call response message. Also, the user can record the “please wait message” and “call response message” in his or her own

voice by using the watch-shaped information processing device 12A. The user also can record caller's messages in the watch-shaped information processing device 12A, so the user can hear the caller's message anywhere.... So, the watch-shaped information processing device 12A becomes an interesting gadget to its user.

Id., ¶¶ [0298]-[0300]. A “Third Embodiment” in Fujisawa mirrors the “Second Embodiment” but teaches storing voice messages at a service center. *Id.*, ¶ [0302].

Fujisawa discloses a discrete “Fourth Embodiment” for determining and notifying users about the strength of a communication link between devices. *Id.*, ¶¶ [0376]-[0544].

c. Vock—“Sport Monitoring System for Determining Airtime, Speed, Power Absorbed and Other Factors Such as Distance Drop”

Vock “relates generally to monitoring and quantifying sport movement” of a person or a vehicle ridden by a person. Ex. 1007, 1:1-19. The **field of endeavor** of Vock is quantitatively determining (e.g., measuring) and reporting to the user certain movement parameters of a user during a sport activity. Vock describes the **particular problem** with which its alleged invention is involved as being the fact that people can only assess whether they went fast, slow, or average, got “big air,” or expended significant energy based on their perception, and not actual quantitative data:

[P]ersons in such sporting activities only have a qualitative sense as to speed and loft or “air” time. For example, a typical snowboarder might regularly exclaim after a jump

that she “caught” some “big sky,” “big air” or “phat air” without ever quantitatively knowing how much time really elapsed in the air.

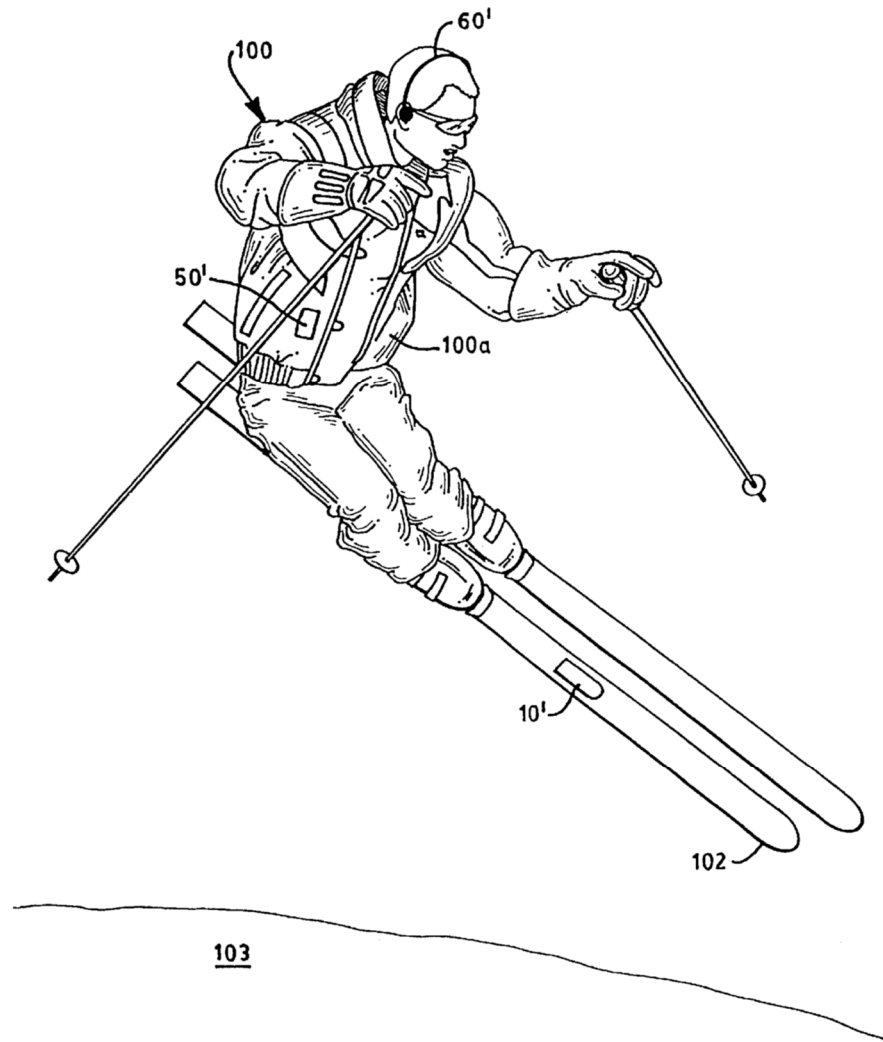
Speed or velocity also remain unquantified. Generally, a person such as a skier can only assess whether they went “fast”, “slow” or “average”, based on their perception of motion and speed (which can be grossly different from actual speed such as measured with a speedometer or radar gun).

There are also other factors that sport persons sometimes assess qualitatively. For example, suppose a snowboarder skis a double-diamond ski slope while a friend skis a green, easy slope. When they both reach the bottom, the “double-diamond” snowboarder will have expended more energy than the other, generally, and will have worked up a sweat; while the “green” snowboarder will have had a relatively inactive ride down the slope. Currently, they cannot quantitatively compare how rough their journeys were relative to one another.

Id., 1:52-2:6.

To address this problem, Vock discloses a “sensing unit” that can be a “stand-alone unit” (*id.*, 3:60-4:28) or “integrated into objects already associated with the sporting activity,” such as ski boots, snowboard boots, skis, bikes etc. *Id.*, 4:29-44.

Figure 2 shows an example, with a sensing unit 10':

**FIG. 2**

Id., Fig. 2, 27:11-20.

Vock also indicates “the sensing unit provides for the measurement of power entirely within a watch”:

Manufacturers such as CASIO™, TIMEX™, SEIKO™, FILA™, and SWATCH™ make sport wrist-watches with certain digital electronics disposed therein. In accord with the invention, power measurement capability is added within such a watch so that “power” data can be provided

to sport enthusiasts in all sports, e.g., volleyball, soccer, football, karate, and similar common sports.

Id., 4:45-53. Figures 38 and 39 disclose examples of such embodiments:

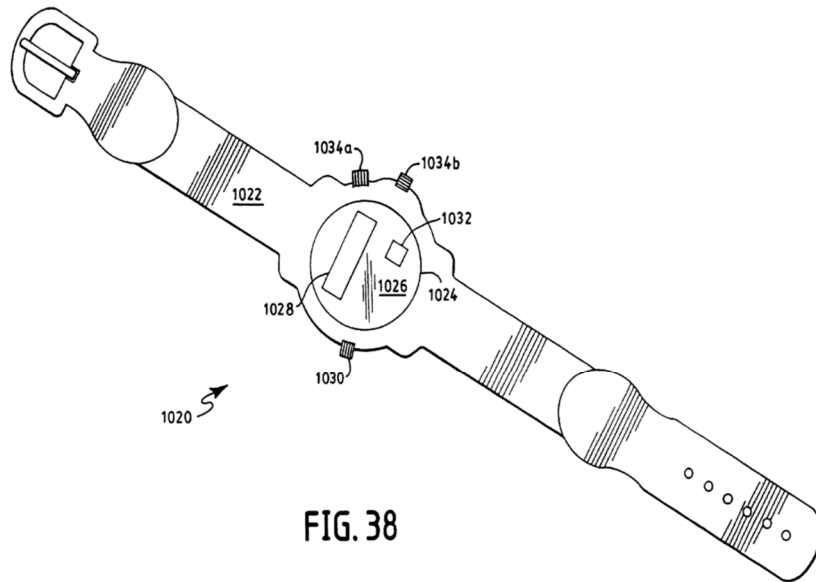


FIG. 38

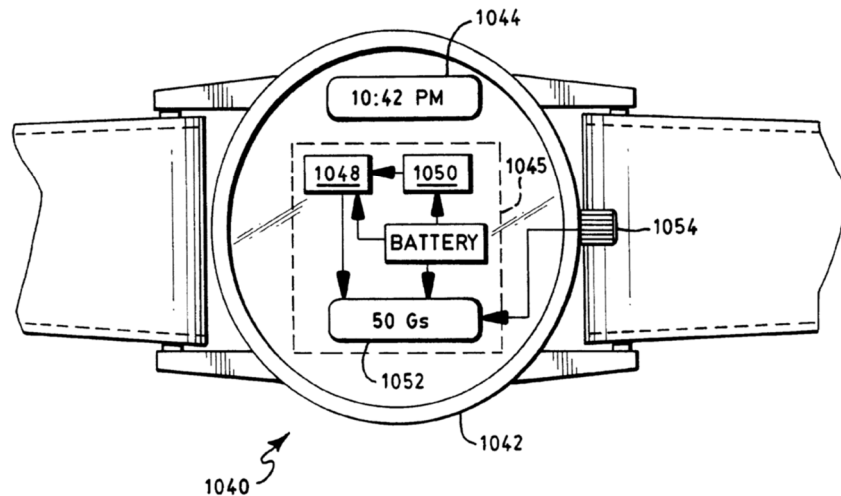


FIG. 39

Vock explains that these watches may contain power sensing units (1032, 1045) that inform the user of his/her performance data “without the additional mounting of a sensing unit on a vehicle.” *Id.*, 44:26-65. The watch embodiments are self-contained

and have no communication with other devices. Vock describes another instance of such an embodiment with reference to Figure 21. *Id.*, 40:48-62; *see also* 24:64-67 (describing watch containing data unit 50).

Vock also indicates that a watch may be used to receive and display performance data received from a sensing unit located elsewhere, such as on a ski, as depicted in Figure 27:

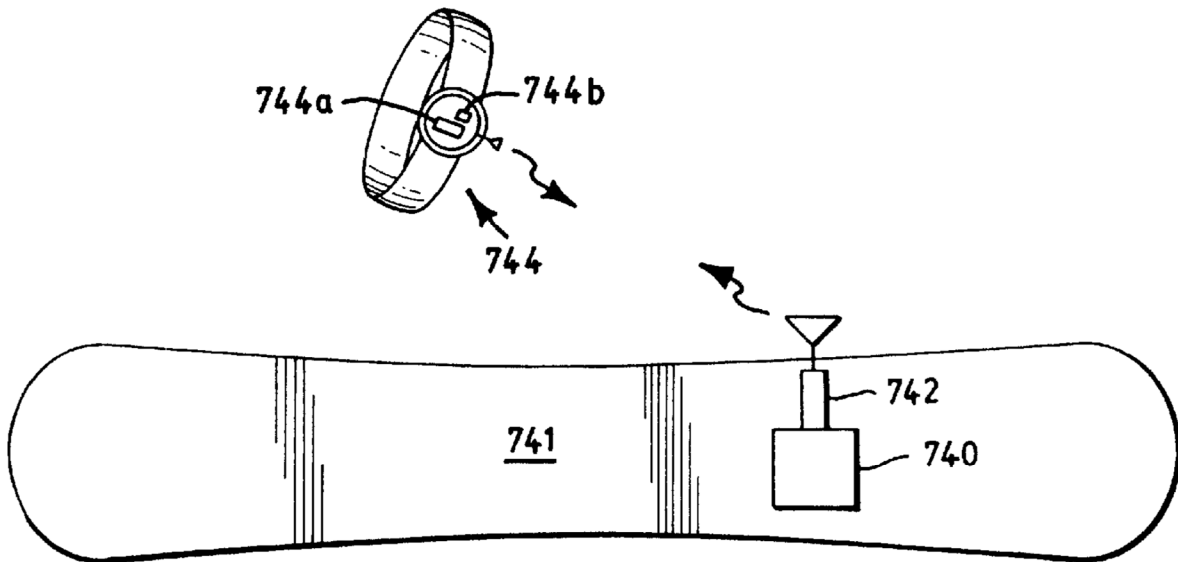


FIG. 27

Id., Fig. 27, 40:38-47. Vock depicts and describes an additional similar embodiment with respect to Figure 41. *Id.*, Fig. 41, 46:1-30.

2. Petitioner Does Not Provide a Valid Rationale for Combining Vock with Narayanaswami

Petitioner provides no cogent and legally valid reason to support its argument that combining Vock with Narayanaswami would have been obvious to a person of

skill in the art at the time of invention. Pet., 21. The Petition broadly asserts that skilled artisans “would have been motivated to combine the smart watches described in Narayanaswami and Vock” because (1) “the references are analogous” and (2) skilled artisans “would have been motivated to” incorporate “additional functionality” of Vock “into the Narayanswami smart watch” to provide “additional types of notifications and the ability to sense additional events.” Pet., 21. These reasons are not factually or legally supported.

a. Vock and Narayanaswami are Not Analogous and, Even if They Were, that Fact Does Not Establish Obviousness

Vock is not in the same field of endeavor, nor seeks to solve the same particular problem, as Narayanaswami. *See* Section VI.A.1. That both references allegedly “describe watches that include microprocessors, display the current time, and allow the user to access information directly from the watch” – as argued in the Petition (Pet., 21) – is not the legal test. The Petition fails to even allege a specific “field of endeavor” or “particular problem.” Narayanaswami and Vock are in different fields of endeavor and describe inventions for solving different problems as explained directly above. *See Donner Tech.*, 979 F.3d at 1359.

Even if Narayanaswami and Vock were analogous (which they are not), being in the same field of endeavor is not enough to find obviousness. *See Securus Techs., Inc. v. Global Tel*link Corp.*, 701 F. App’x 971, 977 (Fed. Cir. 2017) (“[A] broad

characterization of [two prior art references] as both falling within the same alleged field of ‘telecommunications monitoring and control,’ without more, is not ... a sufficient rationale to support an obviousness conclusion.”); *Microsoft Corp. v. Enfish, LLC*, 662 F.App’x 981, 990 (Fed. Cir. 2016) (stating that two “references [being] directed to the same art or same techniques” alone was insufficient to support obviousness). Like the deficient rationales in *Securus Technologies* and *Enfish*, Petitioner’s “analogous” assertion would improperly “lead to the conclusion that any and all combinations of [“watches that include microprocessors, display the current time, and allow the user to access information directly from the watch”] would automatically be obvious.” *Securus Techs.*, 701 F. App’x at 977; Pet., 21.

b. Petitioner’s Reasons for Combining the Alleged “Motion Sensors” of Vock with Narayanaswami are Deficient

Petitioner argues that skilled artisans “would have been motivated to combine the smart watches described in Narayanaswami and Vock”⁶ to incorporate the “additional types of notifications and the ability to sense additional events” into the Narayanaswami watch. Pet., 21-22. This broad assertion is improper and not adequately supported. The Petition does not identify which specific disclosures in Vock would have been obvious to combine with Narayanaswami. Petitioner refers to “additional functionality” and “performance data described in Vock” but provides

⁶ The Vock reference does not use the term “smart watch.”

no citations to any excerpt in Vock’s 62-column specification. *Id.* The Petition also states that “Vock describes motion sensors that are designed to be installed in a watch” but does not explain why, based on this disclosure, skilled artisans would have been motivated to combine the two references, especially when Petitioner itself alleges that Narayanaswami already discloses motion sensors. Pet., 31-32. Obviousness requires “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). It is Petitioner’s burden to demonstrate “that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367–1368 (Fed. Cir. 2016) (citations omitted). The Petition fails to satisfy this burden.

The motivation to combine inquiry also necessarily requires consideration of the claimed invention. *In re NuVasive, Inc.*, 842 F.3d 1376, 1381 (Fed. Cir. 2016) (“In assessing the prior art, the PTAB ‘considers whether a PHOSITA would have been motivated to combine the prior art *to achieve the claimed invention.*’”) (emphasis added) (quoting *In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333 (Fed. Cir. 2016)); *see also KSR*, 550 U.S. at 418 (“[I]t can be important to identify a reason that would have prompted a [PHOSITA] to combine the elements *in the way*

the claimed new invention does.”) (emphasis added). The Petition fails to identify which elements of the ’633 Patent claims its “motivation to combine” arguments seek to render obvious. *See Harmonic*, 815 F.3d at 1363 (“*Harmonic* does not relate what appears to be generic multiplexing and bit rate adjustment to what is recited in claim 11.”). It is not possible for the Board to analyze, and Patent Owner to rebut, Petitioner’s “motivation to combine” assertions without knowing which claim elements of the ’633 Patent are allegedly being achieved by the Narayanaswami and Vock combination.

Petitioner’s declarant, Dr. Bims, also does not sufficiently explain which aspect(s) of the Vock disclosure skilled artisans would have combined with which aspect(s) of Narayanaswami, nor does he provide evidence as to why claim 1 allegedly represents nothing more than the predictable use of prior art elements. Ex. 1003, ¶¶ 89-91. Like the Petition, Dr. Bims also fails to identify which specific elements of the challenged claims his “motivation to combine” arguments concern. Little weight should thus be given to his testimony. *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”); *Rohm & Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997) (explaining nothing in Federal Rules of Evidence or Federal Circuit jurisprudence requires fact finder to credit unsupported assertions of an expert).

Petitioner also asserts that skilled artisans “would have expected to be successful” in combining Vock with Narayanaswami because “both describe watches having processors, sensors, and software.” Pet., 22. There is no evidence in either disclosure, however, to support this conclusion. Even accepting this statement as true, neither reference provides any guidance on how a skilled artisan would incorporate any alleged “motion sensor” into the Narayanaswami watch and why it would have resulted in an operable device, let alone the claimed invention. *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (“[P]rior art fails to provide the requisite ‘reasonable expectation’ of success where it teaches merely to pursue a ‘general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.’” (quoting *In re O’Farrell*, 853 F.2d 894, 903-04 (Fed. Cir. 1988))).

Here, the specific “sensors and software,” the extent of any modifications, the reasons for these modifications, and why there would have been a reasonable expectation of success in implementing those modifications are not adequately identified or supported. Pet., 22. Dr. Bims also fails to address why skilled artisans would have deemed it feasible and appropriate to modify the Narayanaswami watch to include “motion sensors” allegedly described in Vock and still achieve the

tantamount objective of Narayanaswami, namely providing “a wrist watch” that is “a small device” with “a small volume.” Ex. 1005, 1:54-61; Ex. 1003, ¶¶ 89-91.

c. Petitioner’s Reasons for Combining the Watch Band of Vock with Narayanaswami are Deficient

The Petition alleges that skilled artisans “would have been motivated to incorporate the watch band of Vock to the Narayanaswami smart watch” because two-banded watches with buckles “had been well known for decades” and provide for “a band that is adjustable.” Pet., 22-23. In other words, Petitioner’s alleged “motivation” is adjustability. But neither the Petition nor Dr. Bims explains why skilled artisans at the time would have understood the Narayanaswami watches to *not* be adjustable or accommodating of different wrist sizes. That is, Petitioner and Dr. Bims do not explain why the wrist bands in Narayanaswami could not have been adjustable. The allegations in the Petition are thus not sufficiently supported.

Petitioner also misrepresents Narayanaswami in alleging that “both watches include similar designs that each includes a lug on each side of the face.” Pet., 23. There is no depiction in any of the three watch illustrations in Figure 1 of Narayanaswami of a “lug” – to the contrary, it appears that the band in each design traverses underneath “shell (25)”. Practically speaking, that Petitioner itself recognizes that Narayanaswami only discloses a single band, how could Narayanaswami possibly disclose “lugs on each side of the [watch] face”?

3. Petitioner Does Not Provide a Valid Rationale for Combining Vock with Fujisawa

The Petition does not provide a valid reason to support its argument that combining Vock with Fujisawa would have been obvious to skill artisans at the time of the invention. Pet., 24. Petitioner broadly asserts that skilled artisans “would have been motivated to combine the smart watches described in Fujisawa and Vock”⁷ because (1) “the references are analogous” and (2) skilled artisans “would be motivated to incorporate the motion sensors described in Vock, e.g., microphones, accelerometers, or altimeters, and the corresponding software” into the Fujisawa watch. Pet., 24. These reasons are not factually or legally supported.

a. Vock and Fujisawa are Not Analogous and, Even if They Were, that Fact Does Not Establish Obviousness

Vock is not in the same field of endeavor, nor seeks to solve the same particular problem, as Fujisawa. *See* Section VI.A.2.a. That both references allegedly “describe watches that include microprocessors and displays that allow the user to access information directly from the watch in addition to current time” – as argued in the Petition (Pet., 24) – is not the legal test. Petitioner fails to even allege a specific “field of endeavor” or “particular problem.” Fujisawa and Vock are in different fields of endeavor and describe inventions for solving different problems, and are therefore not analogous art. *See Donner Tech.*, 979 F.3d at 1359.

⁷ Neither Fujisawa nor Vock use the term “smart watch” in their disclosures.

Even if Fujisawa and Vock were analogous (which they are not), being in the same field of endeavor is not enough to find obviousness. *See Securus Techs.*, 701 F. App'x at 977 (“[A] broad characterization of [two prior art references] as both falling within the same alleged field of ‘telecommunications monitoring and control,’ without more, is not . . . a sufficient rationale to support an obviousness conclusion.”); *Enfish*, 662 F.App'x at 990 (stating that two “references [being] directed to the same art or same techniques” alone was insufficient to support obviousness). Petitioner’s “analogous” assertion would indeed “lead to the conclusion that any and all combinations of [“watches that include microprocessors and displays that allow the user to access information directly from the watch in addition to current time”] would automatically be obvious.” *Securus Techs.*, 701 F. App'x at 977; Pet., 24.

b. Petitioner’s Reasons for Combining the Alleged “Motion Sensors” of Vock with Fujisawa are Deficient

Petitioner argues that skilled artisans “would have been motivated to combine . . . to incorporate the motion sensors described in Vock, e.g., microphones, accelerometers, or altimeters, and the corresponding software . . . into the smart watch described in Fujisawa.” Pet., 24. This broad assertion is improper and not adequately supported. The Petition does not adequately identify which specific disclosures in Vock would have been obvious to combine with Fujisawa. Petitioner

refers to “motion sensors” and “corresponding software” but provides no citations to any excerpt in Vock’s 62-column specification. *Id.*

The motivation to combine inquiry also necessarily requires consideration of the claimed invention. *In re NuVasive, Inc.*, 842 F.3d at 1381; *see supra* Section VI.A.2.b. The Petition fails to identify which elements of the ’633 Patent claims its “motivation to combine” arguments seek to render obvious. It is not possible for the Board to analyze, and Patent Owner to rebut, Petitioner’s “motivation to combine” assertions without knowing which claim elements of the ’633 Patent are allegedly being achieved by the Fujisawa and Vock combination.

Dr. Bims also does not sufficiently explain which aspect(s) of the Vock disclosure skilled artisans would have combined with which aspect(s) of Fujisawa, nor does he provide evidence as to why claim 1 allegedly represents nothing more than the predictable use of prior art elements. Ex. 1003, ¶¶ 89-91. Like the Petition, Dr. Bims also fails to identify which specific elements of the challenged claims his “motivation to combine” arguments concern. Little weight should thus be given to his testimony.

The Petition also fails to state any viable and supported “motivation” theory for combining any of Vock’s alleged “motion sensors” into the “radio communication device” of Fujisawa. Petitioner and Dr. Bims hypothesize that skilled artisans would have been motivated to incorporate the motion technology of

Vock into the Fujisawa watch to make it “appeal to ... athletes desiring to monitor performance in a convenient manner,” but provide no evidence to support this theory. Pet., 24-25; Ex. 1003, ¶ 95. While “common sense” or “common knowledge” is permissible to motivate a combination, it “cannot be used as a wholesale substitute for *reasoned analysis* and *evidentiary support*, especially when dealing with a limitation missing from the prior art references specified.” *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1362 (Fed. Cir. 2016) (emphasis added). The Petition here contains neither, and thus Petitioner’s motivation theory is deficient.

Petitioner also asserts that skilled artisans “would have expected to be successful” in combining the “motion sensors” and “software” from Vock into the Fujisawa watch because Fujisawa “could be programmed to accept and process the data from the Vock sensors.” Pet., 24-25. There is no evidence in either reference, however, to support this conclusion. Even accepting this statement as true, neither reference provides any guidance on how a skilled artisan would incorporate any alleged “motion sensor” into the Fujisawa watch and why it would have resulted in an operable device, let alone the claimed invention. *Medichem*, 437 F.3d at 1165 (“[P]rior art fails to provide the requisite ‘reasonable expectation’ of success where it teaches merely to pursue a ‘general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the

particular form of the claimed invention or how to achieve it.” (quoting *In re O’Farrell*, 853 F.2d at 903-04).

Here, the specific “sensors and software,” the extent of any modifications, the reasons for these modifications, and why there would have been a reasonable expectation of success are not adequately identified or supported. Pet., 22. Dr. Bims also fails to address why skilled artisans would have deemed it feasible and appropriate to modify the Fujisawa watch to include a “motion sensor” as allegedly described in Vock. Ex. 1005, 1:54-61; Ex. 1003, ¶¶ 89-91.

B. The Petition Fails to Provide Sufficient Evidence that Vock Combined with Narayanaswami or Fujisawa Discloses the “Watch Band” Limitations

It is indisputable that no reference cited in the Petition depicts in any illustration or written description “a watch band; a second watch band; a buckle, wherein said buckle is coupled to said second watch band” as recited in claim 1 of the ’633 Patent. While Petitioner and its declarant repeatedly claim that “the components of [a] watch band ... had been well known for decades to have two watch bands extending from a watch with a buckle to connect the bands to one another” and that this is “how watches have functioned for decades,” the Petition oddly provides no evidence supporting this assertion. Pet. 22, 28.

Petitioner admits that “Narayanaswami does not disclose the specific elements of the claimed watch band” and that “Fujisawa ... does not disclose a two-piece

watch band with a buckle.” Pet. 28. And even though Petitioner relies on Vock for this limitation, it too does *not* disclose the claimed configuration.

Vock depicts a “watch” in Figures 27, 28, 38, 39, 41 and 80. None of these figures show “a watch band; a second watch band; a buckle, wherein said buckle is coupled to said second watch band,” nor does the written description of Vock even contain the word “buckle” or describe multiple “bands.” Figures 27 and 41 do not show a two-piece band and a buckle.

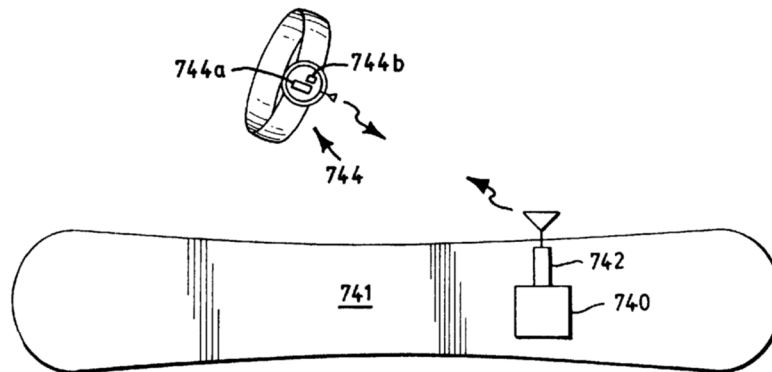


FIG. 27

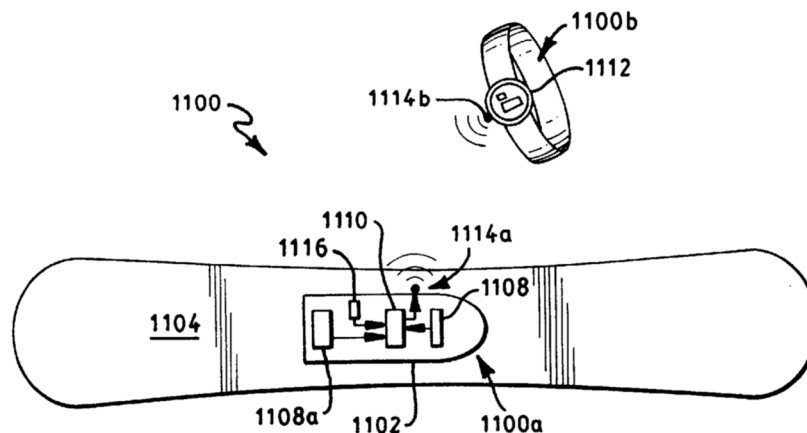


FIG. 41

Ex. 1007, 40:38-62 (describing watch 744 with no mention of bands or a buckle);
46:1-30 (describing watch 1112 with no mention of bands or a buckle).

Figures 38 and 39 – relied on by Petitioner – also do *not* depict a two-piece band and a buckle.

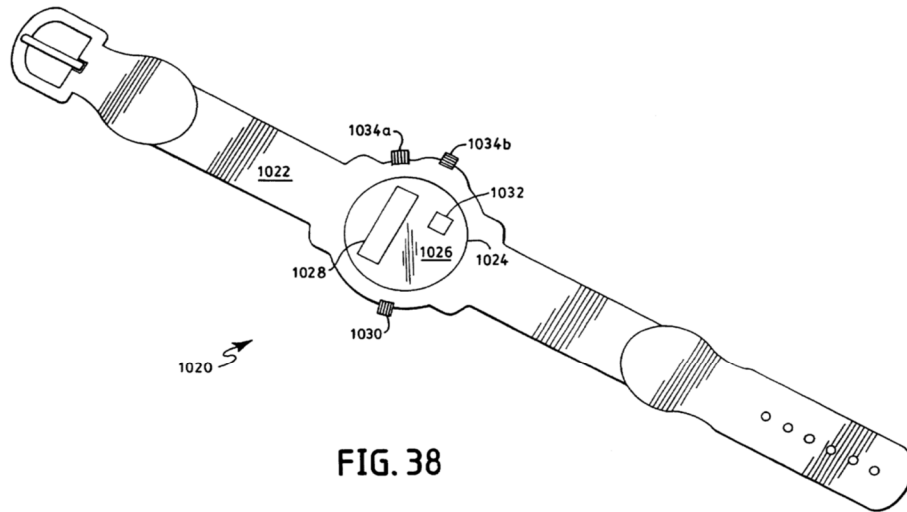


FIG. 38

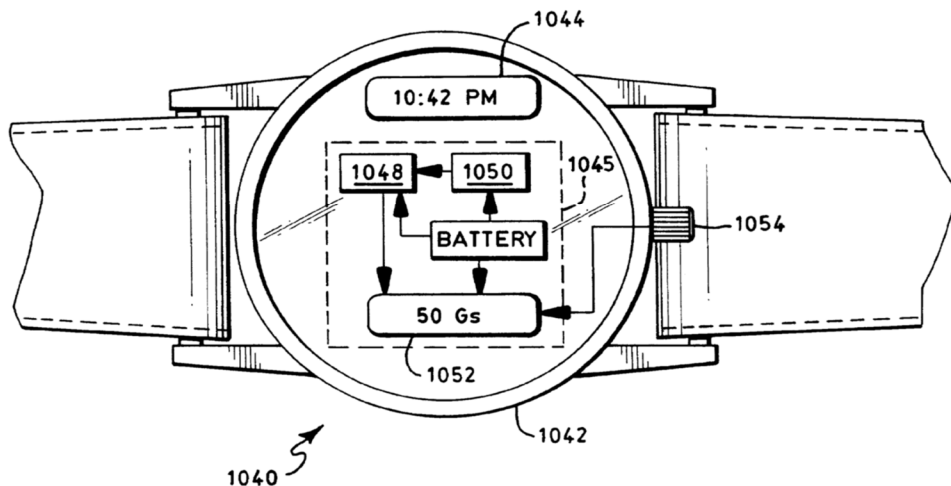


FIG. 39

Id., 44:26-47 (describing watch 1020 having a single “band 1022”); 44:48-45:5
(describing watch 1040 with no mention of a buckle nor multiple bands).

Figures 28 and 80 also do not show a two-piece band and a buckle

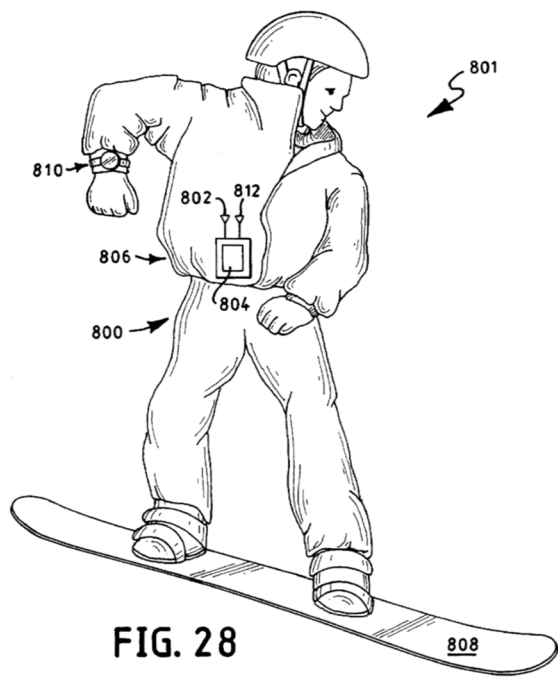


FIG. 28

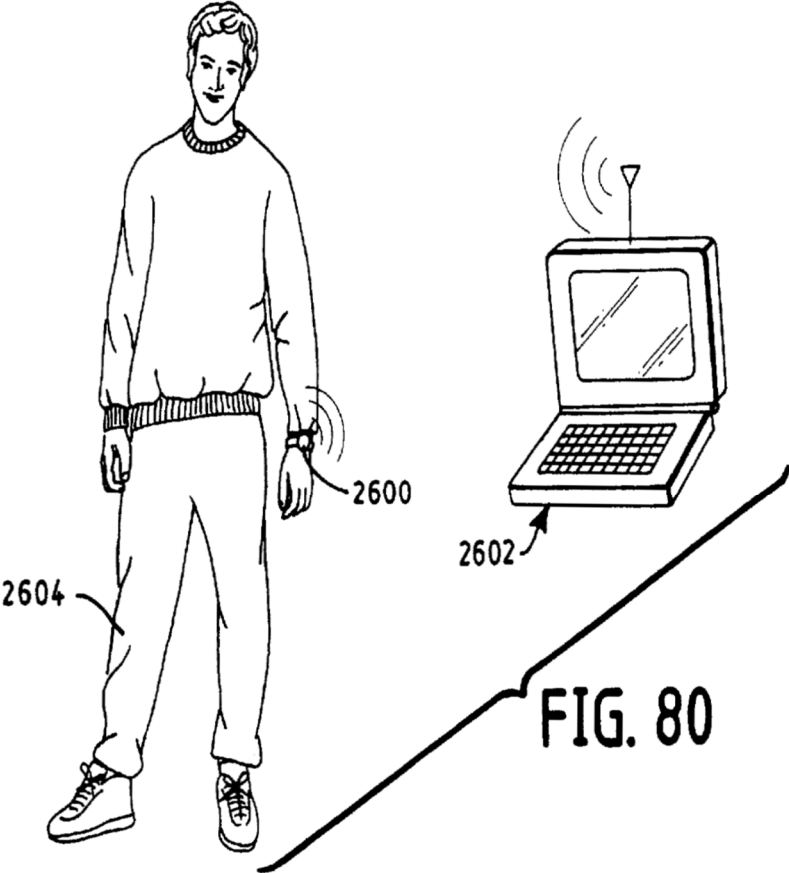


FIG. 80

Id., 40:63-41:8 (describing watch 810 with no mention of bands or a buckle); 60:15-30 (describing watch 2600 with no mention of bands or a buckle).

Despite these explicit disclosures, the Petition represents that Vock discloses a “two-band strap with a buckle” in each of Grounds 1 and 3:

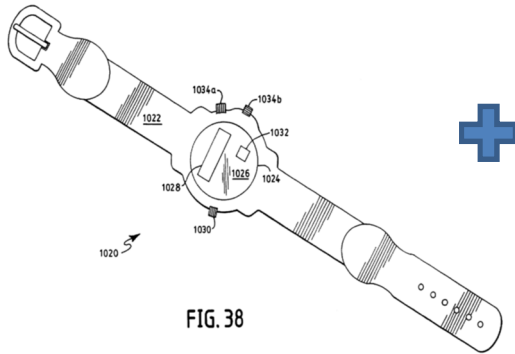
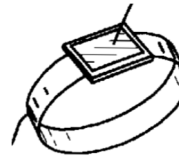
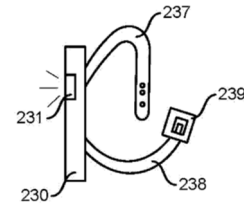
And as discussed in
Section VI.A, it would have been obvious to incorporate the two-band strap with a buckle disclosed in Vock with the Narayanaswami smart watch, at least because this is how watches have functioned for decades. *Id.*

Pet., 28 (annotated).

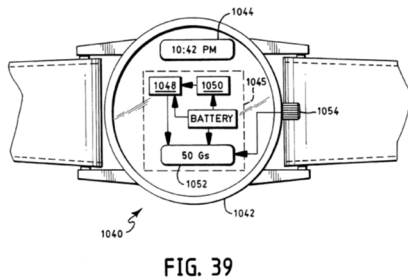
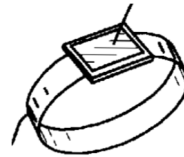
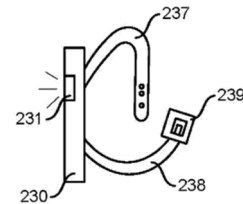
It would have been obvious to
incorporate the two-band strap with a buckle disclosed in Vock with the Fujisawa smart watch, at least because this is how watch bands have been used for decades.

Pet., 50 (annotated). These assertions are demonstrably false.

Narayanaswami. Incorporating *any* “watch band of Vock” into the Narayanaswami watch would not have provided for a two-band watch with a buckle as claim 1 of the ’633 Patent requires. For example, adding the single band with buckle in Figure 38 of Vock to the single-banded watch in Figure 1 of Narayanaswami would have provided for a single-banded watch with a buckle, not a two-banded watch with a buckle:

Vock, Fig. 38**Narayanaswami,
Fig. 1****'633 Patent,
Fig. 2**

Similarly, adding two embodiments together – Figure 39 and Figure 1 – neither of which disclose two bands or a buckle, would not have resulted in an embodiment *with* two bands *and with* a buckle:

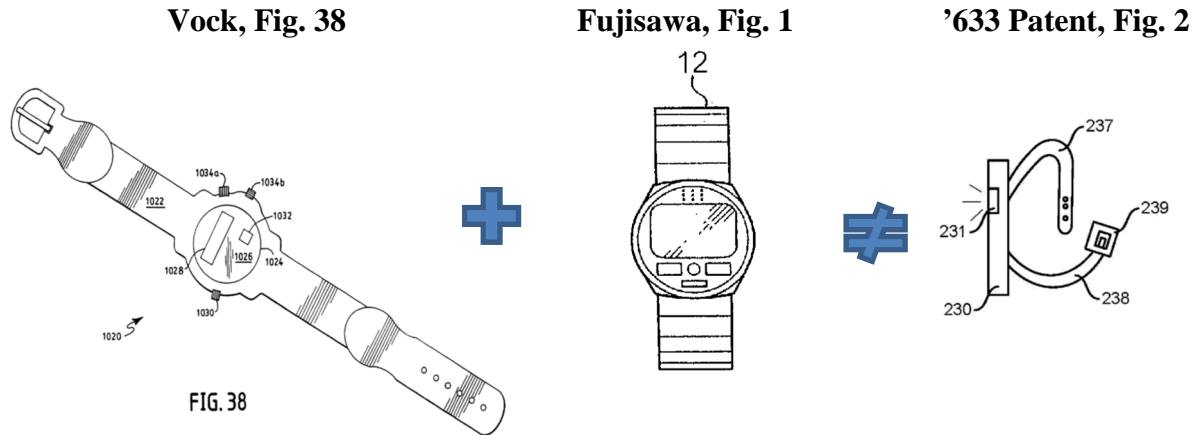
Vock, Fig. 39**Narayanaswami, Fig. 1****'633 Patent, Fig. 2**

Petitioner contends Figure 39 shows two bands but that is not necessarily true. Both portions shown on the sides of the watch face could most certainly be part of the same single band, e.g., a band of elastic, rubber or some other flexible material.

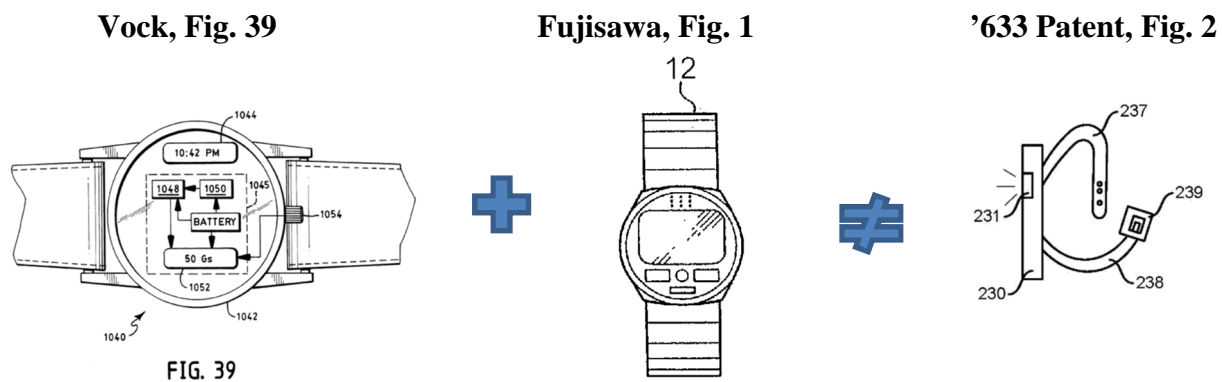
Dr. Bims' statement that "Narayanaswami does not include the two-piece band and buckle, but Vock does" is also demonstrably false. Ex.1003, ¶ 98. Dr. Bims' argument that "it would have been obvious to incorporate the two-band strap

with a buckle disclosed in Vock with the smart watch of Narayanaswami” also incorrectly presumes that Vock discloses a “two-band strap with a buckle,” which it does not. *Id.*, ¶ 100. Furthermore, Petitioner’s statement that Figure 39 “demonstrates that the smart watch of Vock includes two bands” mischaracterizes Vock (Vock never says “smart watch”) and presumes that Figure 39 includes two bands when, in fact, that figure is an incomplete illustration, as shown above. Indeed, the watch in Figure 39 may have three or more bands or use a mechanism other than a buckle, such as Velcro®, to attach the watch to a user. Critically, neither the Petition nor Dr. Bims even bother to argue that skilled artisans would have combined the embodiments in Figures 38 and 39 of Vock (assuming *arguendo* that Figure 39 discloses two bands).

Fujisawa. Similarly, incorporating *any* “watch band of Vock” into the Fujisawa watch would not have provided for a two-band watch with a buckle as claim 1 of the ’633 Patent requires. For example, adding the single band with buckle in Figure 38 of Vock to the band in Figure 1 of Fujisawa, which has no buckle or “lugs,” would not have provided for two bands and a buckle:



Similarly, adding two embodiments together – Figure 39 and Figure 1 – neither of which disclose a buckle, would not have resulted in an embodiment *with* a buckle:



Dr. Bims’ statement that “Fujisawa ... does not disclose a two-piece watch band with a buckle [but] Vock discloses a two-piece band with a buckle” is also demonstrably false. *Id.*, ¶ 153. Dr. Bims’ argument that “it would have been obvious to incorporate the two-band strap with a buckle disclosed in Vock with the smart watch of Fujisawa” also incorrectly presumes that Vock discloses a “two-band strap with a buckle,” which it does not. *Id.*

The Petition thus fails to present evidence sufficiently demonstrating this claim limitation in the cited art, and Grounds 1-4 should be rejected.

C. The Petition Fails to Provide Sufficient Evidence that Skilled Artisans Would Have Found the “Second Wireless Communication Signals Associated with a Second Event from Said Mobile Telephonic Device” Limitation Obvious

It is indisputable that Narayanaswami describes only one instance of the watch receiving a signal from a “mobile telephonic device,” namely one containing “caller ID information.” Ex. 1005, 7:63-8:5. Indeed communicating with a mobile phone is not a focus—Narayanaswami mentions “mobile phone” just twice as one of many devices that may communicate with the watch (Ex. 1005, 3:43-45, 4:53-59) and provides the single abovementioned “caller ID” embodiment. *Id.*, 8:3-17. These disclosures do not teach a watch that receives “second” signals associated with a “second” and “different” event “from said mobile telephonic device,” as referenced above in Section IV in connection with Petitioner’s incorrect claim interpretation.

Petitioner nevertheless asserts that Narayanaswami discloses this claim requirement by arguing (i) that the claims do “not require events of different types” and “Narayanaswami discloses receiving ... multiple phone calls” and, alternatively, (ii) that Narayanaswami describes using a PC to input a calendar appointment to the watch, which is “a second event of a different type” and that it would have been

obvious to input the appointment using a mobile phone. Pet., 30. Both arguments fail.

First, a proper construction of the “first event and second event are different” limitation in claim 1 requires **both** (i) the existence of a “first event” and a “second event” (i.e., they are not the same event) and (ii) that the first event and second event are “different.” Claim 1 does not cover first and second events that are, for example, both text messages or both incoming calls. Petitioner’s proposed construction and corresponding argument that “multiple phone calls” in Narayanaswami can be the recited “first event” and “second event” should be rejected. *See supra* Section IV.

Second, Petitioner and its declarant, Dr. Bims, admit that Narayanaswami does not disclose receiving “second” signals associated with a “second” and “different” event “from said mobile telephonic device,” as claim 1 of the ’633 Patent requires. Pet., 30; Ex. 1003, ¶ 105. The Petition and Dr. Bims thus allege that, at the time of the invention, “a mobile phone **would be capable of** executing a calendar application,” but each fail to support this technical assertion with any evidence. Pet. 30 (emphasis added). Moreover, based on this unsupported statement, Petitioner and Dr. Bims conclude, “**Thus**, it would have been obvious to receive the calendar information from the wireless phone.” *Id.* (emphasis added). This conclusory assertion is the product of an improper obviousness analysis. Rather than focusing on why skilled artisans would have been motivated to do what claim 1 requires,

Petitioner and Dr. Bims analyze what skilled artisans would have been able to do and would have understood the capabilities of a mobile phone to be. *Polaris Indus. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1069 (Fed. Cir. 2018) (faulting Board for focusing on what a skilled artisan would have been able to do, rather than what a skilled artisan would have been motivated to do at the time of the invention); *see also InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014) (concluding that expert “succumbed to hindsight bias in her obviousness analysis” where such analysis “primarily consisted of conclusory references to her belief that one of ordinary skill in the art could combine these references, not that they would have been motivated to do so”). Dr. Bims’ testimony on this point adds nothing beyond the conclusory statements in the Petition. Ex. 1003, ¶ 105.

Petitioner’s reliance on an excerpt from Narayanaswami regarding “synchronization manager 250” is misplaced and does not remedy these issues. Pet., 30. First, this disclosure is silent about “mobile phones.” Second, the entire paragraph – column 6, line 43 through column 7, line 17 – concerns the software architecture for “Wrist Watch device 10” and the process flows of that software, including between various applications, along communication channels and in response to “process events received from user input devices such as the roller wheel and touch panel.” Ex. 1005, 6:64-67. Read in context, the “update to a calendar

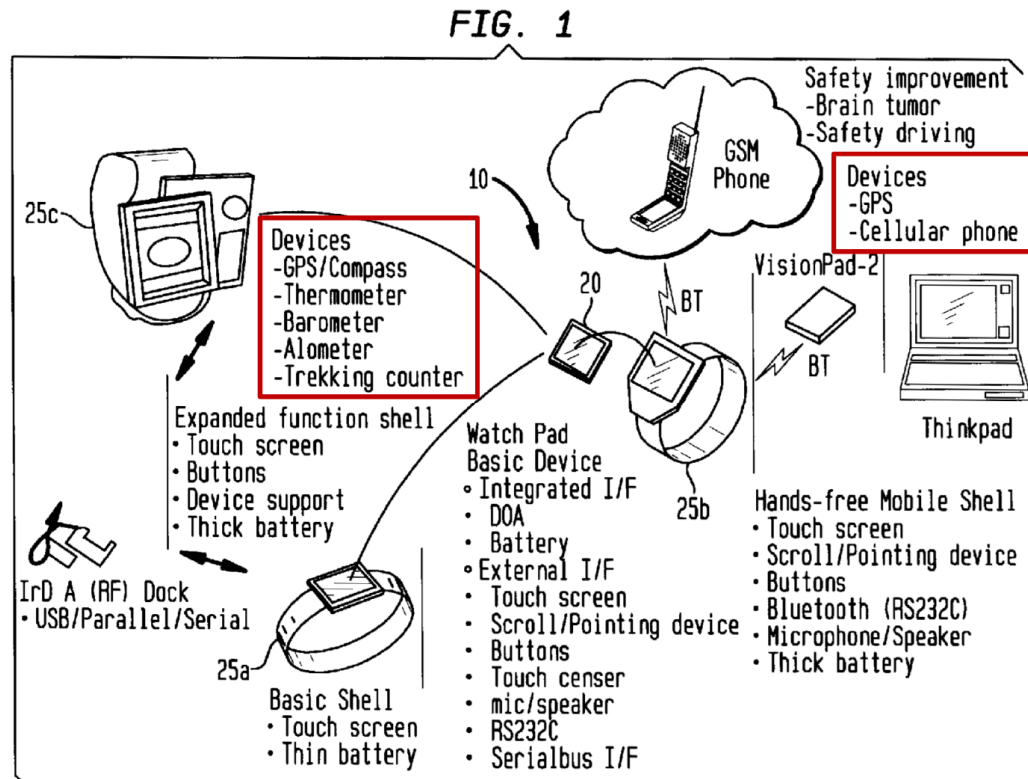
event” as described in this paragraph is an internal process flow, *not* a response to an external device. *Id.*, 7:5-9.

D. The Petition Fails to Provide Sufficient Evidence that Narayanaswami Discloses the “Motion Sensing” Limitation

Claim 1 of the ’633 Patent requires that the “device” include “motion sensing operable to distinguish between a plurality of different types of motion.” Ex. 1001, Claim 1. For this limitation in Ground 1, the Petition cites two disclosures in Narayanaswami—(i) a reference to an “expanded function shell 25c” that provides “support for various devices such as GPS/compass, thermometer, barometer, altimeter, etc.” and (ii) a statement about “additional tilt and motion (velocity, direction, speed) sensors.” Pet., 31-32. Neither disclosure teaches a “device [that] includes motion sensing operable to distinguish between a plurality of different types of motion,” and the Petition provides no supporting evidence to the contrary.

First, regarding the “GPS” and “altimeter” disclosures, Petitioner ignores the plain language of claim 1 requiring that the “device *includes* motion sensing.” Ex. 1001, Claim 1 (emphasis added). Quite differently, Narayanaswami explicitly describes the GPS and altimeter as external devices that “expanded function shell 25c” may “support.” Ex. 1005, 3:47-50. Narayanaswami does not teach that shell 25c “*includes*” motion sensing as claim 1 of the ’633 Patent requires. Consistent with Narayanaswami describing “shell 25c” as being configured to “support” (not

“include”) a GPS or altimeter, Figure 1 of Narayanaswami unequivocally illustrates the external devices (including a “GPS/Compass” and “Alometer” [sic]) that “shell 25c” and “shell 25b” may be configured to “support” and communicate with:



Ex. 1005, Fig. 1 (annotated). To be sure, Narayanaswami describes “shell 25b” as “providing, in addition to basic desktop functionality, a communications interface with *GPS and mobile phone communications capability*, etc.” *Id.*, 3:43-45. Petitioner does not argue against these clear teachings. For this reason alone, the Petition’s reliance on “GPS/compass, thermometer, barometer, altimeter” is misplaced.

Even if Narayanaswami disclosed that the wrist watch *included* a GPS or altimeter (which it does not), Petitioner offers no evidence or technical explanation as to why or how either of a GPS or altimeter senses motion. The Petition simply concludes that the “GPS and altimeter sensors are both capable of sensing motion,” without explanation. Pet., 32. The testimony from Petitioner’s declarant, Dr. Bims, in support of this assertion is equally unavailing, adding nothing beyond the same conclusion statement in the Petition. Ex. 1003, ¶ 107. Narayanaswami itself does not remedy these shortcomings in the Petition. Regarding “GPS,” Narayanaswami does not refer to “GPS” as a motion sensor, nor teach anywhere in its disclosure that the described “GPS” senses motion. Similarly, Narayanaswami does not explain what an altimeter is, how it works in the “watch” or what (if anything) it senses, and certainly does not describe it as a “motion sensor.” Despite this lack of disclosure in Narayanaswami, Petitioner and Dr. Bims offer no evidence on these terms. Pet., 32.

Moreover, that the device must “include” motion sensing is not the only language in the claim limitation ignored by Petitioners. The Petition also fails to allege, let alone explain, how a GPS or altimeter “distinguish between different types of motion” as claim 1 requires. The Narayanaswami specification mentions “motion” one time and is silent about “distinguishing between a plurality of different types of motion.” Ex. 1005, 6:15-21. Petitioner provides *no* analysis or evidence on this portion of the claim limitation, even though it is Petitioner’s burden to explain

to the Board how the GPS or altimeter disclosures in Narayanaswami render claim 1 unpatentable. Pet., 31-32. For this reason, the Petition fails.

Second, the Petition cites to Narayanaswami's statement that "additional sensors may be attached to the Wrist Watch device over an interface," including "additional tilt and motion (velocity, direction, speed) sensors." Pet., 32. In doing so, Petitioner again ignores the plain language of claim 1 requiring that the "device *includes* motion sensing." Ex. 1001, Claim 1 (emphasis added). As it does with the GPS and altimeter devices discussed above, Narayanaswami describes the "tilt and motion ... sensors," along with "environment sensors such as thermal sensors, pressure sensors, health monitoring sensors such as blood pressure, etc." as external devices that "may be attached to the device "over an interface." Ex. 1005, 6:15-21. Narayanaswami indeed explains that, in this configuration, the watch device "provides the display for the sensor and may also analyze the data collected by the sensor." *Id.*, 6:21-23. Again, to be sure, Figure 1 illustrates such sensors as external devices. *Id.*, Figure 1 (showing "barometer" (blood pressure), "thermometer" (thermal sensor) and "alometer" [sic] (pressure sensor)). For this reason alone, the Petition's reliance on the "additional tilt and motion (velocity, direction, speed) sensors" disclosure in Narayanaswami is misplaced.

Petitioner also ignores that the motion sensing must "distinguish between a plurality of different types of motion." *Id.* The Petition asserts that "[t]ilt is a type of

motion sensed with sensors” and “sensing velocity is also motion sensing” but goes no further in relating this disclosure to the claim language of the ’633 Patent. Pet., 32 (emphasis added). Petitioner provides no analysis or evidence directed to the balance of the limitation, namely that the motion sensing must “distinguish between a plurality of different types of motion.” *Id.* Even though it is Petitioner’s burden to explain to the Board how this statement in Narayanaswami renders claim 1 unpatentable, the Petition does not relate it to the claim language. The Petition does not explain, let alone by citing to evidence, why or how this disclosure teaches “distinguish[ing] between a plurality of different types of motion” as claim 1 requires.

Petitioner also fails to explain with supporting evidence why “tilt is a type of motion” as stated in the Petition. Pet., 32. Narayanaswami itself does not rescue Petitioner from its deficient showing. Narayanaswami describes a tilt sensor as one for detecting position or orientation of the watch, e.g., 6:10-17 (“To detect the posture of the watch, a mechanical four-way tilt sensor 72 is further provided comprising mechanical switches (for detecting degree of tilt)...”); 11:14-18 (“1) the user did not hear the alarm although the watch is on the wrist, or 2) the watch is not on the user’s wrist at all. The watch distinguishes these two cases by periodically monitoring the tilt sensor 72 (FIG. 2) on the watch”); 13:48-58 (“If the tilt sensor indicates that it is possible the watch is on the wearer’s wrist, then the system

automatically sets a snooze alarm at block 535 and returns to the default clock display. Otherwise, if the tilt sensor indicates that the watch is not on the wearer's wrist, then the system cancels the alarm at block 537 and returns to the default clock display.”). Narayanaswami does not describe the “tilt sensor” as detecting motion and, in fact, distinguishes the “tilt sensor” from a “motion ... sensor” by describing the two sensors separately in the same sentence—“Examples may include additional tilt and motion (velocity, direction, speed) sensors.” Ex. 1005, 6:17-18. Petitioner and its declarant offer no evidence on this point—both the Petition and Dr. Bims simply conclude, without more, that “[t]ilt is a type of motion sensed with sensors.” Pet., 32; Ex. 1003, ¶ 107. Petitioners and Dr. Bims also fail to cite any evidentiary support or explain what a “ball-in-a-tube sensor” is, how it measures motion and how it relates to a “tilt sensor.”

E. The Petition Fails to Provide Sufficient Evidence that Vock Combined with Fujisawa Discloses the “Motion Sensing” Limitation

Claim 1 of the '633 Patent requires that the “device” include “motion sensing operable to distinguish between a plurality of different types of motion.” Ex. 1001, Claim 1. For this limitation in Ground 3, the Petition relies exclusively on Vock because “Fujisawa does not disclose motion sensing.” Pet., 52. Petitioner fails, however, to sufficiently explain how or why Vock teaches the claimed “motion sensing” requirements. The Petition contains four disparate sentences regarding

disclosures in Vock – none of which reference “motion sensing” or “distinguish[ing] between a plurality of different types of motion.” *Id.* Petitioner improperly leaves it to the Board to deduce what these disclosures mean and how they relate to claim 1.

The Petition states that “Vock discloses, ‘[t]he watch 1020 also holds a power sensing unit 1032....’” and that the “‘power sensing unit [] provides a measure of the intensity and how ‘hard’ the user played during a particular activity.’” *Id.* Petitioner does not explain how or why the “power sensing unit” senses motion or “distinguish[es] between a plurality of different types of motion.” Petitioner also does not clarify whether “intensity” equates to, or even relates to, motion and, if it does, how or why that is the case. Nor does Petitioner clarify whether “how ‘hard’ the user played” equates to, or even relates to, motion and, if it does, how or why that is the case. In other words, even though it is Petitioner’s burden to explain to the Board how Vock combined with Fujisawa teaches the “motion sensing” limitation, the Petition does not relate these disclosures to what is recited in claim 1 of the ’633 Patent.

The Petition further asserts that the “power sensing unit may include, for example, one or more microphones or accelerometers,” but again fails to explain or cite any further evidence as to how this disclosure relates to “motion sensing” and “distinguish[ing] between a plurality of different types of motion.” *Id.*

Petitioner alleges that the “watch may also include an altimeter to provide a ‘dual drop distance and power watch embodiment.’” *Id.* First, this assertion mischaracterizes the Vock disclosure—while Vock associates an “altimeter” with “drop distance,” it does indicate that an “altimeter” measures or otherwise senses “power.” The reference to “power” in lines 1-5 of column 45 concerns that parameter being displayed on display 1052 in Figure 39; it does not refer to “power” being sensed by an altimeter. Moreover, the Petition does not contend that an “altimeter” senses motion or “distinguish[es] between different types of motion,” let alone explain how or why an “altimeter” might have such functionality. Petitioner also fails to explain the meaning of the phrase “dual drop distance and power” and how it relates, if at all, to the “motion sensing” limitation in claim 1. That is, the Petition does not discuss how either of “dual drop” or “power” equates to, or even relates to, motion and, if either of these disclosures do, how or why that is the case.

Petitioner’s expert declaration from Dr. Bims in support of the assertion that Vock teaches a “device” that includes “motion sensing operable to distinguish between a plurality of different types of motion” adds nothing beyond the conclusory statements in the Petition. Ex. 1003, ¶ 157.⁸ Dr. Bims’ contention that the “altimeter ... in addition to sensors for ‘airtime’, and ‘speed’,” teach that “Vock discloses

⁸ For the “motion sensing” limitation in Ground 3, the Petition cites in error to ¶ 156, instead of ¶ 157, of Dr. Bims’ Declaration.

distinguishing between different types of motion” is not adequately supported. *Id.* Dr. Bims does not explain how or why an “altimeter” senses motion, nor does he clarify whether “airtime” equates to, or otherwise relates to, motion and, if it does, how or why that is the case. Dr. Bims also fails to clarify whether “speed” equates to, or otherwise relates to, motion and, if it does, how or why that is the case. His testimony also does not identify what sensors in Vock relate to “airtime” or “speed” and whether those devices include “motion sensing” and are “operable to distinguish between a plurality of different types of motion.”

VII. CONCLUSION

For at least the foregoing reasons, Patent Owner respectfully submits that (i) the Petition is ripe for discretionary denial under 35 U.S.C. 314(a) based on the *Fintiv* factors; and, additionally, (ii) the Petition should be denied for failing to demonstrate a reasonable likelihood that Petitioner would prevail on showing that at least independent claim 1 of the '633 Patent is unpatentable.

Dated: December 8, 2022

Respectfully submitted,

/Peter F. Snell/

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CERTIFICATE OF WORD COUNT

The undersigned certifies pursuant to 37 C.F.R. § 42.24(d) that the foregoing Petition for Inter Partes Review excluding any table of contents, table of authorities, certificates of service or word count, or appendix of exhibits or claim listing, contains 13,905 words according to the word-processing program used to prepare this paper (Microsoft Word). Petitioner certifies that this Petition for Inter Partes Review does not exceed the applicable type-volume limit of 37 C.F.R. § 42.24(a).

Dated: December 8, 2022

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CERTIFICATE OF SERVICE

I certify that a copy of Patent Owner's Mandatory Notices is being served by electronic mail on the following counsel of record:

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