

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Gregory J. Pinter

U.S. Patent No.: 5,894,506

Attorney Docket No.: 39521-0003IP1

Issue Date: April 13, 1999

Appl. Serial No.: 08/708,696

Filing Date: September 5, 1996

Title: METHOD AND APPARATUS FOR GENERATING AND COMMUNICATING MESSAGES BETWEEN SUBSCRIBERS TO AN ELECTRONIC MESSAGING NETWORK

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**PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 5,894,506
PURSUANT TO 35 U.S.C. §§ 311-319, 37 C.F.R. § 42**

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EXHIBITS

APL-1001	U.S. Patent No. 5,894,506 to Gregory J. Pinter (“506 Patent”)
APL-1002	Prosecution History of the ‘506 Patent
APL-1003	Declaration of Dr. Rajeev Surati (“Surati”)
APL-1004	U.S. Patent No. 5,850,594 to Cannon et al. (“Cannon”)
APL-1005	U.S. Patent No. 5,970,122 to LaPorta et al. (“LaPorta”)
APL-1006	U.S. Patent No. 5,588,009 to Craig A. Will (“Will”)
APL-1007	Claim Construction Order from <i>Mobile Telecommunications Technologies, LLC v. Apple Inc.</i> , Civil Action No. 2:13-cv-258-JRG-RSP (E.D. Tex.) (“Markman Order”)
APL-1008	Plaintiff’s Opening Brief on Issues of Claim Construction from <i>Mobile Telecommunications Technologies, LLC v. Apple Inc.</i> , Civil Action No. 2:13-cv-258-JRG-RSP (E.D. Tex.)
APL-1009	Docket for <i>Mobile Telecommunications Technologies, LLC v. Apple Inc.</i> , Case No. 2:13-CV-258 (E.D. Tex.)
APL-1010	Claim Construction Order from <i>Mobile Telecommunications Technologies, LLC v. Clearwire Corp.</i> , Civil Action No. 2:12-cv-308-JRG-RSP (E.D. Tex.) (“Clearwire Order”)
APL-1011	U.S. Patent No. 5,784,001 to Deluca et al. (“Deluca”)

Apple Inc. (“Petitioner” or “Apple”) petitions for *Inter Partes* Review (“IPR”) under 35 U.S.C. §§ 311–319 and 37 C.F.R. § 42 of claims 8-14, 19 and 21 (“the IPR Claims”) of U.S. Patent No. 5,894,506 (“‘506 Patent”) of assignee Mobile Telecommunications Technologies, LLC (“Patentee” or “MTel”). As explained in this petition, there exists a reasonable likelihood that Apple will prevail with respect to at least one claim challenged in this petition.

I. MANDATORY NOTICES UNDER 37 C.F.R § 42.8(a)(1)

A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)

Petitioner, Apple Inc., is the real party-in-interest.

B. Related Matters Under 37 C.F.R. § 42.8(b)(2)

Apple is not aware of any disclaimers or reexamination certificates for the ‘506 Patent. The ‘506 Patent does not have any related continuation application. Apple has been named as a defendant in a recently-filed litigation concerning the ‘506 Patent, *Mobile Telecommunications Technologies, LLC v. Apple Inc.*, Civil Action No. 2:13-cv-258-JRG-RSP (E.D. Tex.) (“MTEL Litigation”).¹ Apple has also petitioned—on this same day—for another *Inter Partes* Review of the ‘506 Patent on different grounds of rejection, and for *Inter Partes* Review of several other patents at issue in the MTEL litigation, namely, U.S. Patent Nos. 5,659,891, 5,915,210 and 5,590,403.

¹ This action has been consolidated with other district court cases concerning the same patent. The consolidated lead case is captioned *Mobile Telecommunications Technologies, LLC v. Sprint Nextel Corporation*, Civ. Action No. 2:12-cv-832-JRG-RSP (E.D. Tex.).

C. Counsel Under 37 C.F.R. § 42.8(b)(3), and Service

Apple designates W. Karl Renner, Reg. No. 41,265, as Lead Counsel and Thomas A. Rozy-lowicz, Reg. No. 50,620, as Backup Counsel, both available at 3200 RBC Plaza, 60 South Sixth Street, Minneapolis, MN 55402 (T: 202-783-5070; F: 202-783-2331. Please address all correspondence and service to counsel at the address provided in Section I(C). Apple also consents to electronic service by email at IPR39521-0003IP1@fr.com.

II. PAYMENT OF FEES – 37 C.F.R. § 42.103

Apple authorizes the Patent and Trademark Office to charge Deposit Account No. 06-1050 for the fee set in 37 C.F.R. § 42.15(a) for this Petition, and further authorizes payment for any additional fees to be charged to this Deposit Account.

III. REQUIREMENTS FOR IPR UNDER 37 C.F.R. §§ 42.104

A. Grounds for Standing Under 37 C.F.R. § 42.104(a)

Apple certifies that the '403 Patent is eligible for IPR and that Apple is not barred or estopped from requesting IPR. The present petition is being filed within one year of when Apple's waiver of service was filed in the co-pending district court litigation, Case No. 2:13-CV-258, which took place on June 27, 2013. See APL-1009, p. 9; see also *Macauto U.S.A. v. BOS GMBH & KG* (IPR2012-00004), Paper No. 18 at 16.

B. Challenge Under 37 C.F.R. § 42.104(b) and Relief Requested

Apple requests IPR of the Challenged Claims of the '506 Patent on the grounds set forth in the table below, and requests that each of the claims be found unpatentable.

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