UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC. Petitioner

v.

IXI IP, LLC Patent Owner

Case IPR2019-00140 Patent 7,039,033 B2

PATENT OWNER IXI IP, LLC'S PRELIMINARY RESPONSE TO APPLE, INC.'S PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 7,039,033 PURSUANT TO 35 U.S.C. § 313, 37 C.F.R. § 42.107

DOCKET

TABLE OF CONTENTS

I.	INTF	INTRODUCTION		
II.	THE PETITION IS TIME BARRED UNDER 35 U.S.C. § 315(b)7			
	A.	The Office Lacks Jurisdiction Because The Petition Was Filed Over Three Years After The § 315(b) Bar Expired		
		Issuance Of A Reexamination Certificate Does Not Nullify The One Year Filing Limitation Under 35 U.S.C. § 315(b)		
		1. The Federal Circuit Has Held that New Claims In Reexamination Do Not Create A New Patent Under § 315(b).10		
		2. The Director Agrees That Reexamination Does Not Reset §315(b)		
		3. The Board Also Agrees That Reexamination Does Not Reset §315(b)		
	C.	Apple's Arguments That The New Claims Are "Substantively Different" Contradicts Its Prior Statements That They Are Not15		
	D.	Subsection 315(b) Would Preclude Institution Even Under Chevron		
	E.	The Law Governing Reissued Patents And Infringement Damages Does Not Govern Reexamined Patents Under § 315(b)20		
	F.	Apple's Joinder Request Cannot Nullify The § 315(b) Time Bar23		
III.	BEC	PETITION SHOULD ALSO BE DENIED UNDER § 325(d) AUSE SUBSTANTIALLY SIMILAR ARGUMENTS AND ERENCES WERE JUST CONSIDERED BY THE OFFICE25		
	A.	The Central Reexamination Unit Recently Analyzed Substantially The Same Arguments And Subject Matter27		
	р			

B. The § 325(d) Factors Collectively Support Denial Of Institution.30

DOCKET

Page

	1.	<i>Factors 1-3:</i> (1) the similarity of the asserted art and the prior art involved during the examination; (2) the extent to which the asserted art was considered during examination, including whether the prior art was the basis for rejection; & (3) the cumulative nature of the asserted art and the prior art considered during examination
	2.	Factor 4: the extent to which the arguments made during examination and the manner in which Petitioner relies on the prior art or the applicant's arguments during examination overlap
	3.	Factor 5: whether Petitioner has pointed out sufficiently how the Examiner erred in its consideration of the asserted prior art
	4.	Factor 6: the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the asserted prior art
	5.	Additional Factor: the burden on the patent owner 44
IV.	CONCLUS	ION44

TABLE OF AUTHORITIES

Page(s)

CASES

Abbott Labs. v. United States, 573 F.3d 1327 (Fed. Cir. 2009)	14
Aspex Eyewear, Inc. v. Marchon Eyewear, Inc., 672 F.3d 1335 (Fed. Cir. 2012)	11, 15, 21, 22
Bloom Eng'g Co. v. N. Am. Mfg. Co., 129 F.3d 1247 (Fed. Cir. 1997)	23
Chevron, U.S.A., Inc. v. NRDC, Inc., 467 U.S. 837 (1984)	
Click-To-Call Techs., LP v. Ingenio, Inc., 899 F.3d 1321 (Fed. Cir. 2018), pet. for cert. filed sub nom. Dex Click-To-Call Techs., LP (U.S. Jan. 11, 2019) (No. 18-916)	
Convolve, Inc. v. Compaq Computer Corp., 812 F.3d 1313 (Fed. Cir. 2016)	23
<i>Senju Pharm. Co. v. Apotex Inc.</i> , 746 F.3d 1344 (Fed. Cir. 2014)	11, 15, 19, 20
Splane v. West, 216 F.3d 1058 (Fed. Cir. 2000)	13
VirnetX Inc. v. Mangrove Partners, No. 17-1383 (Fed. Cir.)	25

STATUTES

35 U.S.C. § 252	22
35 U.S.C. § 302	40
35 U.S.C. § 305	40
35 U.S.C. § 307	40
35 U.S.C. § 307(b)	
35 U.S.C. § 315(b)	passim
35 U.S.C. § 325(d)	passim

ADMINISTRATIVE DECISIONS

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017- 01586, Paper 8 (PTAB Dec. 15, 2017)
<i>Biodelivery SI v. MonoSol Rx</i> , IPR2013-00315, Paper 31 (PTAB Nov. 13, 2013)14
<i>Blue Coat Sys., Inc. v. Finjan, Inc.,</i> IPR2016-00498, Paper 10 (PTAB June 20, 2016)24
<i>Edge Endo LLC v. Scianamblo</i> , IPR2018-01320, Paper 15 (PTAB Jan. 14, 2019)
<i>Fox Factory, Inc. v. SRAM, LLC,</i> IPR2017-01439, Paper 7 (PTAB Dec. 9, 2017)
<i>Fresenius Kabi USA, LLC v. Hospira, Inc.,</i> IPR2017-01055, Paper 10 (PTAB Sept. 6, 2017) (concurrence)24
Google LLC v. Uniloc Luxembourg S.A., IPR2017-01665, Paper 10 (PTAB Jan. 11, 2018)
<i>Intel Corp. v. Godo Kaisha IP Bridge</i> , IPR2018-00756, Paper 11 (PTAB Oct. 9, 2018)
Juniper Networks, Inc. v. Mobile Telecomm'ns Techs., LLC, IPR2017-00642, Paper 24 (PTAB July 27, 2017)
<i>Merial Inc. v. Intervet Int'l B.V.</i> , IPR2018-00919, Paper 13 (PTAB Oct. 22, 2018)
<i>Nora Lighting, Inc. v. Juno Mftg., LLC,</i> IPR2015-00601, Paper 13 (PTAB Aug. 12, 2015)31
Novartis Pharms. Corp. v. Plexxicon, Inc., IPR2018-01287, Paper 17 (PTAB Jan. 16, 2019)
<i>Nu Mark LLC v. Fontem Holdings 1, B.V.</i> , IPR2016-01309, Paper 11 (PTAB Dec. 15, 2016)37
<i>Polygroup Ltd. v. Willis Elec. Co., Ltd.,</i> IPR2016-00801, Paper 8 (PTAB Oct. 17, 2016)32
Proppant Express Investments, LLC v. Oren Techs., LLC, IPR2018-00914, Paper 21 (PTAB Nov. 8, 2018)25
Proppant Express Investments, LLC v. Oren Techs., LLC, IPR2018-00914, Paper 24 (PTAB POP Dec. 3, 2018) (per curiam)25

DOCKET A L A R M



Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.