

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

IXI IP, LLC,
Patent Owner

Case IPR2019-00141
Patent No. 7,039,033

PETITIONER'S NOTICE OF APPEAL

Pursuant to 37 C.F.R. § 90.2(a), Petitioner Apple Inc. (“Apple”) hereby respectfully gives notice that it appeals to the United States Court of Appeals for the Federal Circuit from the Patent Trial and Appeal Board’s (“Board”) Institution Decision entered on June 3, 2019 (Paper No. 13) (the “Institution Decision”), as well as from all other underlying orders, decisions, rulings, and opinions that are adverse to Petitioner.

For the limited purpose of providing the Director with the information requested in 37 C.F.R. § 90.2(a)(3)(ii), the issues on appeal may include, but are not limited to, the Board’s determination that Apple is time-barred from petitioning for *inter partes* review under 35 U.S.C. § 315(b) (“An *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.”) As explained in Apple’s petitions, though Apple was previously served with a complaint alleging infringement of some claims of the ’033 patent, those claims were later cancelled as a result of an earlier successful IPR petition brought by Apple. *See IXI IP, LLC v. Samsung Elecs. Co.*, 903 F.3d 1257 (Fed. Cir. 2018) (affirming Board’s determination that asserted claims were unpatentable). The claims challenged in the present petition did not exist at the time IXI’s complaint was served, nor did they exist at the time Apple filed its earlier petition. The claims were issued as a part of

an *ex parte* reexamination initiated by IXI after the Board found the originally asserted claims unpatentable and while appeal of that decision to the Federal Circuit was pending. As such, Apple will argue to the Federal Circuit that it should not be barred from seeking *inter partes* review of claims that did not exist at the time it was served with IXI's complaint.

Apple may additionally argue that the agency improperly promulgated policy in a manner inconsistent with the Administrative Procedures Act.

The Board's order denying institution is appealable pursuant to 28 U.S.C. § 1295(a)(4) and is not barred by 35 U.S.C. § 314(d). The Board's order denying institution is a final order "with respect to a[n] . . . inter partes review under title 35." *See* 28 U.S.C. § 1295(a)(4); *see also Bankers Tr. Co. v. Mallis*, 435 U.S. 381, 387 (1978) (explaining that an agency determination is final and ready for appeal when the determination "represents the final decision in the case"); *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1348 (Fed. Cir. 2018) (holding that section 1295(a)(4) allows for appeal of "adverse judgments" arising from decisions of the PTAB, provided that the entered adverse "judgment terminate[s] the IPR proceeding"). The Board's order denying institution is a jurisdictional decision with respect to the application of the time bar of 35 U.S.C. § 315(b), which the *en banc* Federal Circuit determined to be a reviewable decision because it was not a decision under 35 U.S.C. § 314 and the appeal exemption set forth by 35 U.S.C. § 314(d) is

limited to decisions “under this section.” *See Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364, 1375 (Fed. Cir. 2018) (“[W]e hold that the Director’s time-bar determinations under § 315(b) are not exempt from judicial review” under section 314(d)).¹

Simultaneous with this submission, a copy of the Notice of Appeal is being filed electronically with the Patent Trial and Appeal Board. In addition, a copy of this Notice of Appeal, along with the required docketing fees, is being electronically filed with the Clerk’s Office for the United States Court of Appeals for the Federal Circuit.

Respectfully submitted,

Dated: August 5, 2019

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¹ The preceding discussion of the jurisdiction of the Court of Appeals for the Federal Circuit is provided for exemplary purposes only. Apple reserves the right to supplement or amend arguments should the need so arise.

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on August 5, 2019, a complete and entire copy of this Petitioner's Notice of Appeal was provided via email to the Patent Owner by serving the correspondence address of record as follows:

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