UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2019-00251
Patent 6,993,049 B2

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO FILE SUPPLEMENTAL INFORMATION

Petitioner Apple's Motion to File Supplemental Information ("Mot." or "Motion") should be rejected as failing to address or even mention the two basic questions set forth in the Board's authorization, emailed on August 27, 2019. The Board's authorization clearly stated "[t]he papers should address why the supplemental information reasonably could not have been obtained earlier, and why consideration of the supplemental information would be in the interests-of-justice."

Rather than address why the supplemental information reasonably could not have been obtained earlier, as ordered by the Board, Apple defies the Board by challenging the relevance of the question itself. Mot. 1. Apple purports to justify its stance by pointing to Rule 42.123(a) and a non-precedential opinion. *Id*. (citing IPR2014-01204, Paper 26, 4). However, nothing in the cited rule (or the non-precedential opinion for that matter) proscribes the Board from ordering the movant to provide certain information the Board deems useful to its *discretionary* decision.

The PTAB considered a similar a motion to submit supplemental information under 37 C.F.R. § 42.123(a) in IPR2017-01541, Paper 14. The Board there observed that "the requirements laid out in 37 C.F.R. § 42.123(a) do not prohibit us from exercising discretion." *Id*. at 3 (citing *Redline Detection,* 811 F.3d 435, 446–49 (Fed. Cir. 2015)). In denying the motion, the Board further explained that "Petitioner has not sufficiently persuaded us why the supplemental information could not have been filed with the Petition or why granting such a motion would be more than an opportunity 'to supplement a petition after initial comments or arguments have been laid out by a patent owner.'" *Id*. (citing IPR2014–00561, Paper 23 at 3, which quotes *Redline*, 811 F.3d at 448).

There is a simple explanation for why Apple avoided the specific question the Board ordered Apple to address. The facts here confirm that Apple reasonably could have obtained—*and admittedly did obtain*—the information much earlier.

Apple cited the *same* reference at issue (Ex. 1014, which Petitioner refers to as the BT Core document) *well over a year ago* in IPR2018-01092, filed on May 29, 2018. Apple fails to explain why it took nearly a year (i.e., in the time since Apple filed the instant Petition) for Apple to seek to submit the supplemental information in question, in an attempt to cure deficiencies of this *same* reference.

Furthermore, Apple alleges it merely seeks to submit a declaration similar to what it had previously submitted as Exhibit 1008 in IPR2019-1337, filed on July 16, 2019. Mot. 3. Apple fails to explain how the *same* supplemental information reasonably could not have been obtained earlier when in fact it *was obtained earlier* and indeed deemed ready for filing as early as July 16, 2019.

Apple spills much ink (about a third of its Motion) challenging Uniloc's characterization of its preliminary response filed in that matter, which is dated Oct. 16, 2018, and hence *before* Apple filed the instant Petition. In doing so, Apple seems to suggest that its obligation to "adhere to the requirement that the initial petition identify with particularity the evidence that supports the grounds for the challenge to each claim" only arises if Uniloc had previously included certain magical language in responding to a different matter relying on the *same* reference. *See Wasica Finance,* 853 F.3d 1272, 1286-87 (Fed. Cir. 2017) (citations omitted). Not so.

In the preliminary response in question, and citing its expert's testimony, Uniloc at least brought to the attention of both the Board *and Apple*, before Apple

filed the instant Petition, that (1) "it disputes [Apple]'s allegation that a person of ordinary skill in the art as of January 2002 would 'readily be familiar with the Bluetooth [] communication standards and implementation of wireless communication using such standards"; and that (2) "[t]he Bluetooth specification wasn't ratified by the IEEE until 2002." IPR2018-01092, Pap. 8 at 2-3. This should have at least triggered Apple to consider including within the instant Petition (filed a month later) the supplemental information it now seeks to add *nearly a year later*. Apple's Motion fails to offer any argument to the contrary.

Regarding the second issue the Board ordered Apple to address, the Motion fails to address or even include the phrase "interests-of-justice." The burden does not lie with Uniloc on this issue; and indeed, the Motion fails to articulate any argument for Uniloc to rebut. Nevertheless, given the demonstrable facts above, which Apple ignores, the interests of justice would not be served by rewarding Apple for its clearly intentional delay, as this would unjustifiably complicate the issue with additional testimony to consider, of a *new* declarant, and at this late stage.

Uniloc further notes that Apple has already impermissibly filed as an exhibit the supplemental information that is the subject of its Motion, without prior authorization for it to do so. Uniloc hereby *objects* and expressly requests (1) that the Board disregard Exhibit 1020, and (2) that the exhibit be *expunged* from the record. To the extent Uniloc's request to expunge must be effected through a motion, Uniloc hereby expressly requests authority to file such a motion.

Date: September 6, 2019

Respectfully submitted,

By: /s/ Brett A. Mangrum

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