

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.
Petitioner

v.

UUSI, LLC dba NARTRON
Patent Owner

Case IPR2019-00356
Patent No. 5,796,183

**PATENT OWNER'S FURTHER BRIEF IN SUPPORT OF
DISCRETIONARILY DENYING INSTITUTION UNDER
35 U.S.C. § 314(a)**

Patent Owner submits this paper in response to the PTAB's May 22, 2019 Order allowing three-page briefs addressing the precedential *Valve* decision.

Valve reaffirmed that the Board, under § 314(a), may consider “any relationship between [the] petitioners when weighing the *General Plastic* factors,” not just strict privity, or whether petitioners are co-defendants in a single suit. *See Valve* at 9 (citing *NetApp*, IPR2017-01195 (Paper 9)). *Valve* further affirmed that no single *General Plastic* factor or relationship type is dispositive. In this Petition, *Valve* solidifies Patent Owner's arguments for denying institution under § 314(a). While *Valve*'s application in this case still supports non-institution under *General Plastic* factor one, it further tips factors two through seven firmly to denial.

Factor One: The '183 Patent is the subject of two patent infringement suits. The first led Samsung to challenge 30 claims in an IPR, but the Final Written Decision (FWD) found it failed to show any challenged claim unpatentable. The second suit, filed 6 weeks after the FWD, led Apple to file six new petitions—nearly 12 months later.

This factor favors denial here, even though Samsung petitioned first. *Valve* at 9. Both petitioners share a common desire to see the same claims invalidated. Both petitioners are defendants in co-pending lawsuits having the same procedural posture, *i.e.*, both are stayed pending Samsung's appeal of its IPR loss. And Apple challenged the same claims as Samsung. (Apple challenged more claims, but that

is hardly surprising, as it filed six petitions compared to Samsung's one). Apple and Samsung are similarly situated and, thus, this factor weighs in favor of denial.

Factor Two: Despite its assertion to the contrary, almost half the references used in its Petition were known to Apple years before Samsung was even sued. To avoid using the exact art from the just-concluded IPR, Apple merely picked earlier patents from the same inventors (Caldwell and Ingraham). As in *Valve*, Apple knew of at least some of the alleged "new" references and should have been aware of others from the research endeavors of the same parties. *Cf. id.* at 11 (imputing knowledge between different research groups). This factor strongly favors denial.

Factor Three: Apple learned from the entire Samsung IPR, using it as a roadmap in locating the few references that it was not already aware of, and in cherry-picking claim constructions it agreed with while attempting to distinguish others it did not, as shown in the Preliminary Response. *Valve* expressly warns against such behavior. *Cf. id.* at 12-13. This factor plainly favors denial.

Factors Four and Five: Apple in 2013 was aware of three of the seven references asserted in this Petition—and was aware of two more (to Ingraham), and a more relevant version of them, prior to the filing of this IPR, from Samsung's IPR. Apple does not provide any credible explanation related to the timing of its Petition and, as the Board has noted, to the extent a reasonable explanation exists for Petitioner's delay, it is incumbent upon Petitioner to identify those

circumstances. And if five months with an intervening change in the law was excessive in *Valve*, then surely 12 unexplained months of delay is too much here. *See id.* at 14; *NetApp* (denying institution where patent owner sued petitioner more than 1 year after suing third parties who petitioned for IPR and petitioner waited 10 months after being sued to petition). This factor favors denial.

Factors Six and Seven: *Valve* is directly on point: “[H]aving multiple petitions challenging the same patent, especially when not filed at or around the same time as in this case, is inefficient and tends to waste resources. Here, Valve waited until after the institution decision in the [related] IPR, and then filed not one but three additional petitions.” *Id.* at 15. Nearly identical facts apply here—*i.e.*, serial and repetitive attacks against the same patent, with not one but six additional IPR petitions, all filed after the earlier FWD. As in *Valve*, “[t]hese serial and repetitive attacks implicate the efficiency concerns underpinning *General Plastic*, and, thus, favor denying institution.” *Id.*

Following *Valve* and *General Plastic*, institution should be denied.

Date: June 5, 2019

Respectfully submitted,

Joseph A. Rhoa, Reg. No. 37,515
Jonathan Roberts, Reg. No. 68,565
NIXON & VANDERHYE, PC
901 N. Glebe Rd., Suite 1100
Arlington, Virginia 22203
Telephone: (703) 816-4000
Email: jar@nixonvan.com
Email: jr@nixonvan.com

By: /s/ Lawrence M. Hadley
Lawrence M. Hadley (Admitted Pro Hac Vice)
GLASER WEIL FINK HOWARD
AVCHEN & SHAPIRO LLP
10250 Constellation Boulevard, 19th Floor
Los Angeles, California 90067
Telephone: (310) 553-3000
Email: LHadley@Glaserweil.com

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on the date indicated below, a complete and entire copy of this submission was provided by email to Petitioner's counsel via email, as agreed to by Petitioner's Service Information in the Petition submission, by serving the email address of record as follows:

W. Karl Renner, Reg. No. 41,265
Jeremy Monaldo, Reg. No. 58,680
Daniel D. Smith, Reg. No. 71,278
Fish & Richardson P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, MN 55402
Tel: 202-783-5070
Fax: 877-769-7945
IPR39521-0062IP2@fr.com
PTABInbound@fr.com
axf-ptab@fr.com
monaldo@fr.com
dsmith@fr.com

Date: June 5, 2019

By: /s/ Jonathan Roberts
Jonathan Roberts
Reg. No. 68,565
NIXON & VANDERHYE, PC
901 N. Glebe Rd., Suite 1100
Arlington, Virginia 22203
Telephone: (703) 816-4000
Email: jr@nixonvan.com