

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

UUSI, LLC d/b/a NARTRON,
Patent Owner

Case IPR2019-00356
Patent 5,796,183

**PETITIONER'S SUPPLEMENTAL BRIEF RE DISCRETIONARY
DENIAL UNDER 35 U.S.C. § 314(a)**

Unlike the parties in *Valve*, Apple and Samsung are unrelated. In *Valve*, “Valve and HTC were co-defendants in [a] District Court litigation and were accused of [infringement] based on the same product.” *Valve v. Elec. Scripting*, IPR2019-00062 Paper 13, 9-10 (PTAB 2019). Here, Apple and Samsung have *never* been co-defendants in an action involving the ’183 patent, and Apple and Samsung have *completely separate* products. Indeed, UUSI sued Apple *more than two years* after suing Samsung, “approximately six weeks” after Samsung’s IPR concluded. Pet., 5; Paper 10, 14. UUSI makes no overlapping allegations between Apple and Samsung, and did not notice Apple of infringement at the time of its complaint against Samsung. Thus, unlike the lawsuit against *HTC and Valve*, UUSI’s lawsuit against *Samsung* did nothing at the time of Samsung’s petition to make Apple aware of a UUSI allegation of ’183 patent infringement by Apple.

Also, Apple’s Petition challenges several claims unchallenged by the Samsung IPR. See Pet., 1. This further distinguishes the instant case from *Valve*, establishing that Apple is not similarly situated to Samsung and that *General Plastic* (“GP”) factor one weighs against discretionary denial. See Pet., 5.

The remaining GP factors also weigh against discretionary denial, and several further distinguish *Valve*. Because it had not been sued, Apple had no reason to assess validity of the ’183 patent at the time of Samsung’s petition (GP factor 2). The length of time between the Samsung IPR and the present IPR and

any inefficiencies related to multiple petitions (*GP* factors 4-7) are due to UUSI's decision to sue Apple after Samsung's IPR. *See* Pet., 4-6; POPR, 15.

As to the third *GP* factor, UUSI alleges "gamesmanship," but Apple did not delay its petition to gain a strategic advantage by learning from Samsung's IPR – Samsung's IPR was already complete when UUSI sued Apple. And, this is not a case like *Valve* where "Valve submitted a declaration from the same expert that HTC used" and admittedly addressed "issues" the Board found in denying HTC's earlier petition. *Valve*, 13. Apple used a different expert and, as Patent Owner admits, did not rely on the same prior art as the Samsung IPR. POPR, 17-18.

If anything, UUSI, not Apple, seeks to gain advantages from Samsung's IPR. In its POPR, UUSI alleges an "implicit claim construction" of "selectively providing signal output frequencies" in the Samsung IPR. POPR, 17, 22-27. The Board in the Samsung IPR, however, explicitly chose *not* to construe this term. Paper 35, 10. Indeed, UUSI's POPR cites to pages "14-16, 18" for the Board's construction, yet the only mention of multiple frequencies in those pages relates to the Board's summary of Samsung's contentions, not the Board's construction. *Id.*, 14-16, 18 ("Petitioner contends"). UUSI also argues that, if the Board used a broad interpretation, it "never would have needed to consider Gerpheide in combination with Inghram-Caldwell." POPR, 25. But *all* of Samsung's grounds involved Gerpheide, making its consideration necessary to evaluate *Samsung's*

challenge. By alleging an implicit construction, UUSI uses Samsung's challenge to support a narrow interpretation that does not exist in the '183 patent.

In fact, '183 never describes "a microprocessor capable of generating multiple frequencies from an oscillator." POPR, 24. In '183, the only selection made by the microprocessor is selection of rows to "*sequentially* activate the touch circuit rows," and the only description of varying frequency involves varying "values of the resistors and capacitors utilized in oscillator 200." Ex. 1001, 14:22-25, 18:43-49 ("Microcontroller ... selects each row"). Dependent claims 41 and 45 confirm that "selectively providing signal output frequencies" does not require selection from multiple frequencies, as claim 45 specifies the "same hertz value" and claim 41 explicitly specifies UUSI's implicit construction where a frequency "is selected from a plurality of hertz values." By attempting to draw an implicit claim construction through how Samsung chose to style its IPR, UUSI, not Apple, seeks to gain advantage from the prior IPR (*GP* factor 3).

Allowing UUSI to benefit from the timing of its litigation filings would encourage patent owners to "game the system" by timing infringement actions to avoid IPR challenges from later-sued parties. Exercising discretion under 314(a) would encourage use of a staggered litigation filing strategy that unjustly disadvantages future defendants by removing the option of IPR simply because an earlier, unrelated defendant filed one. Thus, IPR should not be denied under *Valve*.

Respectfully submitted,

Dated: June 5, 2019

/W. Karl Renner/

W. Karl Renner, Reg. No. 41,265
Jeremy Monaldo, Reg. No. 58,680
Daniel Smith, Reg. No. 71,278
Fish & Richardson P.C.
3200 RBC Plaza,
60 South Sixth Street
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Attorneys for Petitioner

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.