

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.
Petitioner

v.

UUSI, LLC dba NARTRON
Patent Owner

Case IPR2019-00359
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, one-third of the references used in its Petition were known to Apple years before Samsung was even sued. Another one-third was known from the '183 patent file history. As in *Valve*, Apple knew of at least some of the alleged "new" references and should have been aware of at least another one-third "through the exercise of reasonable diligence around the time of [Samsung's] petition." *Cf. id.* at 11. 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 two of the six references asserted in this Petition (including the main reference)—and quickly became aware of two more prior to the filing of this IPR from the '183 patent file history. Apple knew or quickly could have known of two-thirds of the relied-upon references but 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. Thus, 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.

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Respectfully submitted,

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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:

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