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 IPR2019-00360
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 Ingraham-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,

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