UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

REMBRANDT WIRELESS TECHNOLOGIES, LP,
Patent Owner.

Case IPR2020-00033
U.S. Patent No. 8,023,580

PATENT OWNER'S RESPONSE TO PETITIONER'S RANKING AND EXPLANATION OF PARALLEL PETITIONS

I. INTRODUCTION

Petitioner filed two separate petitions in IPR2020-00033 and IPR2020-00034 (collectively, "the Petitions") on the same day challenging the *same* two claims of the *same* patent - U.S. Patent No. 8,023,580 ("the '580 Patent"). Petitioner's Ranking and Explanation of Parallel Petitions ("Petitioner's Ranking/Explanation") fails to justify the need for multiple burdensome proceedings. These two petitions "filed against the same patent at or about the same time … raise fairness, timing, and efficiency concerns." Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019) ("the Consolidated Guide") at 59 (citing 35 U.S.C. § 316(b)). "[M]ultiple petitions by a petitioner are not necessary in the vast majority of cases," as is true in the present proceedings. *Id*. Accordingly, the Board should not institute on more than one petition (if it institutes at all).

II. THE BOARD SHOULD NOT INSTITUTE ON BOTH PETITIONS

The present proceeding does not represent one of those rare situations where "more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references." *Id*. In the related district court litigation, Patent Owner has asserted *only two claims* (claims

2 and 59) of the '580 Patent. Pet, at 3. Petitioner's Ranking/Explanation fails to mention this fact, and asks the Board to unduly burden itself and the parties by instituting the same number of petitions as there are claims being asserted in the district court litigation. This is far from an efficient use of Board resources.

Petitioner's concern about a dispute over non-analogous art in one petition is not sufficient justification for parallel petitions. While, indeed, Petitioner acknowledges that the "difference in the exemplary devices receiving the transmissions (pagers vs. computers, smart appliances, and other stations) is material" and thus is justified being concerned about its characterization as non-analogous art, that does not require separate petitions. Valid disputes over non-analogous art are but one of many types of disputes that may arise during *inter partes* review. There is nothing special about a dispute over non-analogous art that would justify parallel petitions, even if the Petitioner fears it may lose the dispute.

Furthermore, Petitioner's argument that parallel petitions are justified because Patent Owner may try to swear behind U.S. Patent No. 6,075,814 to Yamano et al. ("Yamano") is moot, because Patent Owner stipulates that Yamano is prior art as to the '580 Patent.

Petitioner also relies on the petitions being the first petitions filed by Petitioner with respect to the '580 patent as an alleged justification for institution of parallel

petitions. *See* Petitioner's Ranking/Explanation, at 4. However, petitions for IPR are routinely brought by Petitioners who have not previously challenged the patent at issue. If being a first-time challenger was a determining factor, parallel petitions would be the norm instead of the exception.

III. CONCLUSION

Patent Owner respectfully requests that the Board decline to institute *inter partes* review on at least one of the petitions for the reasons stated above.

Respectfully submitted,

Dated: February 13, 2020 By: /Jason Shapiro/
Jason Shapiro (Reg. No. 35,354)
Attorney for Patent Owner
Rembrandt Wireless Technologies, LP

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing PATENT OWNER'S RESPONSE TO PETITIONER'S RANKING AND EXPLANATION OF PARALLEL PETITIONS was served via email on February 13, 2020, to lead and backup counsel of record for Petitioner as follows:

Mark D. Rowland
Reg. No. 32,077
mark.rowland@ropesgray.com

Gabrielle E. Higgins
Reg. No. 38,916
gabrielle.higgins@ropesgray.com

Josef Schenker
Josef.Schenker@ropesgray.com

Carolyn Redding
Carolyn.Redding@ropesgray.com

ROPES & GRAY LLP, IPRM – Floor 43
Prudential Tower, 800 Boylston Street
Boston, MA 02199

Ropes-Rembrandt-IPR-Service@ropesgray.com

Dated: February 13, 2020 By: /Mark J. DeBoy/
Mark J. DeBoy (Reg. No. 66,983)
Attorney for Patent Owner
Rembrandt Wireless Technologies, LP