

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 SUR-REPLY

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I. Denial of Institution Is Warranted Under § 325(d)

Petitioner wrongly accuses PO of ‘mischaracteriz[ing] the record,’ by “contend[ing] that ‘Siwiak ‘398 expressly describes the very aspects of Siwiak ‘306 that Petitioner relies on, e.g., the “different types” of modulation.’ POPR 43.” Reply at 1 (bolding Petitioner’s). In fact, the cited materials fully support PO’s position. See POPR 43-44 & n. 13 (quoting Siwiak ‘398 (EX2016 at 3:5-17).

As the quoted language indicates, Siwiak ‘398 expressly describes different types of modulation, i.e., how Siwiak ‘398’s “dual mode receiver” is similar to the “dual mode receiver of [Siwiak ‘306] which utilizes FM ... and a linear modulation format,” a format which Petitioner has admitted is QAM. *See, e.g.,* Pet. at 56-57 (citing references to “FM modulation” and “linear modulation” in support of contention that Siwiak ‘306 teaches FSK and QAM, respectively). In other words, Petitioner equates “FM modulation” and “linear modulation,” the Siwiak ‘398 terms relied on by PO as *expressly describing* different modulation types, with FSK and QAM respectively.

Next, Petitioner alleges that “to secure allowance during prosecution, PO represented that Siwiak ‘398 does not teach ‘different types’ of modulation methods,” relying on an amendment made during prosecution. Reply at 2. Yet, that amendment, which includes numerous additional clarifying recitations, was made after the claims at issue were already allowed. *See* EX1002 at 71, 127, 140, 168. In

fact, PO explicitly stated that the amendments were made “to more precisely claim the subject-matter.” *Id.* at 140. To support its position that PO amended its claims to overcome a rejection, Petitioner cites various documents. Reply at 1-2 (citing EX2027 at 9, 12; EX1010 at 756-758; EX1002 at 140). Again, as indicated in Exs. 1010 and 1002, the claims had already been allowed at the time “different types” was added.

During litigation, while admittedly PO indicated that “of a different type” was added to overcome a rejection, PO further quoted the prosecution history, i.e., that the claim “had been clarified to refer to two types of modulation methods.” EX2027 at 9. Notably, Apple responded as follows:

... the Examiner did not reject claim 1, he allowed it. ... [A]lthough Rembrandt *now* argues that it amended claim 1 “to distinguish the Siwiak reference” ... , that is not what Rembrandt told the USPTO during prosecution. There, Rembrandt stated it further amended claim 1, which the Examiner previously allowed, “with additional recitations to more precisely claim the subject-matter.” Thus, none of Rembrandt’s new arguments about the prior art Siwiak patent appears anywhere in the prosecution record that led to issuance of the asserted patents.

EX2028 at 15-16 (citations omitted) (emphasis added). Apple was right to clarify to the district court that the subject amendments and statements were made *after allowance*. But Apple is wrong to take the opposite position before the Board knowing it to be false.

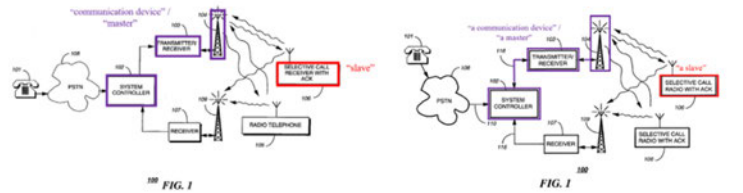
Finally, Petitioner relies on the fact that four of the five references were not previously cited and that, *through incorporation by reference of Leitch*, Briancon “*expressly discloses* two ‘different types’ of modulation, FSK and QAM, whereas Siwiak ‘398 does not.” Reply at 2. Tellingly, other than Petitioner’s alleged “critical disclosures” of FSK and QAM, Petitioner identifies nothing in its references that distinguishes them from those already considered. In contrast, see POPR at 40-45 (describing the substantial overlap in teachings).

II. Denial of Institution is Warranted Under §314(a)

Petitioner argues against denial under §314(a) because (1) “PO ... has requested new claim constructions here on terms it previously told the district court ‘do not require construction’”; (2) “Ground 2 here relies on US 5,521,926 to Ayerst, while the court contentions rely on a different Ayerst patent with a different disclosure, US 5,644 568”; (3) “Both parties rely on different experts here and in the litigation”; and (4) “the district court case includes multiple grounds of invalidity ... not at issue here.” Reply at 3 (emphases omitted).

With respect to (1), apparently Petitioner is referring to PO’s discussion of the meaning of claim terms “master/slave,” “indicates an impending change,” and indicates that a reversion ... to the first modulation” has occurred. In fact, PO’s positions as to the meaning of these claim terms are the *same* as in district court. See Morrow Expert Report (EX2025) at, *e.g.*, ¶¶ 67-73, 142-145, 150-152, 218-219 &

passim. This is not surprising, given that the *Phillips*' claim construction standard applies to both. Petitioner cannot manufacture a difference between the litigation and IPR when the positions of PO are consistent. With respect to (2), while the two Ayerst patents are different, the relied on portions are identical. Both Petitioner's IPR expert (EX1003) and litigation expert (EX2007) rely on substantially identical teachings, including figures and annotations:



EX1003 at 54

EX2007 at 42

Compare also U.S. Patent No. 5,644,568 at 5:26-37 (cited in EX2007 at ¶¶59, 77) with EX1007 at 5:13-25 (cited in Pet. at 51, 54, 67). With respect to (3), the opinions of Petitioner's experts also are substantially identical, relying on identical passages in and annotations to the references. POPR at 35-39; also compare EX1003, *passim*, with EX2007, *passim*. With respect to (4), the complete overlap with the issues raised here and the additional invalidity grounds in the litigation demonstrate that validity will be fully addressed in the litigation. Other than Petitioner's speculation, there is nothing to show that Petitioner will be denied a full opportunity to present the invalidity defenses raised here in district court.

PO agrees that “[c]onsideration of discretion under § 314(a) requires a ‘balanced assessment of all relevant circumstances . . . , including the merits.’” Reply

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