

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

**PETITIONER'S RANKING AND EXPLANATION OF
PARALLEL PETITIONS**

I. Introduction

Petitioner herewith files two parallel petitions for *inter partes* review of U.S. Patent No. 8,023,580 (“580 patent”), IPR2020-00033 and IPR2020-00034. Pursuant to the July 2019 Update to the USPTO Trial Practice Guide, Petitioner hereby submits this notice ranking and explaining the differences between the petitions for the Board’s consideration.

II. Comparison and Rankings of the Petitions

Rank	Petition	Reference Combinations
A	IPR2020-00033 (Pet. 1 of 2)	Briancon ¹ in view of Leitch ² Briancon in view of Leitch and Ayerst ³ Siwiak-306 ⁴ in view of Siwiak-038 ⁵
B	IPR2020-00034 (Pet. 2 of 2)	Yamano ⁶ in view of Davis ⁷ Yamano in view of Davis and Christian ⁸

As these petitions present alternative arguments in a manner contemplated by the Board and are not cumulative challenges, Petitioner requests that both petitions be independently considered.

¹ U.S. Patent No. 5,905,448 (“Briancon”), 35 U.S.C. §102(e) (filed Jan. 2, 1997).

² U.S. Patent No. 5,689,440 (“Leitch”), §102(e) (filed Dec. 11, 1996).

³ U.S. Patent No. 5,521,926 (“Ayerst”), §102(b) (issued May 28, 1996).

⁴ U.S. Patent No. 5,239,306 (“Siwiak-306”), §102(b) (issued Aug. 24, 1993)

⁵ U.S. Patent No. 4,875,038 (“Siwiak-038”), §102(b) (issued Oct. 17, 1989).

⁶ U.S. Patent No. 6,075,814 (“Yamano”), §102(e) (filed May 9, 1997).

⁷ U.S. Patent No. 5,583,922 (“Davis”), §102(a) (issued Dec. 10, 1996).

⁸ U.S. Patent No. 4,549,293 (“Christian”), §102(b) (issued Oct. 22, 1985).

III. Material Differences that Compel Permitting Multiple Petitions

First, while Petitioner challenges the same claims in both petitions, the grounds are distinct. Petition 1 relies on references disclosing communication systems and methods in which one or more selective call radio receivers receive addressed transmissions over a communication medium. The references describe wireless paging systems as examples. Petition 2 relies on references disclosing communication systems and methods in which one or more computers, smart appliances, or other stations receive addressed transmissions over a communication medium. The references describe computers, smart appliances, or other stations linked by telephone lines or radio. The difference in the exemplary devices receiving the transmissions (pagers vs. computers, smart appliances, and other stations) is material because Patent Owner Rembrandt has previously asserted in litigation that a different reference (U.S. Patent No. 5,537,398 to Mr. Kazimierz Siwiak) disclosing paging systems could reasonably be found to be non-analogous art. (Ex. 1016, 15-16 “[T]he Siwiak Patent is directed to pagers—a very different technology than the modems disclosed by the [’580 patent]”). Petitioner disagrees that art describing paging systems as exemplary embodiments of disclosed communication systems or methods is non-analogous, at least because the challenged claims are not limited to any particular modem technology and the ’580 patent specification states that “the present invention relates generally to the fields

of data communications and modulator/demodulators (modems).” Ex. 1001, 1:19-20, 2:24-25 (“The present invention disclosed herein includes communication systems, devices, and methods.”). Nonetheless, the Yamano and Davis references in Petition 2 both describe examples with computers, smart appliances, or stations using modem devices, and none of the references in Petition 2 use paging systems as examples. Thus, because Patent Owner may argue that the references in Petition 1 are non-analogous art, the obviousness analysis in each petition is materially different and supports parallel petitions.

Second, Petition 2 relies on Yamano (which qualifies as prior art under §102(e)) as a primary reference, whereas parallel Petition 1 relies on Siwiak-306 (which qualifies as prior art under §102(b)). Patent Owner may try to antedate Yamano by attempting to swear behind it. Indeed, although the claimed priority date for the ’580 patent is December 5, 1997 (Ex. 1018, 3), Patent Owner pointed to an earlier June 1997 date and suggested that it may have earlier documents relating to the invention. Ex. 1010, 407 (’580 Reexamination, Control No. 90/013,808, 2/27/2017 Patent Owner’s Request For an Extension of Time under 37 C.F.R. § 1.550(c) to File its Response to the January 24, 2017 Office Action Pursuant to 35 U.S.C. § 305, at 2). Therefore, the differences in the relevant prior art dates in the petitions are material, as Patent Owner may argue that the challenged claims are entitled to an earlier priority date. As stated in the Trial

Practice Guide, “when there is a dispute about [a] priority date requiring arguments under multiple prior art references,” multiple petitions “may be needed.”⁹

Finally, these are the first petitions filed by Petitioner with respect to the ’580 patent. Patent Owner did not sue Petitioner until after the conclusion of the previous post-grant proceedings filed by Samsung to which Petitioner was not a party, after the conclusion of the litigation filed by Patent Owner against Samsung, and after the Federal Circuit’s issued its claim construction decision under *Phillips* (Ex. 1012).

IV. The Board should exercise its discretion to institute both petitions.

The Board should exercise its discretion to institute both petitions because of the material differences discussed above and the strong showing of obviousness in both petitions. Additionally, instituting both would not unduly burden the Board or the parties; the claims of the ’580 patent would be challenged only *twice* with a total of only *five* grounds. For at least these reasons, the Board should institute trial in both IPR2020-00033 and IPR2020-00034.

Respectfully submitted,
ROPES & GRAY LLP

Dated: November 5, 2019

/ Gabrielle E. Higgins /
Gabrielle E. Higgins

⁹ USPTO Trial Practice Guide (July 2019 Update), p. 26.