

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

REMBRANDT WIRELESS TECHNOLOGIES, LP,
Patent Owner.

Case IPR2020-00034
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] Davis’ teaching of QAM is substantially the same as or cumulative of Siwiak ‘398.” Reply 1. In fact, the cited materials fully support PO’s position.

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.*, IPR2020-00033 Petition, Paper 2, 56-57 (citing references to “FM modulation” and “linear modulation” in support of Petitioner’s contention that Siwiak ‘306 teaches FSK and QAM, respectively). In other words, Petitioner equates “FM modulation” and “linear modulation,” the very terms used in Siwiak ‘398 and relied upon by PO in related proceedings as *expressly describing* different modulation types, with FSK and QAM respectively.

Petitioner further alleges that “to overcome a rejection based on Siwiak ‘398, Applicant amended the claims to require different ‘types’ of modulation and ‘identified the FSK family’ and ‘the QAM family’ as examples.” Reply 1. Yet, the referenced amendment, which includes numerous additional clarifying recitations, was made *after* the claims at issue in the present proceeding were *already allowed*. *See, e.g.*, EX1102 at 71, 127, 140, 168. In fact, PO explicitly stated on the record 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 1-2 (citing EX2027 at 9, 12; EX1110, 756-758; EX1102, 140). Again, as indicated in Exs. 1110 and 1102, 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.

Petitioner alleges that “PO wrongly contends Petitioner’s reliance on Yamano ‘is simply rehashing’ a previous argument presented in the reexams” because

Yamano was not cited for ‘different types’” but rather only for the address limitation. Reply 2. In fact, the reexam examiner was well aware of Yamano’s full teachings (*see, e.g.*, EX1110 at 837 (“Yamano ... relat[es] to transmitting data packets over a network at varying rates”)), citing many of the same portions of Yamano (i.e., FIG. 8, 1:1-29 and 19:54-20: 33) that Petitioner relies on in this proceeding (*see, e.g.*, Pet. 7, 19, 22, and 32).

Petitioner alleges that “PO has put forth no credible basis for suggesting that the art advanced ... is cumulative of the art of record.” Reply 3. To the extent Petitioner is arguing that Siwiak ‘398 does not disclose FSK and QAM, Siwiak ‘398 discloses both for the reasons given *supra* at 1. See also EX2016 at 6:27-28 re FSK. In addition, the Office previously relied on Kamerman as disclosing “QAM schemes.” EX1110 at 838. Thus, with respect to disclosing QAM, Davis is cumulative of Siwiak ‘398 and Kamerman. POPR 38. PO has further explained the redundancies of Davis and Christian in its POPR. *See, e.g.*, POPR 30-41.

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

Petitioner argues against denial under §314(a) because of “significant differences between the IPR and litigation,” Reply, at 3, including: (1) “PO ... has requested a new claim construction here on a term it previously told the district court ‘do[es] not require construction’”; (2) Christian is relied on here “in a combination that is not relied on in the district court”; (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.” *Id.* (emphases omitted).

With respect to (1), apparently Petitioner is referring to PO’s discussion of “master/slave.” In fact, PO’s position as to the meaning of “master/slave” is the *same* as its position in district court. *See* Morrow Expert Report (EX2025) at, *e.g.*, ¶¶ 67-73 & *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 based on claim construction when the positions of the PO are consistent. With respect to (2), PO has fully addressed why Christian is merely cumulative to the art already considered by the Office. *See, e.g.*, POPR 30-31, 39-41. With respect to (3), the opinions of Petitioner’s experts also are substantially identical, relying on identical passages from and identical annotations to the references. POPR 30-34; *also compare* EX1103, *passim*, with EX2007, *passim*. With respect to (4), Petitioner appears to suggest that the issues ultimately tried by the district court may not be the same ones tried here. In fact, the complete overlap with the issues raised in the IPR and the additional invalidity grounds in the litigation demonstrate that validity will be fully and thoroughly addressed in the litigation. Absent speculation, there is nothing to show that Petitioner will be denied a full and fair opportunity in district court to present the invalidity defenses it has raised here.

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