

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2020-00200

U.S. Patent No. 10,084,991

**PATENT OWNER'S REDACTED SUR-REPLY IN *INTER PARTES*
REVIEW OF U.S. PATENT NO. 10,084,991**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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| <i>InTouch Techs., Inc. v. VGo Communs., Inc.</i> , 751 F.3d 1327 (Fed. Cir. 2014) | 10 |
| <i>Koninklijke Philips N.V. v. Google LLC</i> , 948 F.3d 1330 (Fed. Cir. 2020) | 10 |
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| <i>SAS Inst., Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018)..... | 9 |
| <i>Sirona Dental SystemsGMBH v. Institut Straumann AG</i> , 892 F.3d 1349 (Fed. Cir. 2018) | 10 |

Case IPR2020-00200
Patent No. 10,084,991
Patent Owner's Sur-Reply

PATENT UPDATED OWNER'S EXHIBIT LIST

| Description | Exhibit # |
|---|------------------|
| October 9, 2018 Notice Letter from Maxell to Apple | 2001 |
| March 16, 2020 Scheduling Order | 2002 |
| May 31, 2019 Scheduling Order | 2003 |
| Docket From District Court Action | 2004 |
| January 8, 2020 Minute Order | 2005 |
| March 18, 2020 Markman Order | 2006 |
| August 28, 2019 Minute Order | 2007 |
| September 17, 2019 Minute Order | 2008 |
| Maxell's Disclosure of Asserted Claims and Infringement Contentions | 2009 |
| Maxell's Final Election of Asserted Claims | 2010 |
| Apple's Final Election of Prior Art | 2011 |
| Apple's Invalidity Contentions | 2012 |
| Asmussen Chart from District Court Action | 2013 |
| March 6, 2017 Scheduling Order from Maxell v. ZTE | 2014 |
| March 19, 2018 Scheduling Order from Maxell v. ZTE | 2015 |
| Docket from District Court Action | 2016 |
| Standing Order re COVID-19 | 2017 |
| April 20, 2020 Scheduling Order from District Court Action | 2018 |
| Declaration of Tiffany A. Miller | 2019 |
| Transcript of September 28, 2020 Deposition of Dr. Lippman | 2020 |
| Declaration of Dr. Maja Bystrom | 2021 |
| U.S. Patent No. 7,864,051 | 2022 |

I. INTRODUCTION

Apple's Reply fails to tackle the flaws in the prior art and motivations to combine the references set forth in the Petition.

Regarding the "network interface" limitation in claim 1(a), Apple fails to demonstrate that Asmussen discloses this limitation alone. Apple's expert, Dr. Lippman does not address key technical issues that undercut his opinions that receiver 750 of Figure 30 could be integrated with tuner 603 (in Figures 11a or 12) to meet the network interface limitation. Nor should the Board consider Apple's belated "Asmussen in combination with Lindstrom" Ground demonstrating claim 1(a) is met as such ground was not raised in the Petition.

Regarding the "rendering the camera operative" limitation in claim 1(e), Apple fails to demonstrate that Asmussen alone or in combination with Bear disclose this limitation. Indeed, the Board preliminarily determined that Asmussen alone does not disclose the "rendering the camera operative" limitation. *See* Institution Decision, at 64. Moreover, as to the Asmussen and Bear combination, the proposed motivations to combine are hindsight reconstructions that use the '991 Patent "as a guide through the maze of prior art references" and should be rejected.

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