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To:	Precedential_Opinion_Panel_Request
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Subject:	Precedential Opinion Panel Request - IPR2020-00202
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Attachments:	IPR2020-00202 PO Request for Rehearing.pdf

Dear Board,

I write on behalf of Patent Owner Maxell, Ltd. to request Precedential Opinion Panel ("POP") review of the Board's panel decision in *Apple Inc. v. Maxell, Ltd.*, IPR2020-00202, Paper 11 (PTAB July 15, 2020) (hereafter "Panel Decision").

I. Basis for POP Review

Based on my professional judgment, I believe this case requires an answer to the following precedent-setting question of exceptional importance: whether under 35 U.S.C. Section 314(a), *NHK Spring*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential) and *Apple v. Fintiv* IPR2020-00019, Paper 11 (PTAB March 20, 2020) (precedential), the proper time with which to evaluate facts with respect to *Fintiv* Factor 4 and whether to deny institution based on 35 U.S.C. Section 314(a) is at the time the Petition is filed or sometime thereafter such as the date of Institution. Such a fixed timeframe—the filing of the Petition—for the Board's Factor 4 analysis would prevent situations where, like here, petitioners manufacture a favorable situation by dropping overlapping prior art in the District Court. Such tactics do not promote *NHK* and *Fintiv*'s goal of efficiency and fairness.

If the answer is "at the time the Petition is filed," the Panel Decision's analysis and conclusion with respect to Factor 4 would be the complete opposite than if the answer is "at the time of institution." In the District Court Action, Apple relied upon the same prior art as this Petition until at least April 7, 2020 (four months after filing its Petition) at which point it selectively dropped certain prior art references in an attempt to compensate for its delay in filing its Petition.

The POP should correct the Board's course in this case where undue emphasis was placed on the overlap of issues, and where at the time of the filing of the Petition there was a complete overlap of issues, but Petitioner then took advantage of the timeframe between the filing of the petition and Institution to inject additional favorable facts to support its arguments against §314 denial. Fixing the "look back" date for Factor 4 as the date of the filing of the Petition promotes *Fintiv*'s quest for efficiency and fairness, rather than a shifting sands approach that allows petitioners to take advantage of deadlines and disclosures in each venue to create an inefficient and unfair process.

Based on my professional judgment, I believe that the Panel Decision improperly applied the Director's discretionary denial authority under 35 U.S.C. Section 314(a), *NHK Spring*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential) and *Apple v. Fintiv* IPR2020-00019, Paper 11 (PTAB March 20, 2020 (precedential), based solely or primarily on the undue weight it gave *Fintiv* Factor 4 (overlap of issues) over, for example, Factor 2 where in this circumstance trial will be complete many months prior to the Final Written Decision. *Fintiv* does not require complete overlap in issues or claims to weigh Factor 4 in favor of denial. Nor does *Fintiv* place particular emphasis on Factor 4 over other factors. Instead, *Fintiv* counsels that "the Board takes a holistic view of whether efficiency and integrity of the

system are best served by denying or instituting review." *Fintiv* at 6. The Board required complete overlap in claims and prior art in its analysis of Factor 4, leading to an unreasonable balancing of the *Fintiv* factors, even where the Board found more factors weigh in favor of denial than not.

II. Conclusion

For these reasons and those in the Request for Rehearing, which is being filing concurrently herewith and a copy of which is attached, Patent Owner seeks review by the POP and requests that the Board deny institution of *inter partes* review.

Respectfully submitted,

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