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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

OPTIS CELLULAR TECHNOLOGY, LLC
Patent Owner

Case IPR2020-00465
U.S. Patent No. 8,102,833

**PETITIONER'S REPLY TO
PATENT OWNER PRELIMINARY RESPONSE**

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The POPR urges the Board to deny the Petition under § 314(a) based on a misapplication of the *Fintiv* factors and an undue focus on the time between the current trial date in the co-pending district court case (“Texas case”) and an expected Final Written Decision (“FWD”). Other factors favor institution, including Petitioner’s strong showing on the merits, a lack of overlap in prior art between the Petition and the Texas case, and the complexities of litigation. A balanced weighing of the factors favors institution.

I. The *Fintiv* Factors Counsel Against Exercising Discretion to Deny

A. Factor 1: Lack of Evidence of Stay Renders This Factor Neutral

The Board routinely declines to speculate as to the likelihood of a stay where none has been requested. *See, e.g., Fintiv*, Paper 15 at 12. Because no stay has been requested in the Texas case, this factor is neutral. *Id.*

B. Factor 3: Petitioner’s Diligence and No Tactical Advantage

PO fails to acknowledge Petitioner’s diligence in filing the Petition. Petitioner’s initial invalidity contentions identified nearly 140 different prior art references across seven asserted patents. Rather than burden the Board with multiple petitions on each patent, Petitioner diligently evaluated the unique strengths of each prior art reference and combination, searched for additional prior art, and filed only three petitions. This Petition uses only a single ground for fourteen claims and does not depend on the constructions disputed by the parties in

the Texas case. Such careful selection of grounds, given the constraints placed upon petitions and the parties constructions, shows Petitioner's diligence. *See Med-El Elek. Geräte GES.M.B.H v. Advanced Bionics AG*, IPR2020-00190, Paper 15 at 13-14 (June 3, 2020). PO also does not allege that Petitioner obtained any tactical advantage for the Petition from the litigation based on the time the Petition was filed, further tilting factor 3 in favor of institution.

C. Factor 4: The Issues Do Not Substantially Overlap

PO's assertion of complete overlap between the Petition and Texas case (POPR at 11-12) is now inaccurate. At PO's request, and to eliminate the possibility of inconsistent findings, Petitioner agreed on July 2, 2020 to drop grounds involving Qualcomm-269 and Cho in the Texas case. *See* Ex. 1063 (PO requesting "narrowing of invalidity theories"). This mitigates concerns of duplicative efforts. *See Sand Revolution II, LLC v. Cont'l Intermodal Grp.—Trucking LLC*, IPR2019-01393, Paper 24, 11-12 (June 16, 2020). The significant differences between the issues in this IPR and the Texas case tip factor 4 in favor of institution. Neither party seeks to construe a term already construed by the Texas case, and PO seeks to construe "control signals" in this IPR, but not in the Texas case. Furthermore, PO's argument about the relative amount of space in the Petition devoted to overlapping and non-overlapping claims fails—PO does not concede that the dependent claims fall with the independent claims.

D. Factor 6: Strong Petition Outweighs Other Factors

The Petition demonstrates that all claim elements were well-known techniques for arranging signals for transmission, which favors institution. *See Apple Inc. v. Seven Networks, LLC*, IPR2020-00156, Paper 10 at 20-22. PO's focus on the fact that Petitioner argues obviousness rather than anticipation misses the mark.

First, PO analyzes the references piecemeal, arguing that no single reference teaches entire limitations. *See, e.g.*, POPR at §§ VI.A, B, C. But the Petition showed that each limitation, as a whole, is obvious over the prior art *combination* (e.g., Qualcomm-037 and -269 teach *how* to form signals for transmission, whereas Cho and Samsung-094 disclose *where* to place particular signals).

Second, PO's argument that a POSA would not look to Qualcomm-037 because it was not endorsed by the 3GPP working group is irrelevant in light PO's own citations showing that Qualcomm-037 was "presented" to the group, and that the sections cited by Petitioner were discussed by the working members. PO identifies no technical flaw in Qualcomm-037, much less one that rises to the level of those identified in the cases PO relies on. POPR at 56-58. In addition, PO's arguments that Qualcomm-037's principle of operation is fundamentally different from Cho's are incorrect; as explained in the Petition, Qualcomm-037 provides a process for mapping signals to a matrix that could easily be used with Cho to yield

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