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Filed on behalf of Apple Inc.

By: Jason D. Kipnis, Reg. No. 40,680
David L. Cavanaugh, Reg. No. 36,476
Mary V. Sooter, Reg. No. 71,022
Richard Goldenberg, Reg. No. 38,895
Ravinder Deol, Reg. No. 62,165
Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, Massachusetts 02109
Tel: (617) 526-6000
Email: Jason.Kipnis@wilmerhale.com
David.Cavanaugh@wilmerhale.com
Mindy.Sooter@wilmerhale.com
Richard.Goldenberg@wilmerhale.com
Ravi.Deol@wilmerhale.com

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 NOTICE OF CLAIMS AND GROUNDS OF INVALIDITY
PRESENTED AT DISTRICT COURT TRIAL**

Pursuant to the Board’s email request of August 13, 2020, Petitioner hereby submits that the following claims of U.S. Patent No. 8,102,833 “were asserted at trial to be invalid” based on the following “ground(s) of invalidity for each claim presented at trial” in *Optis Wireless Technology, LLC v. Apple Inc.*, Case No. 2:19-cv-000666 (E.D. Tex.):

Claim(s)	Ground(s) of Invalidity Presented at Trial (in District Court)
8	Obviousness over Qualcomm R1-075037, Malladi 161 (U.S. Patent No. 8,374,161), Samsung R1-073094, and Malladi 367 (U.S. Patent No. 8,467,367)

Defendant’s expert (Dr. Jonathan Wells) testified about the above-listed ground of invalidity and references at trial. Each of the above-listed references was shown to the jury and entered into evidence.¹

¹ The Patent Owner takes the position that testimony by Plaintiffs’ expert, Dr. Vijay Madiseti, about additional prior art references that were not part of the Defendant’s invalidity case qualify as “ground(s) of invalidity for each claim presented at trial.” This is incorrect. First, Plaintiffs’ complaint did not seek a declaration of validity, so Plaintiffs cannot independently introduce grounds of invalidity at trial that were not addressed during direct testimony by Defendant’s witnesses. Second, because none of the additional references was offered or

Notice of Claims and Grounds of Invalidity Presented at District Court Trial
IPR2020-00465

Respectfully Submitted,

Dated: August 19, 2020

/Jason Kipnis/ (Registration No. 40,680)
Jason D. Kipnis
Lead Counsel for Petitioner Apple Inc.

David L. Cavanaugh
Registration No. 36,476

Mary V. Sooter
Registration No. 71,022

Richard Goldenberg
Registration No. 38,895

Ravinder Deol
Registration No. 62,165

admitted into evidence (much less shown to the jury), the jury could not have considered any of those references in reaching its verdict.

CERTIFICATE OF SERVICE

I hereby certify that on August 19, 2020, I caused a true and correct copy of Petitioner's Notice of Claims and Grounds of Invalidity Presented at District Court Trial to be served via email on the following attorneys of record as listed in Patent Owner's mandatory notices:

Hong Annita Zhong (Reg. No. 66,530)
Lead Counsel for Patent Owner
hzhong@irell.com
azhong@irell.com

Jason Sheasby
jsheasby@irell.com

PanOptisIPRs@irell.com

/Jason Kipnis/
Jason D. Kipnis
Registration No. 40,680