

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner,

v.

OPTIS WIRELESS TECHNOLOGY, LLC
Patent Owner.

Case IPR2020-00466
Patent No. 8,411,557

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

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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TABLE OF CONTENTS

	<u>Page</u>
I. Apple's <i>Fintiv</i> Analysis Is Improper And/Or Incorrect.....	1
A. Factor 1: stay at this stage is highly improbable.....	1
B. Factor 3: Apple confounds it with <i>General Plastic</i> factors	2
C. Factor 4: Notwithstanding Apple's last-minute gamesmanship, the Petition and the district court case overlap substantially.....	3
D. Factor 6: Apple inappropriately used the Reply to supplement its Petition after reviewing the POPR.....	4
E. None of the other factors recited by Apple favors institution.....	6
II. Apple's Challenge To <i>Fintiv</i> Decision Is Improper and Incorrect	7

EXHIBIT LIST

Ex. 2001	Declaration of Professor Murali Annavaram in Support of Patent Owner's Preliminary Response
Ex. 2002	Amended Docket Control Order In Parallel District Court Case, Case 2:19-cv-00066, Doc. 159, June 9, 2020
Ex. 2003	Judge Gilstrap's Standing Order re COVID19
Ex. 2004	"Why Gilstrap is Getting Ready for Trial and Not on Zoom," Law 360, May 15, 2020 https://www.law360.com/texas/articles/1273188/why-gilstrap-is-getting-ready-for-trial-and-not-on-zoom
Ex. 2005	Claim Construction Memorandum Opinion and Order, Case 2:19-cv-00066, Doc. 130, April 7, 2020
Ex. 2006	Sutivong et al., U.S. Publication No. US2006/0018336 A1, published Jan. 26, 2006
Ex. 2007	Email chain on proposals on reducing asserted claims and prior art
Ex. 2008	Table of Contents for Invalidity Expert Report of Mark Lanning regarding the Validity of U.S. Patent Number 8,411,557
Ex. 2009	Defendant Apple Inc.'s P.R. 3.3 Second Amended Invalidity Contentions
Ex. 2010	KREHER, Ralf and RÜDEBUSCH, Torsten, UMTS Signaling,
Ex. 2011	(Gilstrap) Order denying request for stay of trial because of Covid-19 Email exchange re filing of reply briefs after Opposition served in related court case
Ex. 2012	2020-07-07 Email exchange between Patent Owner and Petitioner regarding filings of replies in support of summary judgment motions and motions to exclude/strike

Ex. 2013	2020-07-03 Apple's Identification of Prior Art pursuant to 35 USC § 282
Ex. 2014	2020-07-02 Email from Sheasby to Apple Counsel
Ex. 2015	Texas Coronavirus Map and Case Count, New York Time, July 7, 2020, 2:10 P.M. E.T.
Ex. 2016	2020-07-07 Email from Board authorizing Patent Owner to file sur-replies (with required page limits) in IPR2020-00465, IPR2020-00466, IPR2020-00642
Ex. 2017	2020-03-01 Returned Summons

Apple represented to this Board that it sought a sur-reply to address the *Apple v. Fintiv* factors. Ex. 1056. Using the POPR as a roadmap, it used the reply instead to: (1) respond to the POPR substantively on the technical merits; and (2) create "new" facts in an attempt to eliminate the complete overlap between the PTAB and the district court proceedings. In an extreme movement, Apple announced that it would no longer pursue the Sutivong ground in the IPR, in addition to dropping the Harris ground in the district court. Reply at 2. The Board, however, cannot disregard the Sutivong ground under *SAS* unless it denies the Petition. That is, if Apple is to be held to its words that "it will not pursue Ground 2 . . . in this IPR" (Reply at 2), the outcome is no institution of trial.

I. Apple's *Fintiv* Analysis Is Improper And/Or Incorrect

A. Factor 1: stay at this stage is highly improbable

Apple alleges that because it had not requested a stay, the Board should assume this factor is neutral. Reply at 1. Not so. Apple does not dispute that the district court trial is scheduled to start in less than a month, the Board's institution decision would come after the trial, Judge Gilstrap has never before granted a stay pre-institution, and Apple has not cited any instance where he has granted a stay where review of fewer than all patents at issue was instituted. POPR at 2-4; Reply at 1. Judge Gilstrap recently denied a request to stay a trial because of Covid-19, further demonstrating the unlikelihood of a stay. Ex. 2011.

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