

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner,

v.

OPTIS WIRELESS TECHNOLOGY, LLC

Patent Owner.

Case No. IPR2020-00466

Patent No. 8,411,557

**PATENT OWNER OPTIS WIRELESS TECHNOLOGY, LLC'S
UPDATED MANDATORY NOTICE PURSUANT TO 37 C.F.R. § 42.8 AND
THE BOARD'S AUGUST 13, 2020 ORDER**

Pursuant to 37 C.F.R. § 42.8 and the Board's August 13, 2020 order by email (Ex. 2018), the Patent Owner Optis Wireless Technology, LLC hereby submits the following updated notice.

I. Real Party-In-Interest [No Change]

Optis Wireless Technology, LLC is the owner of U.S. Patent No. 8,411,557 ("the '557 patent"). PanOptis Patent Management, LLC, has the right to license and assert the '557 patent.

II. Related Matters [Updated]

The Patent Owner identifies the following matter that may be deemed related pursuant to 37 C.F.R. § 42.8(b)(2):

- Optis Wireless Technology, LLC ("Patent Owner") Optis Cellular Technology, LLC, Unwired Planet, LLC, Unwired Planet International Limited and PanOptis Patent Management, LLC ("Plaintiffs) have asserted the '557 patent against Apple in *Optis Wireless Technology, LLC v. Apple Inc.*, Case No. 2:19-cv-00066-JRG (E.D. Tex.).

[Updated August 19, 2020] Between August 3 and August 11, 2020, a jury trial was held in the above-mentioned matter. On August 3, 2020, Petitioner filed an opposed motion "to dismiss without prejudice its counterclaim for a declaratory judgment of invalidity of U.S. Patent No. 8,411,557 (Count X of Apple's Answer, Affirmative Defenses, and Counterclaims to Plaintiffs' First Amended Complaint,

IPR2020-00466
Patent No. 8,411,557

Dkt. 110)." Ex. 2019. On August 4, 2020, the Court denied Petitioner's motion to dismiss. Ex. 2020. Thereafter on August 7, 2020, Patent Owner's expert, Dr. Madisetti, testified why the '557 patent was not rendered obvious by either a combination of **Sutivong¹ and Tan (Ex. 1005)** or a combination of **Harris (Ex. 1004) and Tan (Ex. 1005)**, and Petitioner's expert testified why he believed Sutivong and Tan rendered the '557 patent obvious. Both experts were subject to cross-examination. The jury rendered a verdict on August 11, 2020, finding that Petitioner had failed to establish that **independent claims 1 and 10** of the '557 patent were invalid. Ex. 2021 at 5.

III. Lead And Back-Up Counsel [No Change]

Lead Counsel	Back-up Counsel
Hong Annita Zhong (Reg. No. 66,530) IRELL & MANELLA LLP 1800 Avenue of the Stars, Suite 900 Los Angeles, California 90067 Telephone: (310) 277-1010 Facsimile: (310) 203-7199 hzhong@irell.com azhong@irell.com	Jason Sheasby (<i>pro hac vice</i> to be requested) IRELL & MANELLA LLP 1800 Avenue of the Stars, Suite 900 Los Angeles, California 90067 Telephone: (310) 277-1010 Facsimile: (310) 203-7199 jsheasby@irell.com

¹ Petitioner referenced U.S. Application No. 2006/0018336 (Ex. 2006) at trial. The petition asserts the substantively identical WO 2006/019710 (Ex. 1003).

IPR2020-00466

Patent No. 8,411,557

IV. Service Information [No Change]

The Patent Owner consents to electronic service by email to the email addresses above and to the following email address: PanOptisIPRs@irell.com.

Dated: August 19, 2020

Respectfully submitted,

By: /Hong Zhong/
H. Annita Zhong, Reg. No. 66,530
IRELL & MANELLA LLP

IPR2020-00466
Patent No. 8,411,557

CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. section § 42.6, that on August 19, 2020, a complete copy of the foregoing document and Exhibits 2018-2021 were served upon the following, by ELECTRONIC MAIL:

WILMER CUTLER PICKERING HALE AND DORR, LLP

Jason D. Kipnis, Reg. No. 40,680
Jason.Kipnis@wilmerhale.com

Mary V. Sooter, Reg. No. 71,022
Mindy.Sooter@wilmerhale.com

David L. Cavanaugh, Reg. No. 36,476
David.Cavanaugh@wilmerhale.com

Ravinder Deol, Reg. No. 62,165
Ravi.Deol@wilmerhale.com

/Susan M. Langworthy/
Susan M. Langworthy