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Filed on behalf of Apple Inc.

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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
U.S. Patent No. 8,411,557

**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. 8,411,557 “were asserted at trial to be invalid” based on the following “ground(s) of invalidity for each claim presented at trial” *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)
1, 10	Obviousness over Sutivong (U.S. 2006/0018336) and Tan (U.S. 2007/0165567)

Defendant’s expert (Mr. Mark Lanning) 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 Madisetti, 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

Respectfully Submitted,

Dated: August 19, 2020

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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:

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