

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

REMBRANDT WIRELESS TECHNOLOGIES, LP,

Patent Owner.

Case IPR2020-00034

U.S. Patent No. 8,023,580

PETITION FOR *INTER PARTES* REVIEW

REDACTED VERSION

TABLE OF CONTENTS

LIST OF EXHIBITS.....	iii
I. INTRODUCTION	1
II. MANDATORY NOTICES (§ 42.8).....	3
A. Real Party-In-Interest	3
B. Related Matters.....	3
C. Lead and Back-Up Counsel and Service Information	5
III. PAYMENT OF FEES	5
IV. REQUIREMENTS FOR <i>INTER PARTES</i> REVIEW.....	5
A. Grounds for Standing	5
B. Identification of Challenge.....	6
1. The Specific Art on Which the Challenge is Based	6
2. Statutory Grounds on Which the Challenge is Based.....	8
3. How the Construed Claims are Unpatentable under the Statutory Grounds Identified in §42.104(b)(2) and Supporting Evidence Relied upon to Support the Challenge	9
V. FACTUAL BACKGROUND.....	9
A. The '580 Patent	9
B. Prosecution History	12
VI. LEVEL OF ORDINARY SKILL.....	14
VII. CLAIM CONSTRUCTION.....	15
VIII. GROUNDS OF UNPATENTABILITY	16
A. Claims 2 and 59 are rendered obvious under § 103(a) over Yamano in view of Davis (Ground 1) and Yamano in view of Davis and Christian (Ground 2)	17
1. Overview of Yamano	17

2.	Overview of Davis	25
3.	Overview of Christian.....	28
4.	Motivation to Combine Yamano and Davis	31
5.	Motivation to Combine Yamano and Davis and Christian.....	37
6.	Claim Charts for Grounds 1-2.....	40
B.	No Secondary Considerations of Nonobviousness	70
IX.	CONCLUSION	72

LIST OF EXHIBITS

- Ex. 1101 U.S. Patent No. 8,023,580 (“’580”)
- Ex. 1102 File History of U.S. Patent No. 8,023,580
- Ex. 1103 Declaration of Mark R. Lanning (“Lanning”)
- Ex. 1104 U.S. Patent No. 6,075,814 (“Yamano”)
- Ex. 1105 U.S. Patent No. 5,583,922 (“Davis”)
- Ex. 1106 U.S. Patent No. 4,549,293 (“Christian”)
- Ex. 1107 Reserved
- Ex. 1108 Reserved
- Ex. 1109 Reserved
- Ex. 1110 File History of *Ex Parte* Reexamination No. 90/013,808 for the ’580 patent
- Ex. 1111 *Rembrandt Wireless Techs., LP v. Samsung Elecs. Co., Ltd.*, No. 2:13-cv-00213-JRG-RSP, Dkt. 114, Claim Construction Order (E.D. Tex. July 10, 2014)
- Ex. 1112 *Rembrandt v. Samsung*, Appeal No. 16-1729, Fed. Circuit Decision, April 17, 2017
- Ex. 1113 *Rembrandt Wireless Techs., LP v. Apple Inc.*, No. 2:19-cv-00025-JRG, Dkt. 70, Joint Claim Construction Statement (E.D. Tex. Sept. 9, 2019)
- Ex. 1114 U.S. Provisional Application No. 60/067,562, filed Dec. 5, 1997
- Ex. 1115 *Samsung Elecs. Co. Ltd., et al. v. Rembrandt Wireless Techs. LP*, IPR2014-00518, Pap. 47 (Final Written Decision) (P.T.A.B. Sept. 17, 2015)

- Ex. 1116 *Rembrandt Wireless Techs., LP v. Samsung Elecs. Co., Ltd.*, No. 2:13-cv-00213-JRG-RSP, Dkt. 335, Rembrandt's Response in Opposition to Samsung Defendants' Rule 50(b) Renewed Motion for Judgment as a Matter of Law and/or Rule 59(a) Motion for a New Trial on Liability Issues (E.D. Tex. Sept. 7, 2015)
- Ex. 1117 *Rembrandt Wireless Techs., LP v. Samsung Elecs. Co., Ltd.*, No. 2:13-cv-00213-JRG-RSP, Dkt. 338, Samsung Defendants' Reply to Rule 50(b) Renewed Motion for Judgment as a Matter of Law and/or Rule 59(a) Motion for New Trial on Liability Issues (E.D. Tex. Sept. 22, 2015)
- Ex. 1118 *Rembrandt Wireless Techs., LP v. Apple Inc.*, No. 2:19-cv-00025-JRG, Rembrandt's Disclosures Pursuant to Patent Rules 3-1 and 3-2 (E.D. Tex. April 26, 2019)
- Ex. 1119 *Rembrandt Wireless Techs., LP v. Samsung Elecs. Co., Ltd.*, No. 2:13-cv-00213-JRG, Dkt. 352, Memorandum Opinion and Order (E.D. Tex. Feb. 17, 2016)
- Ex. 1120 Reserved
- Ex. 1121 *Samsung Elecs. Co. Ltd., et al. v. Rembrandt Wireless Techs. LP*, IPR2014-00518, Ex. 1218, Declaration of Jon Mears authenticating article "Communication Protocols for Embedded Systems," B. Upender and P. Koopman, Jr.; copy of article "Communication Protocols for Embedded Systems," B. Upender and P. Koopman, Jr.
- Ex. 1122 *Samsung Elecs. Co. Ltd., et al. v. Rembrandt Wireless Techs. LP*, IPR2014-00518, Pap. 1 (Petition for *Inter Partes* Review of U.S. Patent No. 8,023,580) (P.T.A.B. Mar. 20, 2014)
- Ex. 1123 *Samsung Elecs. Co. Ltd., et al. v. Rembrandt Wireless Techs. LP*, IPR2014-00518, Pap. 16 (Decision Institution of *Inter Partes* Review 37 C.F.R. §42.108) (P.T.A.B. Sept. 23, 2014)
- Ex. 1124 *Samsung Elecs. Co. Ltd., et al. v. Rembrandt Wireless Techs. LP*, IPR2014-00518, Ex. 1220, Declaration of David Goodman
- Ex. 1125 Reserved
- Ex. 1126 Reserved

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.