UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC. Petitioner,

v.

MAXELL, LTD., Patent Owner

Case: IPR2020-00597

U.S. Patent No. 8,339,493

PATENT OWNER PRELIMINARY RESPONSE TO PETITION FOR INTER PARTES REVIEW OF U.S. PATENT NO. 8,339,493

Mail Stop **Patent Board**Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450



PATENT OWNER'S EXHIBIT LIST

Description					
5/31/19 Scheduling Order from District Court Action					
Apple's Invalidity Contentions from District Court Action	2002				
Apple's Supplemental Invalidity Contentions from District Court	2003				
Action					
Apple's Motion for Leave to Supplement	2004				
Maxell's Opposition to Motion for Leave to Supplement	2005				
Court Order on Motion for Leave to Supplement	2006				
Apple's Final Election of Prior Art	2007				
Excerpts from Bovik Report	2008				
Sony Chart from Apple's Invalidity Contentions	2009				
Casio Chart from Apple's Invalidity Contentions	2010				
1/8/20 Minute Order	2011				
8/28/19 Minute Order	2012				
9/18/19 Minute Order					
Markman Decision from District Court Action					
4/20/20 Scheduling Order from District Court Action					
Declaration of Tiffany A. Miller					
Notices of Compliance					
COVID Standing Order					
Docket from District Court Action	2019				
Decision denying Apple's Motion to Stay	2020				
'236 IPR Preliminary Response	2021				
'236 IPR Institution Decision	2022				
'904 IPR Preliminary Response	2023				
10/9/18 Letter from Maxell to Apple					
U.S. Patent No. 5,828,406 to Parulski	2025				
Mansoorian Declaration from '236 IPR	2026				
5/17/18 Letter from Maxell to Apple	2027				



Casio Subpoena	2028
Casio Objections and Response to Subpoena	2029
Casio Fiscal Year Schedule	2030



Case IPR2020-00597 Patent No. 8,339,493 Patent Owner Preliminary Response

TABLE OF CONTENTS

				I	Page	
I.	INT	RODU	ICTIO	N	1	
II.	DEN	IY INS	STITU	HOULD EXERCISE ITS DISCRETION AND ITION FOR ALL GROUNDS PURSUANT TO 35	2	
	A.	A. Application of the General Plastic Factors Weighs in Favor Denying Institution				
		1.	Gen	eral Plastic Factors 6 and 7 Weigh in Favor of Denial	6	
			a.	The District Court Action Will Resolve the Same or Substantially the Same Arguments as Those Presented Here	7	
			b.	The District Court Action Will Be Complete Well Before a Final Written Decision in This Proceeding	13	
			c.	Apple's Inexcusable Delay in Filing the Petition	18	
		2.	Gen	eral Plastic Factors 4 and 5 Weigh in Favor of Denial	20	
		3.	Gen	eral Plastic Factor 3 Weighs in Favor of Denial	22	
		4.		eral Plastic Factors 1 and 2 Have Little Probative ue in this Case	26	
	B.		Application of the Fintiv Factors Weighs in Favor of Denying Institution			
III.	THE PETITION DOES NOT SHOW A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY					
	CHALLENGED CLAIM					
	A.			ltarround Of The Polavient Technology		
		1. 2.		kground Of The Relevant Technologyel of Skill of a POSITA		
	D					
	В.	B. Claim Construction				



Case IPR2020-00597 Patent No. 8,339,493 Patent Owner Preliminary Response

TABLE OF CONTENTS (continued)

			Page
C.	Petiti	ioner Failed to Establish that Casio Is Prior Art	38
	1.	The Etchells Declaration is Insufficient to Show Public Accessibility of the Casio User Guide	39
	2.	The Etchells Declaration Lacks Corroboration and Credibility	44
	3.	The Casio Press Release Does Not Demonstrate Public Accessibility of the User Guide Prior to the Critical Date.	45
	4.	Apple Fails to Show Relevant Sales Prior to the Critical Date	48
D.		and 1: Petitioner Failed To Establish That Claims 1, 3, 5, 10 Are Obvious Over Casio In View Of Juen	49
	1.	A POSITA Would Not Have Combined Casio and Juen Without the Benefit of Hindsight	49
	2.	Petitioner fails to establish that Casio in view of Juen Discloses Elements 1(a)/5(a)/10(a)	53
	3.	Petitioner fails to establish that Casio in view of Juen Discloses Elements 1(b)/5(b)/10(b)	56
	4.	Petitioner fails to establish that Casio in view of Juen Discloses Elements 1(d)/5(e)/10(f)	59
	5.	Petitioner fails to establish that Casio in view of Juen Discloses the "pixel intervals of K1 pixels" / "intervals of a first distance" of Elements 1(d)/5(e)/10(f) and the "pixel intervals of K2 pixels" / "intervals of a second distance" of Elements 1(e)/5(f)/10(g)	
	6.	Petitioner fails to establish that Casio in view of Juen Discloses Claim 3	
E.		and 2: Petitioner Failed To Establish That Claim 4 Is	63



DOCKET

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.

