

Filed: March 16, 2021

Filed on behalf of:

Patent Owner One-E-Way, Inc.
By: Douglas G. Muehlhauser (Reg. No. 42018)
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, Fourteenth Floor
Irvine, CA 92614
Tel.: (949) 760-0404
Fax: (949) 760-9502
E-mail: BoxOne-E-Way@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

ONE-E-WAY, INC.,

Patent Owner.

Case IPR2021-00283
U.S. Patent 8,131,391 B2

PATENT OWNER PRELIMINARY RESPONSE

TABLE OF CONTENTS

	Page No.
I. INTRODUCTION	1
II. BACKGROUND OF THE INVENTION AND OVERVIEW OF THE CHALLENGED PATENT	3
A. Development Of The Invention.....	3
B. Embodiments Described In The Specification.....	4
C. The Claims	5
D. Preliminary Claim Construction.....	5
E. Person of Ordinary Skill In The Art.....	7
F. Priority Date Of The Challenged Claims	7
III. PETITIONER’S GROUNDS	8
IV. OVERVIEW OF THE REFERENCES RELIED UPON.....	9
A. Ham	9
B. Sklar.....	9
C. Xia	9
D. Groe	10
E. Haartsen.....	10
V. GROUNDS 1 AND 2 FAIL	10
A. Ham Does Not Disclose Reduced Intersymbol Interference Coding.....	12

TABLE OF CONTENTS
(cont'd)

	Page No.
1. Petitioner establishes no motivation to add reduced ISI coding to Ham	12
2. Petitioner fails to show that a skilled artisan would look to Sklar and Xia to alter Ham with respect to the reduced ISI limitation	16
a) The record provides no motivation to combine Ham with Sklar	16
b) The record provides no motivation to combine Ham with Sklar and Xia	18
3. Petitioner’s “alternative mapping” theories for reduced ISI fail.....	23
B. Ham Does Not Disclose <i>Independent</i> CDMA	25
1. The record fails to show that Ham discloses “one-to-one correspondence”.....	26
2. The record fails to support Petitioner’s assertion that Ham does not suggest centralized control	27
3. Ground 2 Cannot Rectify Ham’s Shortcomings.....	32
a) Ground 1’s failure is fatal to Ground 2	33
b) Petitioner establishes no motivation to substitute Ham’s CDMA method with Haartsen’s FH-CDMA method.....	36
C. Ham Does Not Disclose A Direct Conversion Module	38

TABLE OF CONTENTS
(cont'd)

	Page No.
VI. RESERVATION OF RIGHTS.....	43
VII. CONCLUSION.....	44

TABLE OF AUTHORITIES

Page No(s).

<i>Auris Health Inc. v. Intuitive Surgical Operations, Inc.</i> , IPR2019-01547, Paper 11 (March 3, 2021).....	11
<i>In re Certain Wireless Headsets</i> , Investigation No. 337-TA-943.....	5
<i>Ex parte Claus Grewe</i> , Appeal No. 2019-000855.....	15, 24
<i>Ex parte Jerry L. Allen</i> , Appeal No. 2018-008208.....	16, 24
<i>In re Kahn</i> , 441 F.3d 977 (Fed. Cir. 2006)	11, 14, 27
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	11, 12, 14, 22
<i>In re NuVasive, Inc.</i> , 842 F.3d 1376 (Fed. Cir. 2016)	11, 26, 41
<i>Personal Web Techs. v. Apple, Inc.</i> , 848 F.3d 987 (Fed. Cir. 2017)	18, 42
<i>Sony Corp. v. One-E-Way</i> , IPR2016-01638, Paper 42 (P.T.A.B. Feb. 9, 2018).....	7
<i>Trivascular, Inc. v. Samuels</i> , 812 F.3d 1056 (Fed. Cir. 2016)	22

OTHER AUTHORITIES

35 U.S.C. § 314.....	11
M.P.E.P. § 2143.01	37

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.