UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

GUI GLOBAL PRODUCTS, LTD.,
Patent Owner

Case IPR2021-01290
Patent 10,259,021

PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS

Apple previously filed a petition in IPR2021-00471 ("Apple's Petition") challenging claims of U.S. Patent No. 10,259,021 ("the '021 Patent") on February 5, 2021. The Board has yet to render an institution decision based on Apple's Petition. Apple now files an additional petition in IPR2021-01290 ("Copycat Petition") challenging claims of the '021 Patent with a conditional motion for joinder to Samsung's IPR2021-00336 proceeding, which was instituted on July 2, 2021. Pursuant to the November 2019 Consolidated Trial Practice Guide ("CTPG"), this paper provides: "(1) a ranking of the petitions in the order in which [Petitioner] wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions." CTPG, 59-61.

I. Ranking of Petitions

The merits of Apple's Petition are particularly strong. As demonstrated in Apple's Petition with reference to Dr. Cooperstock's testimony and additional evidence, institution would result in invalidation of the challenged claims of the '021 Patent. Apple respectfully requests that the Board prioritize institution of Apple's Petition over consideration of the Copycat Petition.

II. Material Differences Between the Petitions

Apple's Petition and the Copycat Petition each demonstrate the obviousness of claims of the '021 Patent, but they do so on the basis of different combinations of references that address the respectively challenged claims in materially different ways. At bottom, the petitions are non-redundant in their reliance on these different combinations of references.

The grounds of rejection set forth in Apple's Petition each feature U.S. Patent Publication No. 2008/0132293 (Gundlach) as a primary reference. Gundlach describes wireless headsets having "relatively thin shape[s] [that] may allow the headset[s] to be stored and charged in…portable cradle[s]" that are described as incorporating embedded magnets and/or mechanical elements for headset retention. Gundlach, [0003], [0005], [0055]-[0056], [0068], [0073], [0075], Figures 10a-19b. Further, and as explained at length in Apple's Petition, a POSITA would have found it obvious in view of U.S. Patent No. 7,548,040 (Lee) to modify Gundlach to incorporate inductive charging components. *See* Apple's Petition, 9-18.

In contrast, the grounds of rejection set forth in the Copycat Petition feature U.S. Patent Publication No. 2010/0227642 (Kim) as a primary reference. Kim describes mobile terminals (e.g., smart phones and devices with watch-type form factors) that include "a main device (first device) 100 and one or more sub-devices (second devices) 300a to 300n that can be detachably attached to the main device"

using magnetic components. Kim, [0069], [0070], [0181], [0185], [0218].

As is apparent, Gundlach and Kim offer very different disclosures that, in combination with non-overlapping secondary references, demonstrate the obviousness of the '021 Patent's claims in materially different ways. Additionally, the motivations to combine the distinct sets of references presented in each of the two petitions materially differ. In at least these ways, Apple's Petition and the Copycat Petition offer non-redundant, non-duplicative, and substantially dissimilar challenges to a patent that has been simultaneously asserted against each of Apple and Samsung. In summary, each petition provides strong showings of obviousness, without repeating the same theories.

III. Additional Factors that Support Institution in the Alternative

The purpose of the Copycat Petition and the accompanying conditional motion for joinder is twofold: **(1)** to avoid the unnecessary cost of duplicative litigation in different forums on the subject of validity over printed publication prior art; and **(2)** to avoid potentially inconsistent decisions from different forums addressing the same prior art grounds. If the Board were to deny both Apple's Petition and the Copycat Petition, Apple would have no choice but to pursue its printed publication invalidity grounds in district court, separate and apart from the already-instituted proceeding in IPR2021-00336. Additionally, because Apple is unrelated to the petitioner in IPR2021-00336, settlement and termination of

IPR2021-00336 would harm Apple if both Petitions were denied. *See Iron Oak Techs., LLC v. Samsung Elecs. Co., LTD.*, IPR2018-01554, Paper 9 at 29 (PTAB Feb. 13, 2019). Patent Owner's infringement suit against Apple would remain, and the '021 Patent's challenged claims would go untested at the PTAB.

On the other hand, institution in the alternative of either Apple's Petition or the Copycat Petition would promote adjudication of all printed publication prior art by the PTAB, and likely also result in a stay of the district court litigation. EX1116, 2 (noting that stay will be unopposed if Apple's originally-filed petitions are instituted). As such, the present circumstances offer a prime opportunity for IPR to serve its intended role as a true alternative to district court litigation. The Board's final written decision in a proceeding involving the '021 Patent and Apple as a petitioner would bind Apple via the § 315(e)(2) estoppel before a jury trial, and thereby promote judicial efficiency.[1] *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB 2020).

More specifically, Apple respectfully requests that the Board institute Apple's Petition, which would promote adjudication of Apple's and Samsung's printed publication invalidity grounds by a single forum—the PTAB—which could serve as

[1] The district court as yet to set a trial date, and there is no reasonable expectation that it will schedule a trial ahead of the Board's final written decision.

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