UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

Case IPR2022-00348
Patent No. 10,484,915

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LIST

Exhibit No.	Description
2001	Declaration of Kayvan B. Noroozi in Support of Motion for Admission *Pro Hac Vice*
2002	
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I. Introduction

The Petition's unpatentability theories compare the Petition's alleged prior art references to a critical date of November 4, 2016 for the challenged claims. Pet. at 1. The Petition provides no other possible critical date for the challenged claims, and raises no dispute as to whether the November 4, 2016 critical date should apply. Accordingly, the Petition's theories and evidence must be assessed against a November 4, 2016 critical date. Section V.A, *supra.*

Each of the Petition's three grounds, however, relies on references that on their faces do not pre-date the critical date of the challenged claims. Agiwal, the Petition's primary reference for Grounds 1 and 2, was filed on February 27, 2017 and published on August 31, 2017. Abedini, the Petition's sole reference for Ground 3, was filed on October 20, 2017 and published on April 26, 2018.

The Petition contends that Agiwal and Abedini are nonetheless prior art because each is entitled to the priority date of its underlying provisional application. Pet. at 2.

To establish those assertions, however, it is well-settled that the Petition must at least demonstrate that the Agiwal Provisional and the Abedini Provisional each disclose the subject matter the Petition relies upon from Agiwal and Abedini. Section V.B, *supra*.

But the Petition does not even attempt to make that showing, and thus fails to meet its burden of demonstrating obviousness on that basis alone. Section V.C, *supra*. Moreover, the Petition relies extensively on teachings from Agiwal and Abedini that are *entirely absent* from the underlying provisionals, as this Preliminary Response demonstrates in detail. Section V.D, *supra*. Abedini and Agiwal thus cannot constitute prior art in view of the applicable critical date.

The Petition's glaring deficiencies are unsurprising given its provenance. Apple's Petition is essentially a cut-and-paste of a prior petition filed by Samsung challenging the same claims of U.S. Patent 10,484,915 (the "'915 Patent"). *See* IPR2021-00644. Apple's Petition essentially mirrors Samsung's prior petition, asserting the same grounds and arguments. Yet the '915 Patent is not currently asserted against Apple in any pending litigation, so Apple's Petition is not a means for "providing a quick and cost-effective alternative[] to litigation," which is the purpose of *inter partes* review as outlined in the legislative history. H.R. Rep. No. 112–98, pt. 1, at 40 (2011). The use of *inter partes* review in this manner "frustrate[s] the purpose of the section as providing quick and cost-effective *alternatives to litigation*" and "divert[s] resources from the research and development of inventions." *See, e.g.*, *id*. at 40 (2011) (Legislative history establishing *inter partes* review) (emphasis added).

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