

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

SCRAMOGE TECHNOLOGY LTD.,
Patent Owner

IPR2022-00351
Patent 10,622,842

PATENT OWNER'S PRELIMINARY RESPONSE

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U.S. Patent and Trademark Office
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Alexandria, VA 22313-1450

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Notice of IPR Petitions, <i>Scramoge Technology Ltd. v. Apple Inc.</i> , Case No. 6:21-cv-00579-ADA, Dkt. No. 42 (W.D. Tex. Jan. 7, 2022)
2002	Scheduling Order, <i>Scramoge Technology Ltd. v. Apple Inc.</i> , Case No. 6:21-cv-00579-ADA, Dkt. No. 33 (W.D. Tex. Sept. 28, 2021)
2003	Law360 Article: <i>West Texas Judge Says He Can Move Faster Than PTAB</i>
2004	Text Order Denying Motion to Stay Pending IPR, <i>Solas OLED Ltd. v. Google, Inc.</i> , Case No. 6:19-cv-00515-ADA (W.D. Tex. June 23, 2020)
2005	Order Denying Motion to Stay Pending IPR, <i>Multimedia Content Management LLC v. DISH Network L.L.C.</i> , Case No. 6:18-cv-00207-ADA, Dkt. No. 73 (W.D. Tex. May 30, 2019)
2006	Scheduling Order, <i>Correct Transmission LLC v. Adtran, Inc.</i> , Case No. 6:20-cv-00669-ADA, Dkt. No. 34 (W.D. Tex. Dec. 10, 2020)
2007	Scheduling Order, <i>Maxell Ltd. v. Ampere Technology Ltd.</i> , Case No. 6:21-cv-00347-ADA, Dkt. No. 37 (W.D. Tex. Nov. 8, 2021)
2008	Standing Order Governing Proceedings in Patent Cases (OGP) 4.1, Judge Alan D. Albright (April 14, 2022)
2009	Claim Construction Order, <i>Solas OLED Ltd. v. Apple Inc.</i> , Case No. 6:19-cv-00537-ADA, Dkt. No. 61 (W.D. Tex. Aug. 30, 2020)
2010	Plaintiff Scramoge Technology Ltd.'s Amended Preliminary Disclosure of Asserted Claims and Infringement Contentions to Apple Inc. in <i>Scramoge Technology Ltd. v. Apple Inc.</i> , Case No. 6:21-cv-00579-ADA (W.D. Tex.)

2011	Defendant Apple Inc.'s First Amended Preliminary Invalidity Contentions in <i>Scramoge Technology Ltd. v. Apple Inc.</i> , Case No. 6:21-cv-00579-ADA (W.D. Tex.)
2012	Android Authority article: LG Innotek's Latest wireless charger is Three times faster
2013	Scheduling Order, <i>Scramoge Technology Ltd. v. Google LLC</i> , Case No. 6:21-cv-00616-ADA, Dkt. No. 28 (W.D. Tex. Nov. 15, 2021)
2014	Defendants' Joint Reply Claim Construction Brief in <i>Scramoge Technology Ltd. v. Apple Inc.</i> , Case No. 6:21-cv-00579-ADA (W.D. Tex.)
2015	Scheduling Order, <i>Scramoge Technology Ltd. v. Apple Inc.</i> , Case No. 6:21-cv-00579-ADA, Dkt. No. 56 (W.D. Tex. Feb. 11, 2022)

I. INTRODUCTION

Patent Owner Scramoge Technology Ltd. (“Patent Owner”) submits this preliminary response to Petitioner Apple Inc.’s (“Petitioner”) petition for *inter partes* review of U.S. Patent No. 10,622,842 (“’842 patent”).

The Board should exercise its discretion to deny the petition in light of a parallel district court case involving the same patent, the same claims, the same prior art, and the same parties. By the time the Board reaches an institution decision in this proceeding, the parties and the district court will have already invested significant time and resources in the case—the parties will have already exchanged final infringement and invalidity contentions, claim construction will be completed and discovery will nearly be closed. The district court trial is also on track to take place *five months* before the deadline for a final written decision. Moreover, because the *Fintiv* factors so strongly favor a discretionary denial, the Board need not consider the merits. Thus, all six *Fintiv* factors strongly favor a discretionary denial.

Accordingly, the Board should deny institution.

II. ALL *FINTIV* FACTORS WEIGH AGAINST INSTITUTION

35 U.S.C. § 314(a) gives the Board discretion to deny institution of the requested *inter partes* review due to the advanced state of parallel district court litigation regarding the same issues. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7,

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