#### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Marcus Da Silva et al.

U.S. Patent No.: 10,715,235 Attorney Docket No.: 50095-0047IP1

Issue Date: July 14, 2020 Appl. Serial No.: 15/495,539 Filing Date: April 24, 2017

Title: DIRECTED WIRELESS COMMUNICATION

## **Mail Stop Patent Board**

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

# PETITION FOR INTER PARTES REVIEW OF UNITED STATES PATENT NO. 10,715,235 PURSUANT TO 35 U.S.C. §§ 311–319, 37 C.F.R. § 42



# TABLE OF CONTENTS

Ι.	REQ	UIREMENTS FOR IPR UNDER 37 C.F.R. § 42.104	1		
	_	Grounds for Standing			
		Challenge and Relief Requested			
		Level of Ordinary Skill in the Art			
		Claim Construction			
II.	THE '235 PATENT4				
		Brief Description			
		Relevant History of the '235 Patent			
	1	. Applicant's Arguments During Prosecution	9		
	2	2. Applicant Failed to Establish a February 2002 Invention Date			
	3	The Effective Filing Date is After November 4, 2002			
III.	THE	CHALLENGED CLAIMS ARE UNPATENTABLE	20		
	<b>A.</b> (	GROUND 1: Claims 8-12 are obvious over Burke	20		
		. Overview of Burke			
	2	2. Manner in which Burke Renders Claims 8-12 Obvious	25		
	<b>B.</b> (	GROUND 2: Claims 13 and 14 are obvious over Burke in view of Shi	ull		
		48			
	1	. Overview of Shull	48		
	2	2. Combination of Burke and Shull	49		
	3	3. Manner in which the Prior Art Renders Claims 13 and 14 Obvior	us		
			51		
IV.	PTA	B DISCRETION SHOULD NOT PRECLUDE INSTITUTION	58		
	1	Factor 1: No Party Has Yet to Request Stay	59		
	2	2. Factor 2: The FWD will likely issue around the same time as the			
		Trial	59		
	3	3. Factor 3: Petitioners' Diligence and Investment in IPR Outweigh	ıs		
		the Parties' Minimal Investment in Litigation	61		
	4	Factor 4: The Petition's Grounds are Materially Different from			
		any that Might be Raised in Litigation			
	5	5. Factor 5: Institution Would Promote Judicial Efficiency	64		
	6	6. Factor 6: The Merits of this Petition Strongly Favor Institution	65		
V.	CON	CLUSION	66		
VI.	PAY	MENT OF FEES	66		
VII.	MAN	NDATORY NOTICES UNDER 37 C.F.R § 42.8(a)(1)	66		
		Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)			
		-			



# Attorney Docket No. 50095-0047IP1 IPR of U.S. Patent No. 10,715,235

B.	Related Matters Under 37 C.F.R. § 42.8(b)(2)	67
	Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)	
	Service Information	



## **EXHIBITS**

EXHIBIT-1001	U.S. Patent No. 10,715,235 to Da Silva ("the '235 Patent")
EXHIBIT-1002	Prosecution History of the '235 Patent ("the Prosecution History")
EXHIBIT-1003	Declaration and Curriculum Vitae of Dr. Robert Akl
EXHIBIT-1004	Complaint, XR Communications, LLC v. Apple Inc., 6:21-cv-00620, W.D. Tex., June 16, 2021
EXHIBIT-1005	[RESERVED]
EXHIBIT-1006	U.S. Patent No. 7,155,231 ("Burke")
EXHIBIT-1007	U.S. Patent No. 6,006,077 ("Shull")
EXHIBIT-1008	U.S. Patent Application Publication No. 2002/0158801 ("Crilly")
EXHIBIT-1009	U.S. Provisional Application No. 60/423,660 ("'660 Provisional Application")
EXHIBIT-1010	U.S. Patent No. 6,879,823 ("Raaf")
EXHIBIT-1011	PCT Application Publication No. WO 02/47286 ("Hottinen")
EXHIBIT-1012	U.S. Patent No. 6,662,024 ("Walton")
EXHIBIT-1013	U.S. Patent No. 6,208,863 ("Salonaho")
EXHIBIT-1014	U.S. Patent Application Publication No. 20020080862 ("Ali")
EXHIBIT-1015	U.S. Patent No. 7,340,017 ("Banerjee")
EXHIBIT-1016	U.S. Patent No. 6,792,031 ("Sriram")



EXHIBIT-1017 Andrea Goldsmith, Wireless Communications, Cambridge University Press, 2005 EXHIBIT-1018 Complaint, XR Communications, LLC v. HP Inc., 6:21-ev-00694, W.D. Tex., July 1, 2021 EXHIBIT-1019 U.S. Patent No. 6,661,832 ("Sindhushayana") EXHIBIT-1020 Plaintiff's Infringement Contentions, XR Communications, LLC v. Apple Inc., 6:21-cv-00620, W.D. Tex., Dec. 20, 2021 EXHIBIT-1021 "How the Pandemic is Shaping Patent Trials in District Courts," Law360, Feb. 18, 2021, available at https://www.troutman.com/insights/how-the-pandemic-isshaping-patent-trials-in-district-courts.html EXHIBIT-1022 "2021 Discretionary Denials Have Passed 100, But Are Slowing," Dani Krass, Law360, July 21, 2021 EXHIBIT-1023 "Leahy And Cornyn Introduce Bipartisan Bill To Support American Innovation And Reduce Litigation", Sep. 29, 2021, available at: https://www.leahy.senate.gov/press/leahy-andcornyn-introduce-bipartisan-bill-to-support-americaninnovation-and-reduce-litigation EXHIBIT-1024 Restoring the America Invents Act, S. 2891, 117<sup>th</sup> Cong. (2021) "Roku's Trial Delay Request OK'd by 'Surprised' Texas EXHIBIT-1025 Judge," Law360, Aug. 10, 2020, available at https://www.law360.com/articles/1299933



# 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.

