

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

SCRAMOGE TECHNOLOGY LTD.,
Patent Owner

IPR2022-00573
Patent 7,825,537

PATENT OWNER'S PRELIMINARY RESPONSE

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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-01071-ADA, Dkt. No. 30 (W.D. Tex. Feb. 16, 2022)
2002	Scheduling Order, <i>Scramoge Technology Ltd. v. Apple Inc.</i> , Case No. 6:21-cv-01071-ADA, Dkt. No. 36 (W.D. Tex. Apr. 27, 2022)
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	Standing Order Governing Proceedings in Patent Cases, Judge Alan D. Albright
2007	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)
2008	Plaintiff Scramoge Technology Ltd.'s 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-01071-ADA (W.D. Tex.)
2009	Defendant Apple Inc.'s Preliminary Invalidity Contentions in <i>Scramoge Technology Ltd. v. Apple Inc.</i> , Case No. 6:21-cv-01071-ADA (W.D. Tex.)

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. 7,825,537 (“the ’537 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—claim construction will be completed and discovery will be underway. The district court trial is also set to take place months before the deadline for a final written decision. Moreover, the petition fails on the merits as described above. 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,

2019) (“*NHK Spring*”). The Board has set forth six factors for determining whether discretionary denial due to such parallel litigation is appropriate (the “*Fintiv* factors”):

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020) (“*Fintiv I*”); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7–8 (PTAB May 13, 2020) (decision denying institution of *inter partes* review) (“*Fintiv II*”). “These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Fintiv I* at 6. In evaluating the factors, “the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

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