

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC. AND HP INC.,  
Petitioners

v.

XR COMMUNICATIONS, LLC, D/B/A VIVATO TECHNOLOGIES,  
Patent Owner

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IPR2022-00367  
Patent No. 10,715,235

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**PATENT OWNER'S PRELIMINARY RESPONSE**

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Exhibits

<b>Exhibit No.</b>	<b>Description</b>
<b>2001</b>	Complaint, <i>XR Communications v. Apple Inc.</i> , W.D. Tex. Case No. 21-cv-00620-ADA
<b>2002</b>	Complaint, <i>XR Communications v. HP Inc.</i> , W.D. Tex. Case No. 21-cv-00694-ADA
<b>2003</b>	Scheduling Order, <i>XR Communications v. Apple Inc.</i> , W.D. Tex. Case No. 21-cv-00620-ADA, Dkt. No. 27 (W.D. Tex., Jan. 13, 2022)
<b>2004</b>	Scheduling Order, <i>XR Communications v. HP Inc.</i> , W.D. Tex. Case No. 21-cv-00694-ADA, Dkt. No. 24 (W.D. Tex., Jan. 13, 2022)
<b>2005</b>	Notice of Agreed Extension of Deadline, <i>XR Communications v. Apple Inc.</i> , W.D. Tex. Case No. 21-cv-00620-ADA, Dkt. No. 27 (W.D. Tex., Jan. 13, 2022)
<b>2006</b>	Notice of Agreed Extension of Deadline, <i>XR Communications v. HP Inc.</i> , W.D. Tex. Case No. 21-cv-00694-ADA, Dkt. No. 24 (W.D. Tex., Jan. 13, 2022)
<b>2007</b>	Exhibit A-14 to Defendants' Preliminary Invalidation Contentions in <i>XR Communications v. Apple Inc.</i> , W.D. Tex. Case No. 21-cv-00620-ADA and <i>XR Communications v. HP Inc.</i> , W.D. Tex. Case No. 21-cv-00694-ADA
<b>2008</b>	Excerpts of Defendants' Preliminary Invalidation Contentions in <i>XR Communications v. Apple Inc.</i> , W.D. Tex. Case No. 21-cv-00620-ADA and <i>XR Communications v. HP Inc.</i> , W.D. Tex. Case No. 21-cv-00694-ADA

## **I. Introduction**

The Petition (“Pet.”) challenges the claims 8-14 of U.S. Patent No. 10,715,235 (Ex. 1001) under two grounds of unpatentability. One of the primary objectives of the AIA was “to provide an effective and efficient alternative to district court litigation.” But this IPR cannot be an alternative (much less an effective and efficient one) to a WDTex trial between Petitioner and Patent Owner scheduled to conclude before the FWD deadline. The parties have already begun investing significant resources in that case and at the time of the institution decision, the parties in the WDTex will have completed the Markman process and be in the midst of fact discovery. Further, the WDTex case and scheduled trial will involve the same claim construction standard, same invalidity theories, and same prior art references that are at issue in this IPR. Under the PTAB’s precedential orders in *NHK Spring* and *Fintiv*, the Board should deny institution under § 314(a).

## **II. Petitioner’s Asserted Grounds and References**

The Petition asserts the following two grounds of unpatentability:

- Claims 8-12 are obvious over Burke. (Pet. at 2).
- Claims 13, 14 are obvious over Burke in view of Shull. (Pet. at 2).

## **III. Institution Should Be Denied Under the *Fintiv* Factors**

35 U.S.C. § 314(a) only permits the Director to authorize institution when there is a reasonable likelihood that the petitioner will prevail with respect to at least

one of the challenged claims. Petitioners' arguments on the merits suffer from several weaknesses that apply to all grounds and challenged claims. Patent Owner addresses the Petition's merits below, particularly to show that the merits are not "particularly strong" and do not establish a reasonable likelihood of success. While these substantive issues provide an independent bases for denying institution of this IPR, they also fail to support institution under *Fintiv* Factor 6.

The Petition asserts only two grounds of unpatentability. Pet. at 2. Both grounds are based on the Burke reference. Pet. at 2. Patent Owner respectfully submits that Exhibit-1006 (Burke) does not qualify as prior art under 35 U.S.C. § 102(b) or § 102(e).

The Petition asserts that the Burke reference was filed on October 15, 2002. Pet. at 2. The Petition then asserts that Burke qualifies as prior art under 35 U.S.C. § 102(b) or § 102(e) based on an alleged priority date for the '235 Patent of November 3, 2003. Pet. at 2. However, as Applicant explained during the prosecution of the '534 Application, the challenged claims are entitled to a priority date at least as early as February 1, 2002. See EX-1002, 268-272 ('235 Patent File History, Office Action Response, dated July 25, 2018, at 2-6). Indeed, the Examiner found these arguments "persuasive" and agreed that the challenged claims are entitled to a priority date at least as early as February 1, 2002. EX-1002, 98 ('235 Patent File History, Office Action, dated September 26, 2018, at 2).

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