EXHIBIT E

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Paper 11
Entered: June 19, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2020-00204
Patent 6,928,306 B2

Before MICHAEL R. ZECHER, KEVIN C. TROCK, and JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Apple Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review ("IPR") of claims 2, 5, 6, and 12–15 ("the challenged claims") of U.S. Patent No. 6,928,306 B2 (Ex. 1001, "the '306 patent"). Petitioner filed a Declaration of Michael Kotzin, Ph.D. (Ex. 1006) with its Petition. Patent Owner, Maxell, Ltd. ("Patent Owner"), filed a Preliminary Response (Paper 6, "Prelim. Resp.").

With our authorization (Paper 7), Petitioner also filed a Reply (Paper 8, "Pet. Reply") and Patent Owner filed a Sur-Reply (Paper 10, "PO Sur-reply") addressing whether we should exercise our discretion to deny institution under 35 U.S.C. § 314(a).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and the preliminary response "shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons that follow, we institute an *inter partes* review as to claims 2, 5, 6, and 12–15 of the '306 patent on all grounds of unpatentability presented.

I. BACKGROUND

A. Real Parties-in-Interest

Petitioner identifies Apple Inc. as the real party-in-interest. Pet. 48. Patent Owner identifies Maxell, Ltd. as the real party-in-interest. Paper 4, 1.

B. Related Proceedings

The parties identify the following proceedings related to the '306 patent (Pet. 43, 48; Paper 4, 1):

Maxell, Ltd. v. Apple Inc., No. 5:19-cv-00036 (E.D. Tex. Mar. 15, 2019) ("the underlying litigation"); and

Huawei Techs. Co. v. Maxell, Ltd., IPR2019-00640 (settled prior to institution decision) ("the '640 IPR").

In the '640 IPR, Patent Owner identified two other proceedings related to the '306 patent (IPR2019-00640, Paper 4, 1):

Maxell, Ltd. v. Huawei Device USA, Inc., No. 5:18-cv-00033 (E.D. Tex. Mar. 2, 2018); and

Maxell, Ltd. v. ZTE Corp., No. 5:18-cv-00034 (E.D. Tex. Mar. 2, 2018).

C. The '306 patent

The '306 patent is directed to a portable mobile unit that alerts a user of an incoming call using a ringing sound. Ex. 1001, 1:6–10. Figure 1 of the '306 patent is reproduced below.

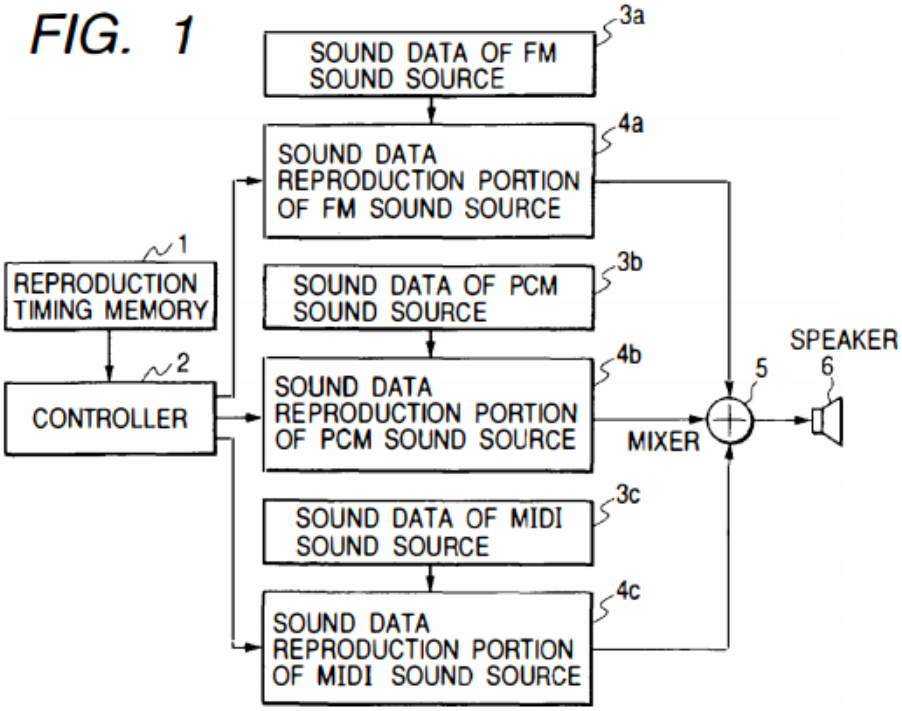

Figure 1 depicts a communication controller and ringing sound generator of a cellular phone. *Id.* at 2:59–61, 4:34–36. The ringing sound generator includes frequency modulation (FM) sound data memory 3a, pulse-code modulation (PCM) sound data memory 3b of a sound source, and Musical

Instrument Digital Interface (MIDI) method sound data memory 3c. *Id.* at 4:41–44. Each of these memories has corresponding sound data reproduction portions 4a, 4b, and 4c, respectively, connected to controller 2. *Id.* at 4:44–53. Controller 2 determines the timing for reproducing selected sound data based on data in reproduction timing memory 1. *Id.* at 4:53–59. Outputs of the respective sound reproduction portions 4a, 4b, and 4c are connected to a mixer 5, which outputs ringing sounds to speaker 6. *Id.* at 4:59–65.

The pattern of a ringing sound may be changed based on a range of time[1] (e.g., from "midnight to the early morning," a day of the week, or holidays) during which a call is received. *Id.* at 9:62–10:64, Figs. 5, 6.

The '306 patent issued from an application that was filed January 4, 2001, which claims priority to a Japanese patent application filed on January 7, 2000. *Id.*, codes (22), (30). As discussed below, Petitioner attempts to establish that, at a minimum, its asserted references qualify as prior art relative to either the January 7, 2000, filing date of the Japanese application (i.e., the earliest possible effective filing date) or the January 4, 2001, filing date of the U.S. application.

[1] The '306 patent refers to ranges of time as "time zones." *See, e.g.*, Ex. 1001, 10:24–28. Petitioner asks us to make a "clarifying construction" that "'time zone' . . . indicate[s] a duration of time or range of hours, rather than one of 24 zones on the earth." Pet. 7 (citing Ex. 1001, 10:35–40). Although we agree with Petitioner's interpretation, we need not affirmatively construe "time zone" given that the asserted prior art (Miura) uses the same term in the same manner. *See, e.g.*, Ex. 1005, 7:37–46.

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