

EXHIBIT 1

Trials@uspto.gov
571-272-7822

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.

IPR2020-00199
Patent 6,329,794 B1

Before MINN CHUNG, 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 1–3 and 5–14 (the “challenged claims”) of U.S. Patent No. 6,329,794 B1 (Ex. 1001, “the ’794 patent”). Petitioner filed a Declaration of Louis Hruska (Ex. 1003) with its Petition. Patent Owner, Maxell, Ltd. (“Patent Owner”), filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

IPR2020-00199
Patent 6,329,794 B1

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 1–3 and 5–14 of the ’794 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. 71. Patent Owner identifies Maxell, Ltd. as the real party-in-interest. Paper 5, 1.

B. *Related Proceedings*

The parties identify the following proceedings related to the ’794 patent (Pet. 71; Paper 5, 1):

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

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

IPR2020-00199
Patent 6,329,794 B1

ZTE Corp. v. Maxell, Ltd., IPR2018-00241 (institution denied) (“the ’241 IPR”).

We further note that Petitioner’s arguments reference two other cases involving the ’794 patent (Pet. 6; *see also* Ex. 1010):

Maxell, Ltd. v. Huawei Device USA, Inc., No. 5:16-cv-00178 (E.D. Tex. Nov. 18, 2016) (“the Huawei litigation”); and

Maxell, Ltd. v. ZTE Corp., No. 5:16-cv-00179 (E.D. Tex. Nov. 18, 2016).

C. The ’794 patent

The ’794 patent is directed to controlling power consumption in a battery-operable information processing device. Ex. 1001, 1:6–11. Figure 1 of the ’794 patent is reproduced below.

FIG.1

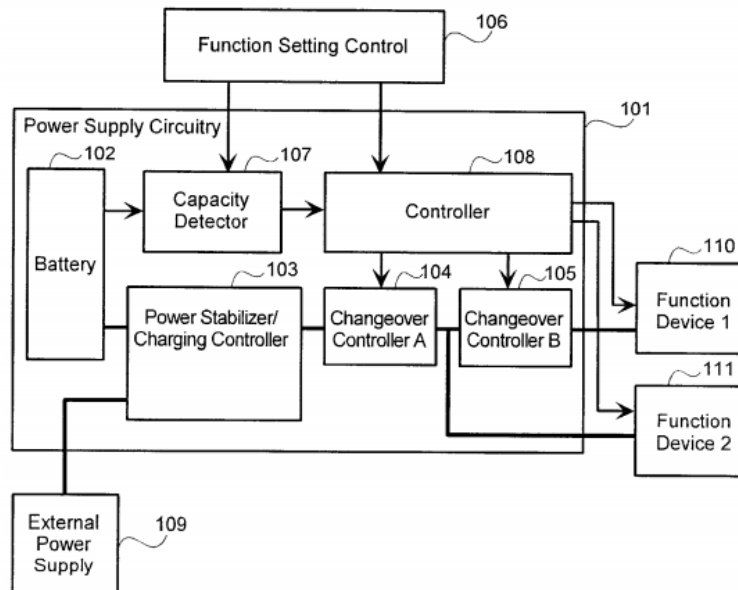


Figure 1 depicts power supply section 101, which supplies power to various functions in an information processing device. *Id.* at 3:23–25. Power supply

IPR2020-00199
Patent 6,329,794 B1

section 101 includes battery 102 and power stabilizer/charging controller 103. *Id.* at 3:25–28. Capacity detector 107 detects the remaining capacity of battery 102. *Id.* at 3:34–35. Power supply section 101 is connected to function device 1 110 and function device 2 111, each of which implements functions of the information processing device. *Id.* at 3:42–44. As examples of such functions, the '794 patent mentions a modem function, an audio communication function, and a videophone function. *Id.* at 1:18–21, 1:31–35.

Changeover controller A 104 switches between activation and stopping of power to function device 1 and function device 2, whereas changeover controller B 105 switches between activation and stopping of power to function device 1. *Id.* at 3:29–34. Controller 108 controls changeover controllers A, B and sends power consumption reduction instructions to function devices 1, 2. *Id.* at 3:35–38.

Priority levels are set for individual function devices and battery time can be maintained in a prioritized manner for function devices with higher priorities. *Id.* at 2:21–26. Power consumption reduction instructions are sent to function devices with lower usage priorities when battery capacity decreases below certain thresholds levels. *Id.* at 1:55–59. As a result, lower-priority function devices will be powered down before higher-priority function devices. *Id.* at 1:59–62. This power management method allows a user to continue using higher-priority functions for a longer period of time by reducing power to lower-priority functions as the battery capacity is depleted. *Id.* at 1:62–67.

The '794 patent issued from an application that was filed September 7, 2000, which claims priority to a Japanese patent application

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.