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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

OPTIS WIRELESS TECHNOLOGY, LLC
Patent Owner

Case IPR2020-00466
U.S. Patent No. 8,411,557

PETITIONER'S REPLY TO PATENT OWNER PRELIMINARY RESPONSE

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The POPR urges denial of the Petition under § 314(a) based on misapplication of the *Fintiv* factors and an undue focus on the time between the trial date in the district court litigation ("Texas case") and an expected Final Written Decision ("FWD"). Other factors favor institution, including Petitioner's strong showing on the merits, a lack of overlap in prior art between the Petition and the Texas case, and the complexities of litigation. A balanced weighing of the factors shows that the patent system would best be served by instituting review.

I. The *Fintiv* Factors Counsel Against Exercising Discretion to Deny

A. Factor 1: Lack of Evidence of Stay Renders This Factor Neutral

The Board routinely declines to speculate as to the likelihood of a stay where none has been requested. *See, e.g.*, *Fintiv*, Paper 15 at 12. Because no stay has been requested in the Texas case, this factor is neutral. *Id.*

B. Factor 3: Petitioner's Diligence and No Tactical Advantage

PO's discussion of Factor 3 fails to acknowledge Petitioner's diligence in filing the Petition, which favors institution. Petitioner's initial invalidity contentions identified nearly 140 prior art references across seven asserted patents in the Texas case. Rather than burden the Board with multiple petitions on seven patents, Petitioner diligently evaluated the unique strengths of each prior art reference and combination, searched for additional prior art, and filed only three petitions. This Petition uses only two grounds to show unpatentability of 10 claims

in a way that does not depend on the constructions disputed by the parties in the Texas case. Such careful selection of grounds shows Petitioner's diligence. *See Med-El Elek. Geräte GES.M.B.H v. Advanced Bionics AG*, IPR2020-00190, Paper 15 at 13-14 (June 3, 2020). PO does not allege that Petitioner obtained any tactical advantage for the Petition from the litigation based on the time the Petition was filed.

C. Factor 4: The Issues Do Not Substantially Overlap

PO's assertion of complete overlap between the Petition and Texas case (POPR at 6-7) is now inaccurate. At PO's request, and to eliminate the chance of inconsistent findings, Petitioner agreed on July 2, 2020 to drop the Harris grounds in the Texas case and further stipulates that it will not pursue Ground 2 (Sutivong and Tan) in this IPR. *See* Ex. 1045. This mitigates concerns of duplicative efforts. *See Sand Revolution II, LLC v. Cont'l Intermodal Grp.–Trucking LLC*, IPR2019-01393, Paper 24, 11-12 (June 16, 2020). The significant differences between the issues in the present IPR and the Texas case (below) tip factor 4 for institution:

	Grounds	Claims	Unique Issues
Texas Case	Sutivong + Tan (+046 Tdoc)	1, 6, 10	Sutivong used for rejection of parent '530 Application (Pet. at 14-19)
IPR	Harris + Tan	1-10	Harris incorporates Tan (motivation to combine), not considered by USPTO

Neither party seeks a construction of a term construed by the district court. Contrary to PO's arguments, Petitioner's analysis of non-overlapping claims is proportionate to their length (12/42 pages = 29%; 216/542 words = 40%).

D. Factor 6: Strong Petition Outweighs Other Factors

Petitioner's strong showing on the merits more than balances out the time between trial and an FWD and the minimal overlap remaining in the proceedings. *See Apple Inc. v. Seven Networks, LLC*, IPR2020-00156, Paper 10 at 20-22.

First, the Petition showed that one must "arrange ... [sequences] so that the base station and mobile devices ... [can] unambiguously identify[] each sequence" and that "arranging the sequences in an increasing order of cyclic shifts is the most obvious choice for a POSITA." Pet. at 34-35, 27-32. The POPR at 24-31 does not address this, and mischaracterizes cases that, if read as PO does, would contravene precedent in *KSR v. Teleflex*. 550 U.S. 398 at 420-421 (a POSA "is also a person of ordinary creativity, not an automaton"). PO's other arguments are wrong: paragraph 25 of Tan discloses multiple, not one, cyclic shifts, and the Petition addresses using multiple base sequences. *Compare* POPR at 26-27 *with* Pet. at 33-35, 27-32.

Second, PO does not challenge Harris's incorporation of Tan. *See* Ex. 1004, 4:5-11. PO's attempt to evade this teaching by asserting that "Harris is not concerned with ... interferences" and is instead "concerned with increasing the

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