

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

APPLE INC.,  
Petitioner,

v.

PINN, INC.,  
Patent Owner.

---

Case IPR2021-00221  
Patent No. 10,455,066

---

**PATENT OWNER PINN, INC.'S PRELIMINARY  
RESPONSE UNDER 37 C.F.R. § 42.107**

**TABLE OF CONTENTS**

I. PRELIMINARY STATEMENT ..... 2

II. BACKGROUND ..... 6

    A. The '066 Patent ..... 6

    B. Patent Owner's Patent Infringement Action.....17

    C. Petitioner's Grounds of Challenge .....18

        1. Apple BT Headset .....19

        2. Lydon .....21

        3. Rabu .....21

        4. Kalayjian .....22

        5. Kim .....22

III. CLAIM CONSTRUCTION .....22

IV. THE DIRECTOR SHOULD EXERCISE DISRECTION UNDER 35 U.S.C. §  
314(a) AND DENY INSTITUTION OF APPLE'S FOLLOW-ON PETITION  
UNDER *GENERAL PLASTIC*. .....23

    1. Apple Previously Filed Two Petitions Directed to the Same Claims of the  
    Same Patent. ....24

|  |           |
|--|-----------|
| 2. Apple Knew of the Prior Art Asserted in the Third Petition at the Time of Filing the First Petition. ....                           | 25        |
| 3. Apple Already Had Received Patent Owner’s Preliminary Response to its First Petition at the Time of Filing its Third Petition. .... | 26        |
| 4. Apple has Known of the Prior Art Asserted in the Third Petition Since as Early as 2007.....   | 26        |
| 5. Apple Provides No Explanation for the Time Elapsed Between the Filings of its First Petition and its Third Petition. ....           | 27        |
| 6. The Board’s Resources Would Be Better Spent Elsewhere.....  | 28        |
| 7. The Final Determination Will Not be Made until 2022, Long After the Underlying District Court Proceeding is Decided. ....           | 29        |
| <b>V. THE DIRECTOR SHOULD EXERCISE DISCRETION UNDER 35 U.S.C. § 314(a) AND DENY INSTITUTION UNDER <i>FINTIV</i>. ....</b>              | <b>30</b> |
| 1. The Court Denied Apple’s Motion to Stay.....  | 31        |
| 2. The Court’s Trial Date is Set for Almost a Year Before the Board’s Projected Statutory Deadline. ....                               | 31        |
| 3. Significant Investment Has Been Made in the Parallel Proceeding by the Court and the Parties.....                                   | 33        |

4. There is Complete Overlap Between Issues Raised in the Third Petition and in the Parallel Proceeding. ....34

5. The Petitioner Here and the Defendant in the Parallel Proceeding are the Same Party. ....35

6. Other Circumstances, Including the Lack of Merit in Petitioner’s Arguments, Favor Denial of Institution.....35

**VI. THE PETITION SHOULD BE DENIED BECAUSE NO GROUND ESTABLISHES A REASONABLE LIKLIHOOD OF SUCCESS .....36**

A. None of the BT Headset, Rabu, or Lydon, Nor Any Combination Thereof Renders Obvious Key Limitations of the Challenged Claims.....37

B. The Addition of Kalayjian to the BT Headset, Rabu, and Lydon Combination Fails to Render Obvious the Challenged Claims .....44

C. The Addition of Kim to the BT Headset, Rabu, Lydon, and Kalayjian Combination Fails to Render Obvious the Challenged Claims .....45

D. Petitioner Has Failed to Show that a Person Having Ordinary Skill in the Art Would Be Motivated to Combine Petitioner’s Asserted References.....46

E. Invalidity Grounds Are Redundant .....49

**VII. THE DIRECTOR SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 325(d) BECAUSE SUBSTANTIALLY THE SAME PRIOR ART WAS PREVIOUSLY PRESENTED TO THE OFFICE. ....50**

1. Substantially the Same Art was Previously Presented to the Office .....51

2. Petitioner has Failed to Demonstrate that the Office Committed Material Error.  
56

**VIII. CONCLUSION .....57**

**TABLE OF AUTHORITIES**

**Cases**

*Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469 .....passim

*Apple Inc. v. Fintiv, Inc.*, IPR2020-00019 .....passim

*Apple Inc. v. Pinn, Inc.*, IPR2021-00220 .....25, 39

*Apple Inc. v. Pinn, Inc.*, PGR2020-00066 .....2, 25, 26, 28

*General Plastic Industrial Co., Ltd. v. Canon Kubushiki Kaisha*, IPR2016-01357  
.....passim

*NHK Spring Co., Ltd. v. Intri-Plex Technologies, Inc.*, IPR2018-00752 .....4, 30

# 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.