

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

PINN, INC.,  
Patent Owner.

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IPR2020-00999 (Patent 9,807,491 B2)  
PGR2020-00066 (Patent 10,455,066 B2)  
PGR2020-00073 (Patent 10,609,198 B2)<sup>1</sup>

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Before JAMESON LEE, KARL D. EASTHOM, and  
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

ORDER

Authorizing Reply and Sur-reply  
37 C.F.R. §§ 42.5(a), 42.20(d), 42.108(c), 42.208(c)

On October 2, 2020, a conference call was held among counsel for  
Apple Inc. (Petitioner), counsel for Pinn, Inc. (Patent Owner), and Judges

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<sup>1</sup> This order will be entered in each case. The parties are not authorized to  
use this caption.

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Lee, Easthom, and Pettigrew. This order memorializes the rulings made on the call. The purpose of the call was to address Petitioner's request for authorization to file a reply to Patent Owner's Preliminary Response in each of these proceedings. *See* Ex. 3001. Petitioner seeks leave to address the following issues: (1) Petitioner's stipulation in the parallel district court proceeding regarding asserted invalidity grounds, (2) discretionary denial pursuant to 35 U.S.C. §§ 314(a) and 324(a), (3) discretionary denial pursuant to 35 U.S.C. § 325(d), and (4) the construction of the claim term "wireless pairing" and the prior art's disclosure of that limitation. *See id.* Patent Owner opposes Petitioner's request. *See id.*

The first two issues relate to the Board's discretion to deny institution of *inter partes* review and post grant review under 35 U.S.C. §§ 314(a) and 324(a), respectively, in view of a parallel district court proceeding. Although both the Petition and Preliminary Response in each case analyzed the factors in *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), good cause exists for additional briefing on the *Fintiv* factors, at least because some documents may not yet have been served or filed in the district court case when the parties submitted their earlier papers to the Board. It also will be beneficial for the parties to clarify the circumstances regarding Petitioner's stipulation regarding asserted invalidity grounds in district court.

Regarding the third issue, good cause exists for additional briefing to address Patent Owner's argument pursuant to 35 U.S.C. § 325(d) that prior art references that were before the Office during prosecution of the patents at issue are substantially the same as references asserted in the Petitions, none

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of which were previously before the Office. Petitioner should be given an opportunity to explain why the references are not substantially the same.

Good cause also exists for additional briefing to address the claim construction and alleged prior art disclosure of “wireless pairing” in view of the Technical Special Master Report and Recommendation on Claim Construction, entered in the district court proceeding after the filing of two of the Petitions in these cases. *See Ex. 2006.*

In view of the particular circumstances of these cases, we authorize Petitioner to file in each case a reply to Patent Owner’s Preliminary Response to address the issues identified in Petitioner’s request. Each of Petitioner’s replies is limited to 15 pages and is to be filed in each case no later than October 14, 2020. Patent Owner is authorized to file a sur-reply in each case, limited to 15 pages, no later than October 26, 2020.

The parties are authorized to file with their replies and sur-replies additional evidence limited to documents filed or served in the parallel district court proceeding and documents from the prosecution histories of the patents at issue. No other additional evidence may be submitted.

It is so ORDERED.

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