

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PINN, INC.,
Patent Owner.

PGR2020-00066
Patent 10,455,066 B2

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

PETTIGREW, *Administrative Patent Judge*.

DECISION
Denying Institution of Post-Grant Review
35 U.S.C. § 324

I. INTRODUCTION

Petitioner, Apple Inc., filed a Petition for post-grant review of claims 1, 4, 6–10, 14, 21, 26, 28, 30, 34, 36, and 38 of U.S. Patent No. 10,455,066 B2 (Ex. 1001, “the ’066 patent”). Paper 2 (“Pet.”). Patent Owner, Pinn, Inc., filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Pursuant to our authorization for supplemental briefing, Petitioner filed a

Reply to Patent Owner’s Preliminary Response, and Patent Owner filed a Sur-reply. Paper 9 (“Pet. Reply”); Paper 10 (“PO Sur-reply”). Following briefing, in response to a joint request from the parties, we authorized the parties to file several documents from a concurrent district court proceeding involving the ’066 patent. *See* Ex. 1060, 3:3–7:21, 23:11–24:6, 24:14–25:22, 27:22–29:1, 30:5–31:9 (transcript of telephone conference, Nov. 24, 2020);¹ Exs. 1055–1059, 2018; *see also* Ex. 2019; Paper 14.²

We have authority to determine whether to institute a post-grant review. 35 U.S.C. § 324(a) (2018); 37 C.F.R. § 42.4(a) (2020). Having considered the parties’ submissions, and for the reasons explained below, we exercise discretion under 35 U.S.C. § 324(a) to deny institution of post-grant review.

II. BACKGROUND

A. Real Parties-in-Interest

Petitioner identifies itself as a real party-in-interest. Pet. 93. Patent Owner identifies itself as a real party-in-interest. Paper 6, 2 (Patent Owner’s Mandatory Notices).

B. Related Matters

The parties identify the following pending district court proceeding related to the ’066 patent: *Pinn, Inc. v. Apple Inc.*, No. 8:19-cv-1805 (C.D. Cal.). Pet. 93; Paper 6, 2. The parties also identify two related patents that

¹ Citations are to the numbered pages of the transcript (upper right corner) rather than the numbered exhibit pages (bottom center).

² Among other things, we authorized the parties to submit a transcript of a district court hearing and a joint submission identifying portions of interest. Ex. 1060, 27:22–29:1. The transcript, originally filed as Paper 13, has been reentered in the record as Exhibit 2019, and Paper 13 has been expunged. Paper 14 contains the parties’ joint submission of citations to the transcript.

are involved in the same district court proceeding and are the subject of other petitions: U.S. Patent No. 9,807,491 B2 (challenged in IPR2020-00999) and U.S. Patent No. 10,609,198 B2 (challenged in PGR2020-00073). Pet. 94; Paper 6, 2.

C. Overview of the '066 Patent

The '066 patent describes a personal wireless media station that includes a base station and a wireless earbud. Ex. 1001, 5:25–26. Figure 4A of the '066 patent is reproduced below:

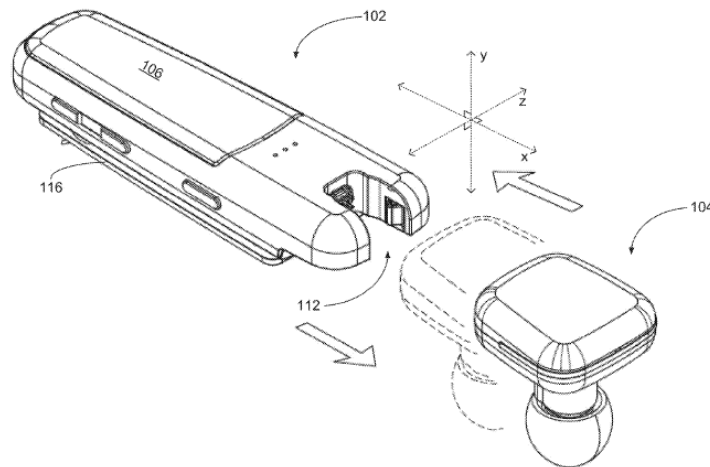


FIG. 4A

Figure 4A above illustrates base station 102 that provides docking bay 112 for receiving earbud 104. *Id.* at 6:1–10. Earbud 104 can be docked to and undocked from base station 102. *Id.*

The personal wireless media station may be wirelessly connected to a user's primary device (e.g., a smartphone) to facilitate the user's access to content on the primary device, such as music. *Id.* at 4:61–5:3. In some embodiments, the base station and wireless earbud may be separately and individually paired with the primary device for communication. *Id.* at 20:5–7.

When the earbud is undocked from the base station, the earbud can play back sound received from the primary device or base station. *Id.* at 9:6–12. When the earbud is docked to the base station, the earbud battery is charged, and some or all components of the earbud may be turned off or disabled. *Id.* at 22:28–30.

D. Illustrative Claim

Challenged claims 1, 10, 30, and 34 are independent. Challenged claims 4 and 6–9 depend directly from claim 1, challenged claims 14, 21, 26, and 28 depend directly from claim 10, and challenged claims 36 and 38 depend directly from claim 34. Claim 1 is illustrative of the claimed subject matter:

1. A mobile system comprising:

a base station comprising a connection hole, a user input button, at least one processor, at least one memory, and circuitry; and
a wireless earbud configured for plugging into the connection hole of the base station to form an integrated body with the base station,

wherein the system is capable of wirelessly pairing with a smartphone and for the wireless earbud to receive audio data originated from the smartphone,

wherein, in response to pressing of the user input button, the at least one processor is configured to execute computer program instructions stored in the at least one memory to initiate processing for the wireless pairing with the smartphone such that the wireless earbud receives audio data originated from the smartphone and plays audio using the audio data from the smartphone,

wherein, in response to plugging the wireless earbud into the connection hole, the at least one processor is configured to execute computer program instructions stored in the at least one memory to initiate charging of a battery of the wireless earbud,

wherein, when the wireless earbud is plugged into the connection hole of the base station, the wireless earbud is configured to electrically connect with the circuitry of the base station and further configured to performing wired data communication with the base station.

Ex. 1001, 33:17–44.

E. Asserted Grounds of Unpatentability

Petitioner asserts that the challenged claims are unpatentable based on the following grounds (Pet. 2–3):

Claim(s) Challenged	35 U.S.C. §	References/Basis
9, 10, 30, 36	112(b)	Indefiniteness
1, 4, 6, 8	103	Hankey, ³ Rabu, ⁴ Sanford ⁵
9, 10, 14, 26, 28, 30, 34, 36	103	Hankey, Rabu, Sanford, Kalayjian ⁶
1, 4, 6, 8	103	Hankey, Rabu, Sanford, Lydon ⁷
9, 10, 14, 21, 26, 28, 30, 34, 36	103	Hankey, Rabu, Sanford, Lydon, Kalayjian
1, 4, 6–8	103	Hankey, Rabu, Sanford, Dua ⁸
1, 4, 6–8	103	Hankey, Rabu, Sanford, Lydon, Dua
9, 10, 14, 21, 26, 28, 30, 34, 36	103	Hankey, Rabu, Sanford, Dua, Kalayjian
9, 10, 14, 21, 26, 28, 30, 34, 36	103	Hankey, Rabu, Sanford, Lydon, Dua, Kalayjian
21	103	Hankey, Rabu, Sanford, Kalayjian, Burnett ⁹
21	103	Hankey, Rabu, Sanford, Lydon, Kalayjian, Burnett

³ U.S. Patent No. 8,401,219 B2, issued Mar. 19, 2013 (Ex. 1004).

⁴ U.S. Patent No. 8,086,281 B2, issued Dec. 27, 2011 (Ex. 1005).

⁵ U.S. Patent No. 8,270,915 B2, issued Sept. 18, 2012 (Ex. 1006).

⁶ U.S. Patent Application Publication No. US 2008/0125040 A1, published May 29, 2008 (Ex. 1008).

⁷ U.S. Patent No. 8,078,787 B2, issued Dec. 13, 2011 (Ex. 1007).

⁸ U.S. Patent No. 8,548,381 B2, issued Oct. 1, 2013 (Ex. 1016).

⁹ U.S. Patent No. 8,838,184 B2, issued Sept. 16, 2014 (Ex. 1012).

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