

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PINN, INC.,
Patent Owner.

PGR2020-00073
Patent 10,609,198 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, 3, 5, 6, 9, 12, 15, 17, 19, 21, 25, 27, and 29 of U.S. Patent No. 10,609,198 B2 (Ex. 1001, “the ’198 patent”). Paper 2 (“Pet.”). Patent Owner, Pinn, Inc., filed a Preliminary Response. Paper 6 (“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 8 (“Pet. Reply”); Paper 9 (“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 ’198 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 13.²

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. 92. Patent Owner identifies itself as a real party-in-interest. Paper 4, 2 (Patent Owner’s Mandatory Notices).

B. Related Matters

The parties identify the following pending district court proceeding related to the ’198 patent: *Pinn, Inc. v. Apple Inc.*, No. 8:19-cv-1805 (C.D. Cal.). Pet. 92; Paper 4, 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 12, has been reentered in the record as Exhibit 2019, and Paper 12 has been expunged. Paper 13 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 (“the ’491 patent,” challenged in IPR2020-00999) and U.S. Patent No. 10,455,066 B2 (challenged in PGR2020-00066). Pet. 92; Paper 4, 2.

C. Overview of the ’198 Patent

The ’198 patent describes a personal wireless media station that includes a main body and a wireless earbud. Ex. 1001, 5:2–5. Figure 1 of the ’198 patent is reproduced below:

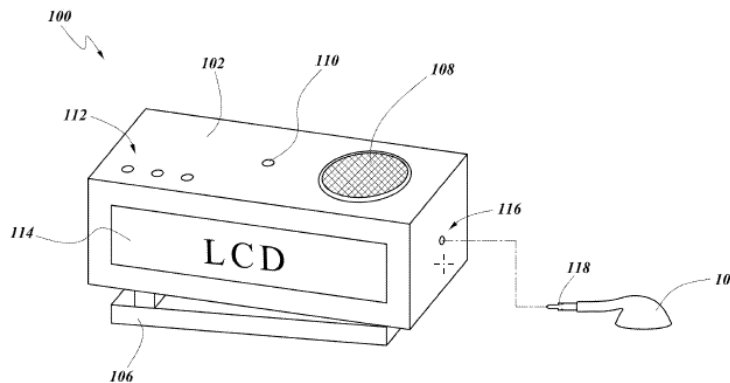


FIG. 1

Figure 1 above illustrates personal wireless media station 100 comprising main body 102 and earbud 104. *Id.* Wireless earbud 104 includes earbud connector 118 for mating with main body connector 116 so that wireless earbud 104 and main body 102 form a single integrated body. *Id.* at 5:26–30, 5:35–38.

The wireless earbud may be wirelessly paired with a smartphone to receive and play back audio data from the smartphone. *Id.* at 1:34–37. A user can initiate pairing between the wireless earbud and the smartphone by pressing a button on the main body. *Id.* at 11:29–33. The main body can charge the wireless earbud when the earbud is inserted into the main body. *Id.* at 8:45–47.

D. Illustrative Claim

Challenged claims 1, 21, and 25 are independent. Challenged claims 3, 5, 6, 9, 12, 15, 17, and 19 depend directly from claim 1, and challenged claims 27 and 29 depend directly from claim 25. Claim 1 is illustrative of the claimed subject matter:

1. A mobile system comprising:

a mobile 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 mobile base station to form an integrated body with the mobile base station,

wherein, while the wireless earbud is plugged in the connection hole of the mobile base station, the wireless earbud is configured to electrically connect with the circuitry of the mobile base station and further configured to perform wired data communication with the mobile base station,

wherein, while the wireless earbud is plugged in the connection hole of the mobile base station, the circuitry of the mobile base station is configured to obtain characteristics of the wireless earbud and send the characteristics to the at least one processor,

wherein, while the wireless earbud is plugged in the connection hole of the mobile base station, 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 the wireless earbud has wireless communication capability for wirelessly pairing with a smartphone to perform data communication with the smartphone,

wherein the mobile system is configured to generate sound when a mobile application installed on the smartphone is searching for the mobile system while the wireless earbud is paired with the smartphone,

wherein, in response to pressing of the user input button of the mobile base station, 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,

wherein the wireless earbud is not capable of wirelessly sending data to the mobile base station.

Ex. 1001, 15:12–48.

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
1, 21, 27	112(b)	Indefiniteness
1, 3, 5, 9, 15, 19, 21, 25, 27	103	Hankey, ³ Rabu, ⁴ Sanford, ⁵ Kalayjian ⁶
1, 3, 5, 9, 12, 15, 17, 19, 21, 25, 27	103	Hankey, Rabu, Sanford, Kalayjian, Lydon ⁷
1, 3, 5, 6, 9, 12, 15, 17, 19, 21, 25, 27	103	Hankey, Rabu, Sanford, Kalayjian, Dua ⁸
1, 3, 5, 6, 9, 12, 15, 17, 19, 21, 25, 27	103	Hankey, Rabu, Sanford, Kalayjian, Lydon, Dua
12	103	Hankey, Rabu, Sanford, Kalayjian, Burnett ⁹
12	103	Hankey, Rabu, Sanford, Kalayjian, Lydon, Burnett
12	103	Hankey, Rabu, Sanford, Kalayjian, Dua, Burnett
12	103	Hankey, Rabu, Sanford, Kalayjian, Lydon, Dua, 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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