

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SPEIR TECHNOLOGIES LTD.,
Patent Owner

IPR2023-00151
Patent 7,110,779

**PETITIONER'S REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

LIST OF EXHIBITS

APPLE-1001	U.S. Patent 7,110,779 to Thomas Jay Billhartz, <i>et al.</i> (“the ’779 Patent”)
APPLE-1002	Excerpts from the Prosecution History of the ’779 Patent (“the Prosecution History”)
APPLE-1003	Declaration of Dr. Zhi Ding
APPLE-1004	Curriculum Vitae of Dr. Zhi Ding
APPLE-1005	U.S. Patent 6,453,168 to McCrady (“McCrady”)
APPLE-1006	U.S. Patent 7,511,604 to Raphaeli, <i>et al.</i> (“Raphaeli”)
APPLE-1007	U.S. Patent 6,070,079 to Kuwahara (“Kuwahara”)
APPLE-1008	WO2003098528 to Raphaeli, <i>et al.</i> (“Raphaeli”)
APPLE-1009	U.S. Patent 7,058,414 to Rofheart (“Rofheart”)
APPLE-1010	Hargrave’s Communications Dictionary, 2001 (excerpts)
APPLE-1011	The Authoritative Dictionary of IEEE Standards Terms, 2000 (excerpts)
APPLE-1012	Federal Court Management Statistics June 2022 published by the Administrative Office of the U.S. Courts, retrieved from https://www.uscourts.gov/sites/default/files/fcms_na_distprofile0630.2022_0.pdf on August 19, 2022
APPLE-1013	Scheduling Order, <i>Speir Technologies Ltd. v. Apple Inc.</i> , Case 6:22-cv-00077-ADA (WDTX)

APPLE-1014	Complaint for Patent Infringement Against Apple Inc., <i>Speir Technologies Ltd. v. Apple Inc.</i> , Case 6:22-cv-00077-ADA (WDTX)
APPLE-1015	Amended Complaint for Patent Infringement Against Apple Inc., <i>Speir Technologies Ltd. v. Apple Inc.</i> , Case 6:22-cv-00077-ADA (WDTX)
APPLE-1016	Preliminary Disclosure of Asserted Claims and Infringement Contentions to Defendant Apple Inc., <i>Speir Technologies Ltd. v. Apple Inc.</i> , Case 6:22-cv-00077-ADA (WDTX)
APPLE-1017	Apple’s Opening Claim Construction Brief, <i>Speir Technologies Ltd. v. Apple Inc.</i> , Case 6:22-cv-00077-ADA (WDTX)
APPLE-1018	Speir’s Responsive Claim Construction Brief, <i>Speir Technologies Ltd. v. Apple Inc.</i> , Case 6:22-cv-00077-ADA (WDTX)
APPLE-1019	U.S. Patent 6,181,944 to Uebayashi <i>et al.</i> (“Uebayashi”)
APPLE-1020	U.S. Patent 5,945,948 to Buford <i>et al.</i> (“Buford”)
APPLE-1021	U.S. Patent 5,929,806 to Birchler <i>et al.</i> (“Birchler”)
APPLE-1022	U.S. Patent 5,365,516 to Jandrell (“Jandrell”)
APPLE-1023	U.S. Patent 6,760,882 to Gesbert <i>et al.</i> (“Gesbert”)
APPLE-1024	U.S. Patent App. Pub. 2006/0234725 to Litwin (“Litwin”)
APPLE-1025	U.S. Patent App. Pub. 2002/0136226 to Christoffel <i>et al.</i> (“Christoffel”)
APPLE-1026	C. Eisenhart, “Realistic Evaluation of the Precision and Accuracy of Instrument Calibration Systems,” JOURNAL OF RESEARCH of the National Bureau of Standards-C.

Engineering and Instrumentation, Vol. 67C, No.2, April-June 1963 (“Eisenhart”). Retrieved from https://nvlpubs.nist.gov/nistpubs/jres/67C/jresv67Cn2p161_A1b.pdf on September 6, 2022.

- APPLE-1027 U.S. Patent Publication 2003/0013146 to Werb (“Werb”)
- APPLE-1028 U.S. Patent Publication 2005/0130634 to Godfrey (“Godfrey”)
- APPLE-1029 U.S. Provisional No. 60/515,701 (“Godfrey-Provisional”)
- APPLE-1030 ANSI/IEEE Std 802.11, *Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) Specifications* (Aug. 20, 1999) (“IEEE 802.11”)
- APPLE-1031 Order Resetting Markman Hearing, *Speir Technologies Ltd. v. Apple Inc.*, Case 6:22-cv-00077-ADA (WDTX)
- APPLE-1032 L. van der Perre, S. Thoen, P. Vandenameele, B. Gyselinckx and M. Engels, “Adaptive loading strategy for a high speed OFDM-based WLAN,” IEEE GLOBECOM 1998 (Cat. NO. 98CH36250), 1998, pp. 1936-1940.

On March 28, 2023, the Board authorized this Reply to Patent Owner's Preliminary Response on the *Fintiv* factors. As detailed below, ***all*** of the *Fintiv* factors counsel towards the same result—institution.

A. The District Court Litigation Has Been Transferred and Stayed

On December 15, 2022, the district court for the Western District of Texas transferred the co-pending litigation between the parties to the district court for the Northern District of California (“District Court”; Case No. 5:23-cv-00095). On March 30, 2023, the District Court granted Petitioner's motion to stay the litigation pending the outcome of this *inter partes* review. Petitioner will provide copies of these two orders on request from the Board.

B. Now That the District Court Litigation Is Stayed, Every *Fintiv* Factor Conclusively Favors Institution

The Petition explained that each of the *Fintiv* factors was either neutral or in favor of institution. *See* Pet., 79-81. Patent Owner is unable to rebut the Petition on these points. For example, Patent Owner did not account for the median time to trial in either the original or transferee forum. *See* POPR, 6-7. Nor did Patent Owner account for Petitioner's contingent stipulation to avoid identical prior art grounds in District Court. *See* POPR, 8-9; Pet., 81.

Regardless, now that the District Court litigation is stayed, there is no question that ***all*** of the *Fintiv* factors favor institution.

Factors 1 and 2—“A district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB March 20, 2020) (precedential). “Accordingly, consideration of the first *Fintiv* factor weighs strongly against exercising discretion to deny institution.” *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15 at 9 (PTAB Oct. 21, 2020) (precedential). Likewise, for the same reasons, “consideration of the second *Fintiv* factor also does not weigh in favor of exercising discretion to deny institution.” *Id.*

Factor 3—“If, at the time of the institution decision, the District Court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.” *Fintiv*, 9-10. So is the case here. Moreover, as the District Court acknowledged, although contentions have been exchanged and briefs have been filed, “these are generally events that happen early in the life of a case.” *Regents of Univ. of Minnesota v. LSI Corp.*, 2018 WL 2183274, at *2 (N.D. Cal. May 11, 2018). Like the first and second factors, the third *Fintiv* factor favors institution.

Factor 4—“[D]ue to the stay of the parallel District Court proceeding, the Board will likely address patentability issues prior to the District Court reaching invalidity issues at trial, thereby obviating concerns of inefficiency and conflicting decisions.” *Snap*, 15-16. Thus, the fourth *Fintiv* factor favors institution.

Factor 5—This factor favors institution because the Board will reach a final written decision before any jury trial. As a result, instituting this *inter partes* review will narrow the issues before the District Court, either by canceling the '779 patent's claims or estopping Petitioner under 35 U.S.C. § 315(e)(2).

Factor 6—The merits should decide this case, and the Petition's merits are strong. This sixth *Fintiv* factor, and all the factors as a whole, support institution.

Respectfully submitted,

Date: April 7, 2023

/Kenneth Wayne Darby Jr./
W. Karl Renner, Reg. No. 41,265
David Holt, Reg. No. 65,161
Kenneth W. Darby Jr., Reg. No. 65,068
John-Paul Fryckman, Reg. No. 62,880
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945
Attorney for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on April 7, 2023, a complete and entire copy of this Petitioner's Reply to Patent Owner's Preliminary Response was provided by email to Patent Owner by serving the email correspondence addresses of record as follows:

Brett Cooper, Reg. No. 55,085
BC Law Group, P.C.
200 Madison Avenue, 24th Floor
New York, NY 10016
bcooper@bc-lawgroup.com
Speir_Counsel@b-clg.com

Robert A. Auchter, Reg. No. 38,069
Auchter PLLC
1629 K Street, NW, Suite 300
Washington, DC 20006
robert@auchterlaw.com

/Crena Pacheco/

Crena Pacheco
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
pacheco@fr.com