

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

THL HOLDING COMPANY, LLC,
Patent Owner.

U.S. Patent No. 11,265,680

IPR Case No.: IPR2024-00398

REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. § 42.71(d)

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Pursuant to 37 C.F.R. § 42.71(d), Patent Owner THL Holding Company, LLC (“Patent Owner”) requests rehearing of the Board’s Decision Granting Institution of Inter Partes Review (“IPR”) under 35 U.S.C. § 314. (“DI,” Paper 6.) In view of its statutory disclaimer disclaiming all claims deemed likely unpatentable in the DI, Patent Owner respectfully requests rehearing pursuant to 37 C.F.R. § 42.71(d), and denial of the IPRs pursuant to 35 U.S.C. § 314(a).

I. Background

Apple Inc. (“Petitioner”) requested review of claims 1-12 and 15-20 of U.S. Patent No. 11,265,680 (“the ’680 Patent”). (Paper 1, p. 1.) Petitioner did not challenge claims 13-14.

The Board determined that Petitioner had demonstrated a reasonable likelihood that it would prevail in its challenge to at least independent claim 10 as unpatentable based on obviousness over the combination of Kalliola, Vauclair, and Kalayjian, which was sufficient for the Board’s institution under 35 U.S.C. § 314(a). (DI, Paper 6, p. 43.)

With respect to independent claim 1, however, and “to provide guidance to the parties and potentially streamline issues for trial,” the Board determined that Petitioner had failed to demonstrate that the combination of prior art rendered obvious the claim limitation requiring a “pairing signal generated by the graphical user interface.” (DI, Paper 6, pp. 44-47.) The Board found the Petition similarly

deficient with respect to dependent claims 2, 3 and 6, which depend directly from claim 1. (*Id.* at p. 47.)

While the Board did not directly address the merits of the Petition with respect to dependent claims 4-5 and 7-9, those claims too depend from claim 1. The Petition relies on the same prior art reference (Vauclair), and the same analysis, for the “pairing signal generated by the graphical user interface” limitation of claim 1. (Paper 1, pp. 54-55, 73-77.) Thus, for the same reasons the Board determined the Petition failed to establish that claims 1, 2, 3 and 6 were unpatentable, the Petition also failed to establish that dependent claims 4-5 and 7-9 were unpatentable.

II. Patent Owner’s Disclaimer Following the DI

Following the Board’s guidance in the DI, and pursuant to 37 C.F.R. § 42.107(e), §1.321(a), and 35 U.S.C. § 253(a), the Patent Owner disclaimed and dedicated to the public claims 10-12 and 15-20 of the ‘680 Patent (the “Disclaimer”). (Ex. 2001, August 7, 2024 Disclaimer and Receipt.) Claims disclaimed under § 253(a) are treated as though they never existed. *See Vectra Fitness, Inc. v. TWNK Corp.*, 162 F.3d 1379, 1383 (Fed. Cir. 1998) (“This court has interpreted the term ‘considered as part of the original patent’ in section 253 to mean that the patent is treated as though the disclaimed claims never existed.”); *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996) (“A statutory disclaimer under

35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent.”)

The Disclaimer leaves intact in the ‘680 Patent (i) claims 1-9, which the DI indicated were not unpatentable for the reasons explained above, and (ii) claims 13-14, which Petitioner did not challenge.

III. The Board Should Consider the Disclaimer and Deny Institution

Good cause exists for the Board to consider the Patent Owner’s Disclaimer (Ex. 2001) filed following, and in view of, the Board’s guidance in the DI. *See Huawei Device Co., Ltd. v. Optis Cellular Tech., LLC*, Case IPR2018-00816, slip op. at 4 (PTAB Jan. 8, 2019) (Paper 19) (precedential) (“a party may argue ‘good cause’ exists in the rehearing itself”). Pursuant to 37 C.F.R. § 42.107(e), “[n]o inter partes review will be instituted based on disclaimed claims.” By disclaiming all claims the Board determined in the DI were likely unpatentable, Patent Owner has heeded the Board’s guidance and thereby streamlined issues in the parallel district court action from which this IPR proceeding arose.

Because no claims currently remain in the ‘680 Patent for which Petitioner has demonstrated a reasonable likelihood that it will prevail in its IPR challenge, the Board should deny institution. *See General Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential, denying institution following disclaimer); *Daiichi Sankyo, Inc. et al. v. Seagen Inc.*, PGR2021-00030,

Paper 31 (PTAB July 15, 2022) (granting request for rehearing and denying institution based in part on disclaimer).

While “[t]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion,” *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016), the statutory “threshold” for institution of an IPR requires the likely invalidity of “at least 1 of the claims challenged in the petition.”

THRESHOLD.—

The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

35 U.S.C. § 314(a).

Here, the Patent Owner has disclaimed the claims of the ‘680 Patent the Board determined were likely unpatentable in the DI. And the Petitioner “may not submit new evidence or argument in reply that it could have presented earlier, *e.g.* to make out a prima facie case of unpatentability.” U.S. Patent Trial and Appeal Board, Consolidated Trial Practice Guide 73 (Nov. 2019).

Continuing with the IPR would unnecessarily consume the resources of the Patent Owner, the Petitioner and the Board, and unnecessarily delay the progress

of the parallel district court action, which is presently stayed in view of the IPR. See 35 U.S.C. § 316(b) (requiring the Board to consider “the efficient administration of the Office, and the ability of the Office to timely complete proceedings”); *see also* Consolidated Trial Practice Guide (“CTPG”) at 5.

For these reasons, Patent Owner requests rehearing of the DI in view of the Disclaimer pursuant to 37 C.F.R. § 42.71(d), and denial of the Petition for IPR pursuant to 35 U.S.C. § 314(a).

Dated: August 8, 2024

Respectfully submitted,

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Certificate of Service

The undersigned hereby certifies that on August 8, 2024, a complete and entire copy of REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. § 42.71(d), was served via electronic mail to the attorneys listed below:

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