UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

S.M.R INNOVATIONS LTD and Y.M.R TECH LTD
Patent Owners

Inter Partes Review Case No. IPR2024-01049
U.S. Patent No. 8,711,866

REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE RE *FINTIV* IN LIGHT OF TRANSFER

On Nov. 14, 2024, the original district court (W.D. Tex.) granted transfer to the Northern District of California. Ex. 1047. On Dec. 9, 2024, the transferee court scheduled an initial case management conference for April 16, 2024. Accordingly, there is no trial date and there will be no schedule until months after this Board rules on institution (by Jan. 30, 2025). Given the changed facts, the *Fintiv* arguments advanced in Patent Owner's Preliminary Response ("POPR") no longer apply.

The POPR argued that discretionary denial is proper because the original trial date would precede the final written decision by two months. Paper 6, 10-11. This is no longer true. Analyzing similar facts where a parallel case was transferred from Texas to N.D. Cal, the Board held the fact "that no trial date has been set weighs significantly against exercising [] discretion to deny institution of the proceeding." *Google v. Uniloc 2017*, IPR2020-00441, Paper 13 at 33-36 (Jul 17, 2020). The POPR also highlighted resources expended by the parties and the expectation that the Texas court will have conducted a claim construction hearing before institution. Paper 6, 11-12. In fact, no claim construction hearing was conducted before transfer. In *Google*, the original district court case had progressed much further—a claim construction order had *issued* and fact discovery was *closed*. *Google*, Paper 13 at 36. Nonetheless, the Board declined to exercise its discretion, finding all other *Fintiv* factors "small in comparison" to the "various impacts of transferring [from Texas] to [N.D. Cal.]." *Id*. at 38. Here too, transfer is dispositive of the *Fintiv* analysis.

Respectfully submitted,

Dated: December 20, 2024

BY: */s/ Paul R. Hart*
Paul R. Hart, Reg. No. 59,646

COUNSEL FOR PETITIONER

APPENDIX OF EXHIBITS

Exhibit 1001	INTENTIONALLY LEFT BLANK
Exhibit 1002	INTENTIONALLY LEFT BLANK
Exhibit 1003	Declaration of Dr. Sayfe Kiaei ("*Dec.*")
Exhibit 1004	U.S. Patent App. Pub. No. 2002/0068600 to Chihara et al. ("*Chihara*")
Exhibit 1005	Specification of the Bluetooth System Version 1.1. February 22, 2001. ("*BluetoothSpec*")
Exhibit 1006	U.S. Patent No. 6,701,162 to Everett ("*Everett*")
Exhibit 1007	U.S. Patent App. Pub. No. 2002/0062406 to Chang et al. ("*Chang*")
Exhibit 1008	U.S. Patent No. 7,580,005 to Palin ("*Palin*")
Exhibit 1009	U.S. Patent No. 6,307,921 to Engelke et al. ("*Engelke*")
Exhibit 1010	U.S. Patent App. Pub. No. 2002/0178279 to Janik et al. ("*Janik*")
Exhibit 1011	International Publication No. WO 01/74024 to Hartmaier et al. ("*Hartmaier*")
Exhibit 1012	European Patent Application No. EP1132847 to Han et al. ("*Han*")
Exhibit 1013	U.S. Patent App. Pub. 2002/0102998 to Lin ("*Lin*")
Exhibit 1014	U.S. Patent No. 7,580,005 to Palin ("*Palin*")
Exhibit 1015	U.S. Patent App. Pub. No. 2003/0110234 to Egli et al. ("*Egli*")
Exhibit 1016	U.S. Patent No. 6,910,068 to Zintel et al. ("*Zintel*")
Exhibit 1017	INTENTIONALLY LEFT BLANK
Exhibit 1018	U.S. Patent No. 6,901,273 to Lutnaes ("*Lutnaes*")
Exhibit 1019	U.S. Patent App. Pub. No. 2002/0141548 to Boda ("*Boda*")
Exhibit 1020	International Publication No. WO 02/19152 to Bergman et al. ("*Bergman*")
Exhibit 1021	Matthew S. Gast. *802.11 Wireless Networks The Definitive Guide*. O'Reilly & Associates. April 2002. ("*Gast*")
Exhibit 1022	U.S. Patent No. 6,925,108 to Miller et al. ("*Miller*")
Exhibit 1023	Jim Geier. *Wireless LANs*. 2nd Edition. Sams Publishing. July 2001. ("*Geier*")
Exhibit 1024	U.S. Patent No. 6,212,282 to Mershon ("*Mershon*")
Exhibit 1025	U.S. Patent No. 6,526,287 to Lee ("*Lee*")
Exhibit 1026	U.S. Patent App. Pub. No. 2002/0101367 to Geiger et al. ("*Geiger*")
Exhibit 1027	U.S. Patent App. Pub. No. 2002/0186770 to Jawerth et al. ("*Jawerth*")
Exhibit 1028	U.S. Patent App. Pub. No. 2003/0013438 to Darby ("*Darby*")

Exhibit 1029	U.S. Patent App. Pub. No. 2003/0139966 to Sirota et al. ("*Sirota*")
Exhibit 1030	U.S. Patent No. 5,781,192 to Kodimer ("*Kodimer*")
Exhibit 1031	U.S. Patent No. 6,297,737 to Irvin ("*Irvin*")
Exhibit 1032	U.S. Patent No. 6,309,305 to Kraft ("*Kraft*")
Exhibit 1033	U.S. Patent No. 7,676,372 to Oba ("*Oba*")
Exhibit 1034	U.S. Patent App. Pub. No. 2002/0035699 to Crosbie ("*Crosbie*")
Exhibit 1035	U.S. Patent App. Pub. No. 2003/0065803 to Heuvelman ("*Heuvelman*")
Exhibit 1036	U.S. Patent App. Pub. No. 2004/0198294 to Hagin-Metzer ("*Hagin-Metzer*")
Exhibit 1037	International Publication No. WO 00/036867 to Lilja et al. ("*Lilja*")
Exhibit 1038	U.S. Patent No. 8,711,866 ("*'866 Patent*")
Exhibit 1039	Prosecution History for the '866 Patent ("*'866 FH*")
Exhibit 1040	*S.M.R Innovations Ltd. v. Apple Inc.*, 6:23-cv-00479, D.I. 50 ("[Proposed] Agreed Scheduling Order") (W.D.Tex. Jun. 7, 2024)
Exhibit 1041	Affidavit of Nathaniel E. Frank-White concerning *BluetoothSpec*
Exhibit 1042	07-01-2023 Complaint, Ex. H
Exhibit 1043	07-01-2023 Complaint, Ex. G
Exhibit 1044	02-06-2024 '990 Patent Infringement Allegations Update
Exhibit 1045	02-06-2024 '866 Patent Infringement Allegations Update
Exhibit 1046	05-17-2024 Preliminary Infringement Contentions
Exhibit 1047	*S.M.R Innovations Ltd. v. Apple Inc.*, 6:23-cv-00479, D.I. 80 ("Amended Order Granting Motion to Transfer Venue") (W.D.Tex. Nov. 14, 2024)

CERTIFICATE OF SERVICE ON PATENT OWNER
UNDER 37 C.F.R. § 42.105

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105, the undersigned certifies that on December 20, 2024, a true and correct copy of the foregoing Reply to Patent Owner's Preliminary Response re *Fintiv* in Light of Transfer and supporting exhibits were served electronically on counsel for Patent Owner at the following address:

Cortney S. Alexander (cortneyalexander@kentrisley.com)
Olivia Murbutt (oliviamarbutt@kentrisley.com)

BY: */s/ Paul R. Hart*
Paul R. Hart, Reg. No. 59,646

COUNSEL FOR PETITIONER