

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2020-00407 (Patent 6,748,317 B2)
IPR2020-00408 (Patent 6,430,498 B1)
IPR2020-00409 (Patent 6,580,999 B2)¹

Before LYNNE E. PETTIGREW, MINN CHUNG, JOHN A. HUDALLA,
JASON W. MELVIN, and FREDERICK C. LANEY, *Administrative Patent
Judges.*²

PETTIGREW, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This order will be entered in each case. The parties are not authorized to use this caption.

² This is not an order from an expanded panel of the Board. Administrative Patent Judges comprising the three-judge panels in all three proceedings are listed.

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On July 17, 2020, a conference call was held among counsel for Apple Inc. (Petitioner), counsel for Maxell, Ltd. (Patent Owner), and Judges Pettigrew, Chung, Hudalla, Melvin, and Laney. The purpose of the call was to address Petitioner's request for authorization to file a supplemental brief in each of these proceedings to address one of the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*"). A court reporter engaged by Petitioner was on the call; Petitioner has filed the reporter's transcript as Exhibit 1057.³

Fintiv provides factors the Board considers when determining whether to exercise its discretion to deny institution under 35 U.S.C. § 314(a) when there is a related, parallel district court action involving the challenged patent. *Fintiv*, Paper 11 at 5–16. After Patent Owner filed its Preliminary Response to the Petition, and pursuant to our authorization, the parties filed supplemental briefing and supporting documentary evidence addressing the *Fintiv* factors. See Paper 7 (order authorizing Reply and Sur-reply); Paper 8 (Petitioner's Preliminary Reply); Paper 10 (Patent Owner's Preliminary Sur-reply).

Petitioner now seeks to file an additional supplemental brief to address how a recent motion for summary judgment filed by Maxell in the parallel district court proceeding might affect the *Fintiv* analysis in these proceedings. Ex. 1057, 5:24–6:3. Petitioner explains that, in the summary judgment motion, Maxell challenges the public availability of the Abowd reference, an issue also raised by Patent Owner here. *Id.* at 6:16–23.

³ Citations are to IPR2020-00407. The parties filed similar papers and exhibits in IPR2020-00408 and IPR2020-00409.

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Because the Board and district court apply different standards of proof and have before them different evidence on the public availability issue, Petitioner requests additional briefing to address the relevance of Maxell's summary judgment motion to the analysis under *Fintiv* factor 4—the overlap between issues raised in the Board proceedings and in the parallel proceeding. *Id.* at 6:4–7, 6:24–10:2, 15:1–13.

Patent Owner opposes Petitioner's request, asserting there has been enough briefing on the *Fintiv* factors for the Board to make an informed decision. *Id.* at 11:9–12. Patent Owner points out that the issue of whether Abowd was publicly available prior art is the same here as it is in the district court proceeding. *Id.* at 12:16–23. Patent Owner also contends the evidence before both tribunals is substantially the same. *Id.* at 12:24–13:17.

Having considered both parties' positions, we determine that additional briefing is not warranted. We agree with Patent Owner that there has been sufficient briefing on the *Fintiv* factors, as each party has filed a supplemental brief with ten pages of argument relating to *Fintiv*. The parties agree that the question of whether Abowd was publicly available presents the same issue before the Board and the district court. Maxell's summary judgment motion does not change the underlying issue that would be considered by both tribunals if the Board institutes *inter partes* reviews. Moreover, to the extent Petitioner contends that different standards of proof are relevant considerations under *Fintiv*, Petitioner had the opportunity to make that argument in its Preliminary Reply. For these reasons, we deny Petitioner's request for authorization to file additional supplemental briefing to address the *Fintiv* factors.

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Accordingly, it is

ORDERED that Petitioner's request for authorization to file an additional supplemental brief is *denied*.

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