UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

APPLE, INC. et al. Plaintiffs, v. ANDREW IANCU, in his official capacity As Under Secretary of Commerce for Intellectual Property and Director, United States Patent and Trademark Office, Defendant.	)

Declaration of Rob Honeycutt

I, Rob Honeycutt, being over the age of 18 years hereby declare as follows.

1. I am an inventor. I invented the device and system described in U.S. Patent Nos. 9,167,329 and 9,769,556. The ’329 and ’556 patents solve the problem of how to use magnetic earbuds to enable features that control a mobile phone through a wireless connection.
2. I am a principal of Snik LLC. I assigned the ’329 and ’556 patents to Snik.
3. I and my company Snik are members of nonprofit US Inventor. We joined because US Inventor is looking after “little guy” inventors and small businesses who need the patent system to function well so that entrepreneurs can build businesses and create jobs, secure in the knowledge that their patent rights will protect them from infringements.

4. Snik is currently in an infringement dispute with various Samsung entities. There is a lawsuit pending in federal court to resolve that dispute: Case No. 6:19-cv-00458 (E.D.Tex.). A trial date has been set before the date that any AIA trial review could be completed.
5. Samsung Electronics America, Inc. has filed five (5) petitions at the USPTO for inter partes reviews of my '329 and '556 patents. The deadline for our preliminary responses is imminent: early December 2020.
6. I have seen statistics that, after institution, 84% of patents result in a final written decision invalidating at least one claim.
7. In the Preliminary Response we plan to ask that the Director use his discretion under 35 U.S.C. § 314(a) (and other parts of the AIA) to deny institution. In particular, we expect to point to the following facts:
    a. Reliance on prior art already considered during original prosecution.
    b. A trial in the court case scheduled to occur before an AIA trial review could be completed.
    c. Possibly other facts.
8. There are no promulgated regulations on the Director's consideration of discretionary factors like these in the decision of whether to grant institution. I and Snik are irreparably and imminently harmed by the lack of such rules. There are no authoritative published rules that I can cite to help me make my discretionary arguments against institution of the IPR trial.
9. If the Court granted a preliminary injunction requiring the Director to deny institution pending issuance of proper regulations, that would eliminate this harm from occurring.

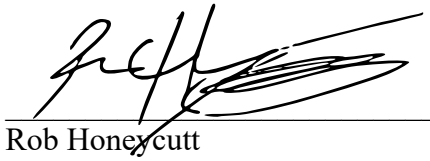
Even if the Court just required the Director to stay that decision, that would eliminate this harm because after the stay, I would be able to use those regulations to persuade the Director to make a discretionary denial.

10. I understand that proper regulations require publication, notice-and-comment by the public, and a thorough review by the agency. I also understand that in this case, agency review would have to take into account the effect of any proposed rule on the economy as a whole, and the integrity of the patent system. I believe that any regulations that come out of such a process will make it much more likely that the PTAB will have to deny institution in cases with facts like mine.

11. The lack of promulgated regulations has made it more expensive and uncertain for us as patent owners to deal with IPR petitions, since the public lacks certainty about what the PTAB will do in factual situations such as my own.

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge and belief.

Dated: September 25, 2020



Rob Honeycutt