UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.;

MICRON TECHNOLOGY, INC.; and

SK HYNIX, INC.,

Petitioners,

v.

ELM 3DS INNOVATIONS, LLC,
Patent Owner.

Cases[1]
IPR2016-00386 (Patent 8,653,672) IPR2016-00387 (Patent 8,841,778)
IPR2016-00388 (Patent 7,193,239) IPR2016-00389 (Patent 8,035,233)
IPR2016-00390 (Patent 8,629,542) IPR2016-00391 (Patent 8,796,862)
IPR2016-00393 (Patent 7,193,239) IPR2016-00394 (Patent 8,410,617)
IPR2016-00395 (Patent 7,504,732)

PATENT OWNER ELM 3DS INNOVATIONS, LLC'S MOTION UNDER 37 C.F.R. § 42.20 REGARDING CLAIM CONSTRUCTION

[1] This Notice addresses issues that are substantially similar across proceedings and is provided pursuant to the Board's instruction that it could be provided "in one document." Order – Conduct of the Proceeding (Paper 14), dated July 1, 2016.

Pursuant to the Board's Order regarding the Conduct of the Proceeding in the above captioned cases, Patent Owner Elm 3DS Innovations, LLC ("Elm") submits this Motion regarding the appropriate claim construction standard pursuant to 37 C.F.R. § 42.20. As fully explained in Elm's Notice of Patent Expiration, filed contemporaneously with this motion, U.S. Patent Nos. 7,193,239 (IPR2016-00388; IPR2016-00393); 8,410,617 (IPR2016-00394); 8,629,542 (IPR2016-00390); 8,653,672 (IPR2016-00386); 8,796,862 (IPR2016-00391); and 8,841,778 (IPR2016-00387) will expire before the deadline for issuing final written decisions in the relevant cases. Thus, in the seven proceedings pertaining to these six patents, the Board should apply the claim construction standard applied by United States District Courts under *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312, 1327 (Fed. Cir. 2005) (words of a claim "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art in question at the time of the invention). U.S. Patent Nos. 7,504,732 (IPR2016-00395) and 8,035,233 (IPR2016-00389) will not expire prior to the respective deadlines for final written decisions in the proceedings relating to those patents. Thus, in these two proceedings, the Board should apply the broadest reasonable interpretation standard.

The Board applies the *Phillips* standard to expired claims. *See In re Rambus*, 694 F.3d 42, 46 (Fed. Cir. 2012). For the relevant patents, the claims will expire before the deadline for a final written decision. There is no reason that these expired claims should be treated any differently than claims expiring prior to institution. Thus, the *Phillips* standard should apply.

The *Phillips* standard applies to expired patents because they do not present the same impetus requiring review under the broadest reasonable interpretation as patents that will remain in effect after the final written decision. The ability to amend the claim language during an IPR mandates that the Board apply the broadest reasonable interpretation standard —the standard applied by patent examiners addressing a patent application in the first instance—to ensure the scope of the patent remains properly constrained. For expired patents, however, the Board analyzes claims under the *Phillips* standard in part because the patent owner does not have the ability to amend claims. *Square, Inc. v. J. Carl Cooper*, IPR2014-00157, Paper 17, at 2 (PTAB June 23, 2014) ("[O]ur final written decision in this proceeding will in all likelihood issue after the '207 patent expires. . . . Therefore, the principles set forth by the court in [*Phillips*] should be applied because the expired claims are not subject to amendment."). Without the ability to

amend the language of the claims, the need to construe the broadest reasonable interpretation is unnecessary, and the district court standard applies.

The same logic applies to patents that will expire prior to the final written decision. After final written decision, the patent will be expired—regardless of whether the claims were amended during the *inter partes* proceeding. These newly expired patents will have the same impact on competition as patents that expired prior to institution. As such, the *Phillips* standard—not the broadest reasonable interpretation—is properly applied to the patents that will expire prior to the deadline for a final written decision.

Further, application of the *Phillips* standard comports with the Board's practice in prior cases. For example, in *Toyota Motor Corp. v. Leroy G. Hagenbuch*, the patent at issue expired "subsequent to the institution of trial," but *prior* to the final written decision. IPR2013-00483, Paper 37, at 5 (PTAB Dec. 5, 2014). Addressing the newly expired patent claims at issue, the Board stated: "We review the expired patent claims according to the standard applied by the district courts." *Id.* Thus, the *Phillips* standard has previously been applied in situations factually indistinguishable from this case. *See also Cisco Sys., Inc. v. AIP Acquisition, LLC*, IPR2014-00247, Paper 39, at 7 (PTAB May 20, 2015) (applying

the *Phillips* standard on final decision despite previously applying the broadest reasonable interpretation in the institution decision); *Square*, Paper 17, at 2.

Finally, application of the *Phillips* standard to patents that will expire prior to the final written decision is not in conflict with Petitioner's argument in the petition. Petitioner argues that "[a]fter expiration, Petitioner believes the claims should be construed according to *Phillips* . . . ." *See, e.g.*, IPR2016-00386, Paper 1, n.6. Because the relevant patents will expire before a final written decision is due, Elm's position is in agreement with that of Petitioners—namely that the *Phillips* standard should apply to the expired patents when the Board drafts its final written decision.

The Board requested briefing on this issue because Elm did not address the claim construction standard in its preliminary response. As Elm is in agreement with Petitioner's position, and the Board has previously applied *Phillips* in similar circumstances, Elm respectfully requests that the Board construe any necessary claim terms for U.S. Patent Nos. 7,193,239; 8,410,617; 8,629,542; 8,653,672; 8,796,862; and 8,841,778 under the *Phillips* standard, and that the Board construe any claim terms for U.S. Patent Nos. 7,504,732 and 8,035,233 under the broadest reasonable interpretation standard.

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