UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.;
MICRON TECHNOLOGY, INC.; and
SK HYNIX INC.
Petitioner

v.

ELM 3DS INNOVATIONS, LLC
Patent Owner

Cases
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)

PETITIONER'S RESPONSE TO PATENT OWNER'S MOTION UNDER 37 C.F.R. § 42.20 REGARDING CLAIM CONSTRUCTION

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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)

Pursuant to the Board's Order dated July 1, Petitioner submits this response to Patent Owner Elm 3DS Innovations, LLC's ("Patent Owner") Motion regarding the appropriate claim construction standard to be applied in the above-captioned proceedings.[1]

Petitioner agrees with Patent Owner that the Board should apply the claim construction standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) in the following seven proceedings because the challenged patents will all expire on April 4, 2017, before the deadline for issuing final written decisions: IPR2016-00388 (U.S. 7,193,239); IPR2016-00393 (U.S. 7,193,239); IPR2016-00394 (U.S.8,410,617); IPR2016-00390 (U.S. 8,629,542); IPR2016-00386 (U.S. 8,653,672); IPR2016-00391 (U.S. 8,796,862); and IPR2016-00387 (U.S. 8,841,778).

With respect to the remaining two proceedings, the information on the faces of U.S. Patent Nos. 7,504,732 ("the '732 Patent") (IPR2016-00395) and 8,035,233 ("the '233 Patent") (IPR2016-00389) indicates expiration dates of January 13,

[1] Pursuant to the Board's Order dated July 1, 2016 (pages 4-5), Petitioner submits this Response as a common document in each proceeding using a caption identifying each proceeding in which the common document is filed.

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2019, and December 30, 2018, respectively. Based on these facts alone, Petitioner acknowledges that the broadest reasonable interpretation ("BRI") standard of claim construction applies in these two proceedings. The above-captioned proceedings, however, present a unique and complex situation.

First, applying different standards in these proceedings for expiring versus non-expiring patents in the same patent family could result in a scenario where a common term found in claims of two different patents sharing an identical specification could be accorded different meanings. This outcome would present logistical issues throughout the proceedings. Accordingly, to ensure efficient and consistent resolutions, Petitioner respectfully requests that the Board apply both the *Phillips* and BRI claim construction standards to the '732 and '233 patents and determine an outcome on the basis of both standards. This approach would substantially simplify appeal and post-appeal proceedings, if any.

Moreover, the '732 and '233 Patents will likely expire prior to the resolution of any appeal to the Federal Circuit (or remand therefrom). In this scenario, even if the Board applied the BRI standard during the initial IPR proceedings before the Board, the Federal Circuit would apply the *Phillips* standard. *See Facebook Inc. v. Pragmatus AV LLC*, 582 Fed.Appx. 864 (Fed. Cir. 2014) (applying the *Phillips*

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standard to patents that expired after the Board's decision, but during appeal). The unique facts at hand, which involve a mix of expiring and non-expiring patents from the same family, warrant an application of both the *Phillips* and BRI standards for the non-expiring patents to simplify issues during any appeal or remand.

Finally, Petitioner asserts that the '732 and '233 Patents are invalid under the doctrine of non-statutory obviousness-type double patenting.[2] A claim is invalid under the doctrine of non-statutory obviousness double patenting if it is "an 'obvious' modification of the same invention" claimed in an earlier expiring

[2] Exhibit 1064 (IPR2016-00389) explains that the challenged claims of the '233 Patent are invalid for obviousness-type double patenting in view of at least U.S. 7,193,239, which Patent Owner admits expires on April 4, 2017 (*see* IPR2016-00388, Paper No. 19). Exhibit 1065 (IPR2016-00395) explains that the challenged claims of the '732 Patent are invalid for obviousness-type double patenting in view of at least U.S. 8,796,862, U.S. 8,653,672, U.S. 8,841,778, U.S. 7,193,239, or U.S. 8,410,617, which Patent Owner admits expire on April 4, 2017 (*see* IPR2016-00391, Paper No. 22; IPR2016-00386, Paper No. 23; IPR2016-00387, Paper No. 21; IPR2016-00388, Paper No. 19; IPR2016-00394, Paper No. 22).

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patent. *In re Longi*, 759 F.2d 887, 892-93 (Fed. Cir. 1985); *Abbvie Inc. v. Mathilda & Terence Kennedy Inst. of Rheumatology Trust*, 764 F.3d 1366, 1379 (Fed. Cir. 2014). Patent Owner still could submit terminal disclaimers during the pendency of these proceedings, in which case these two patents would expire on April 4, 2017. In that case, the Board should apply the claim construction standard set forth in *Phillips* to the'732 and '233 Patents.

Petitioner therefore respectfully requests that the Board construe the claims of the '732 and '233 patents under both the *Phillips* standard and the BRI standard. Under either standard, Petitioner believes the challenged claims are invalid in view of the prior art grounds adopted by the Board. *See* IPR2016-00395, Paper 4 at 9 n.5; IPR2016-00389, Paper 4 at 13 n.5.

Respectfully submitted,

Dated: July 27, 2016

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