Trials@uspto.gov
Tel: 571-272-7822

Paper 52
Entered: January 19, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MPH TECHNOLOGIES OY,
Patent Owner.

IPR2019-00819 (Patent 7,620,810 B2)
IPR2019-00820 (Patent 7,937,581 B2)[1]

Before KEVIN C. TROCK, JOHN D. HAMANN, and
STACY B. MARGOLIES, *Administrative Patent Judges.*

HAMANN, *Administrative Patent Judge*.

ORDER
Conduct of Proceedings on Remand
37 C.F.R. § 42.5

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[1] The parties are not permitted to use this style unless authorized by the Board.

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I. BACKGROUND

On September 24, 2020, we issued a Final Written Decision in each of the above identified cases. -819 case and -820 case, Papers 37. For the -819 case, we found, *inter alia*, that Petitioner did not show that claims 1–6 of U.S. Patent No. 7,620,810 B2 ("the '810 patent") were unpatentable. -819 case, Paper 37, 16–23, 53–54. In particular, we found that Petitioner did not show that the cited art teaches "the request message . . . being encrypted," as recited in independent claim 1, and thus also did not show that claims 2–6, which depend from claim 1, were taught. *Id.*

For the -820 case, we found, *inter alia*, that Petitioner did not show that claims 4 and 6–8 of U.S. Patent No. 7,937,581 B2 ("the '581 patent") were unpatentable. -820 case, Paper 37, 45–55, 66–67. First, claim 4 recites "the request message . . . is encrypted," and like for the -819 case, we found that Petitioner did not show that the cited art teaches this limitation. *Id.* at 45–49; -820 case, Ex. 1001, 11:9–10. Second, claims 6–8 depend from claim 5. -820 case, Ex. 1001, 11:11–23. The ground that Petitioner set forth challenging claim 5 included Ahonen as a reference in the asserted combination. -820 case, Paper 2, 4. However, the grounds that Petitioner set forth for claims 6–8 did not. *Id.* We found thus Petitioner's showing for claims 6–8 did not include Ahonen's alleged teachings directed to the limitations of intervening claim 5, and therefore the showing was insufficient. -820 case, Paper 37, 49–55, 66–67.

Petitioner appealed the above findings in our Final Written Decisions to the United States Court of Appeals for the Federal Circuit. *See* -819 case and -820 case, Papers 38. On September 8, 2022, the Federal Circuit issued

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a joint decision covering the -819 and -820 proceedings. -819 case, Paper 51.

First, the Federal Circuit found that we adopted an erroneous claim construction for "encrypted" messages in both of our Final Written Decisions, and vacated our patentability determinations for claims 1–6 of the '810 patent and claim 4 of the '581 patent based on the erroneous claim construction. *Id.* at 11–13, 18.

Second, the Federal Circuit stated that we "properly declined to consider Ahonen in Grounds 1 and 3 of the" -820 case, as these grounds did not include Ahonen. *Id.* at 16; *see also id.* at 14–18. More specifically, the Federal Circuit "h[e]ld that the Board properly found that [the Petition] failed to demonstrate the unpatentability of dependent claims 6–8 of the '581 patent," and affirmed as to those claims. *Id.* at 2.

In sum, the Federal Circuit vacated our patentability determinations for claims 1–6 of the '810 patent and claim 4 of the '581 patent, and remanded to the Board for further proceedings. *Id.* at 18.

On October 13, 2022, Patent Owner filed with the Office a statutory disclaimer under 37 C.F.R. § 1.321 for each of the challenged patents. As to the '810 patent, Patent Owner stated that it "hereby disclaims and dedicates to the public the entirety of claims 1–3 of the '810 Patent." -819 case, Ex. 3003, 1. As to the '581 patent, Patent Owner stated that it "hereby disclaims and dedicates to the public the entirety of claim 4 of the '581 Patent." -820 case, Ex. 3003, 1.

On October 18, 2022, the Federal Circuit issued its mandate for these cases. -819 case, Paper 50 (Mandate, *Apple Inc. v. MPH Technologies OY*, No. 2021-1355, 2021-1356 (Fed. Cir. Oct. 18, 2022) (No. 46)).

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In accordance with Standard Operating Procedure ("SOP") 9, the parties contacted the Board requesting a call with the panel to discuss the remand proceedings. On November 18, 2022, Judges Trock, Hamann, and Margolies held this call with the parties. A copy of the transcript of the call was filed by Petitioner. -819 case, Ex. 1022. After hearing arguments, we directed the parties to file simultaneously their proposals for what procedures on remand should govern these cases, including addressing the eleven items provided in Appendix 2 of SOP 9. *Id.* at 25:13–19.

II. ANALYSIS

Petitioner proposes that we authorize additional briefing that addresses the following: (1) "application of the grounds in trial [of the -819 case] to properly-construed claims 4–6, including the limitations of claims 1 and 3 from which they depend" and (2) the legal effect of the statutory disclaimers. -819 case, Paper 47, 2–3 (footnote omitted); -820 case, Paper 47, 3. Petitioner argues that it should be allowed to brief and argue the implications of the Federal Circuit's claim construction for an encrypted message because otherwise the -819 case could return to the Federal Circuit and again be remanded to the Board to address this construction issue. *See* Ex. 1022, 11:16–13:5, 19:10–20:13. In addition, Petitioner argues that the statutory disclaimers should be construed as requests for adverse judgment. *E.g.*, *id.* at 6:19–7:1, 9:7–13. Petitioner also proposes that no additional evidence should be allowed. -819 case, Paper 47, 3.

Patent Owner proposes that we authorize no additional briefing or evidence. *E.g.*, -819 case, Paper 46, 1; -820 case, Paper 46, 3–4. As to construction briefing for the -819 case, Patent Owner argues that as directed by the Federal Circuit that we should consider whether Petitioner's showing

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for dependent claims 4–6 of the '810 patent is insufficient because it fails to account for the intervening claim limitations of claim 3—Petitioner did not include Ahonen for the grounds challenging claims 4–6. *See* Ex. 1022, 13:12–24; *see also id.* at 15:23–16:20 (arguing further that no additional briefing as to claim construction issues is needed). Patent Owner adds that in light of the statutory disclaimers that we need not consider anything further. *Id.* at 13:12–24, 17:1–7; -819 case, Paper 46, 1–3; -820 case, Paper 46, 1–3. In addition, Patent Owner disputes that the effect of the statutory disclaimers are adverse judgments, and argues that no briefing or evidence is appropriate for this issue. -819 case, Paper 46, 3; -820 case, Paper 46, 3–4.

Having consider the parties' written proposals and the arguments made during our call with the parties, we determine that no additional briefing as to issues related to claim construction is warranted at this time. As Petitioner acknowledges, the asserted grounds collectively challenging dependent claims 4–6 (which depend from claim 3) do not include Ahonen despite Petitioner relying on Ahonen's teachings for the ground challenging claim 3. -819 case, Paper 46, 2 n.2; Paper 2, 4. As suggested by the Federal Circuit, we have decided to consider this issue on remand because it may be dispositive for the remaining challenged claims for the -819 proceeding. -819 case, Paper 51, 14 n.4. Authorizing claim construction briefing at this time, which may be unnecessary, does not promote efficiency or economy of resources. To the extent that the Ahonen-related issue is found to not be dispositive, we can reconsider at that time whether additional briefing for issues related to claim construction is warranted.

We authorize additional briefing as to the legal effect of the statutory disclaimers that Patent Owner filed for the patents challenged in these cases.

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