

Case IPR2019-00820  
Patent 7,937,581 B2

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

MPH TECHNOLOGIES OY,  
Patent Owner.

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Case IPR2019-00820  
Patent 7,937,581 B2

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**PATENT OWNER MPH TECHNOLOGIES OY'S  
POSITION ON REMAND PROCEDURES PER THE  
BOARD'S NOVEMBER 18, 2022 CONFERENCE CALL AND  
STANDARD OPERATING PROCEDURE 9 APPENDIX 2**

Patent Owner MPH Technologies Oy respectfully submits its positions on remand procedures for Case Nos. IPR2019-00819 (Patent 7,620,810 B2) and IPR2019-00820 (Patent 7,937,581 B2).<sup>1</sup>

**I. Further Briefing or Evidence is Inappropriate in IPR2019-00819**

The sole issue on remand is whether the Board should confirm claims 4-6 of the '810 patent due to the Petition's failure to address the limitations of intervening claim 3. This is the issue identified by the Federal Circuit in footnote 4 of its remand decision. *Apple Inc. v. MPH Techs. Oy*, 2022 WL 4103286, at \*6 n.4 (Fed. Cir. Sept. 8, 2022). The issue was fully briefed and tried (but not decided) in the original trial.<sup>2</sup> As such, any additional briefing, evidence, hearings, or other "do-over" would be highly inappropriate and unfairly prejudicial to Patent Owner.

During the November 18, 2022, panel conference, Apple was unable to identify any way in which the Federal Circuit's claim construction affects the issue identified by the Federal Circuit in footnote 4. There is a good reason for this. The construction of one term in claim 1 has no impact on the Petition's complete failure to address any of claim 3's limitations in the grounds against dependent claims 4-6. Indeed, when briefing claims 4-6 in the original IPR proceeding, neither party

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<sup>1</sup> MPH is filing this same paper in both cases, captioned separately.

<sup>2</sup> See IPR2019-00819, Paper 22, POR, pp. 63-64, 73; Paper 26, Pet. Reply, pp. 22-25; Paper 29, PO Sur-reply, pp. 24-25.

discussed the meaning of claim 1’s disputed claim term (“request message and/or reply message being encrypted”).<sup>3</sup> In these circumstances, no further briefing is appropriate. *See PPC Broadband, Inc. v. Corning Optical Commc’ns RF, LLC*, IPR2013-00342 (Paper 55) (PTAB Aug. 4, 2016) (denying requested briefing because it was unrelated to Federal Circuit claim construction).

Any other substantive issue that might have remained on remand was mooted by Patent Owner’s disclaimer of claims 1-3 of the ’810 patent and claim 4 of the ’581 patent. At the panel conference, Apple said this attempt to streamline the issues and simplify these proceedings was some kind of “trick.” Only Apple—the world’s largest company—could call economizing by its smaller rival a “trick.” IPR proceedings are intended to be quick and economical. 37 C.F.R. § 42.1(b) (“This part shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.”)

Even if the claim construction adopted by the Federal Circuit could somehow affect a live issue—which it does not—Apple would still not be entitled to any additional briefing (much less additional evidence or hearings). Apple was on notice of that construction during the original trial. In fact, it was Apple’s own construction all along. As the Board noted, “[Apple] argued that one of ordinary skill in the art

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<sup>3</sup> *Id.*

would have understood that only a portion of the message need be encrypted. ... [Apple] repeated its argument that Ishiyama’s request message is encrypted because the encapsulated packet is encrypted, even though the outer packet’s header is unencrypted.”). IPR2019-00819, Paper 37, FWD, p. 21. The Federal Circuit adopted that very construction. *Apple Inc.*, 2022 WL 4103286, at \*6 (“The Challenged Patents contemplate that a message can still be considered ‘encrypted’ if its packet has unencrypted ‘outer IP header’ information.”). Therefore, it is far too late for Apple to make new arguments or submit new evidence based on the Federal Circuit’s (and its own) claim construction. *Wireless Protocol Innovations, Inc. v. TCT Mobile, Inc.*, 2022 WL 2813743, at \*5 (Fed. Cir. July 19, 2022) (petitioner forfeited arguments presented for the first time on remand because during the original proceeding the petitioner was on notice of the claim construction position adopted by the Court).

## **II. Further Briefing or Evidence is Inappropriate in IPR2019-00820**

The only remaining task for the Board in IPR2019-00820 (’581 patent) is to issue a certificate confirming the claims affirmed by the Federal Circuit. No briefing or evidence is appropriate for Apple’s novel request for an adverse judgment.

MPH’s statutory disclaimer of certain claims cannot be construed as a request for adverse judgment because it did not occur “during a proceeding” at the Board as required by 37 C.F.R. § 42.73(b). Rather, it occurred during the Federal Circuit

appeal, *before* the Federal Circuit issued its mandate and returned jurisdiction to the Board. *See* 37 C.F.R. § 42.2 (“Proceeding means a trial or preliminary proceeding”). The non-precedential case cited by Apple during the panel conference (*Apple Inc. v. Corephotonics Ltd.*, IPR2018-01146) is not to the contrary. There, the claims at issue were disclaimed three months *after* the Federal Circuit issued its mandate and passed jurisdiction back to the Board. Thus, the disclaimer in that case took place “during a proceeding” at the Board, unlike in the present case.

Further, MPH’s disclaimers did not result in “no remaining claim in the trial” as required for adverse judgment under § 42.73(b)(2). For one, ’581 patent claims 6-8 remain for the Board to issue an IPR certificate confirming their patentability.

During the panel conference, Apple suggested an adverse judgment could be entered even when only *some* of the remaining claims are disclaimed, because that would somehow be a “concession of unpatentability [] of the contested subject matter” under § 42.73(b)(3). However, “the contested subject matter” refers to the entirety of the contested subject matter, not just part. More importantly, a disclaimer of a claim is not a “concession” of unpatentability. *Gilead Sciences Inc. v. U.S.*, 2020 WL 582380, at \*21 n.31 (PTAB Feb. 5, 2020). Instead, such claims should be treated as though they never existed. *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1383 (Fed. Cir. 1998); *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996).

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