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.
MAXELL, LTD.
Patent Owner

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Case No. IPR2020-00202
U.S. Patent No. 10,212,586 B2

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PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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I.   INTRODUCTION

The Response ("POR") turns on two primary issues. First, Patent Owner argues that "performs … a short-range wireless communication" should be construed narrowly to require both transmitting and receiving. *POR* (Paper 17), 15-20. Although Patent Owner did not previously advance this construction, it now insists that the applicant made "repeated and consistent" statements during prosecution that mandate such a narrow interpretation. *Id*. This construction should be rejected at least because (1) it conflicts with the broader meaning ascribed to "short-range wireless communication" in the '586 Patent specification and (2) the prosecution statements on which Patent Owner relies are ambiguous and subject to multiple interpretations. Further, even if the claims were so narrowly construed, Kirkup's HED conducts multiple distinct two-way communications, satisfying even Patent Owner's construction.

Second, the claimed ordered conditions require Kirkup's HED to begin the authentication process in a locked state before being unlocked by the user and then wirelessly sending a code to unlock the PC. Patent Owner argues that "Kirkup does not disclose the claimed three-ordered conditions because (1) either the HED is unlocked when the process in Figure 2 begins; or (2) the HED remains locked when the HED sends the authentication code to unlock the PC 110." *Id*. at 22. The first scenario is irrelevant—Petitioner does not rely on an unlocked HED when the

process begins. As to the second scenario, Patent Owner is simply incorrect that Kirkup teaches or suggests the HED would unlock the PC without being unlocked itself. Under this interpretation, the user is never required to enter a PIN or password, and the PC can be unlocked without authenticating the user in any way. Because this entirely defeats Kirkup's goal of providing a *secure* method for unlocking one device by authenticating the user on another device, it cannot be correct.

II.   CLAIM CONSTRUCTION

Despite representing to the District Court that no claim terms required construction,[1] the POR newly argues that "short-range wireless communications" means "short-range wireless transmission and reception of information." *POR* (Paper 17), 16. In the context of the Challenged Claims, this proposed construction requires bidirectional communication between two claimed "mobile terminals" (or devices) while both mobile terminals (or devices) are locked (e.g., preventing access). *See, e.g., '586 Patent* (Ex. 1001), Claim 1. Patent Owner primarily relies on ambiguous parentheticals included in an office response, seeking to distinguish prior art that performed no communications at all between locked devices. *POR* (Paper 17), 16-19. Patent Owner also argues that because transceivers are *capable of* transmitting and receiving, the "short-range wireless communications" performed

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[1] Joint *Markman* Statement (Ex. 1008), 1-38.

by a transceiver must necessarily include transmitting and receiving. *Id.* at 19-20.

The Board should reject Patent Owner's proposal. First, the specification contradicts Patent Owner's proposed construction, repeatedly describing unidirectional "short-range wireless communications." Second, because the prosecution statements on which Patent Owner relies are ambiguous and subject to multiple reasonable interpretations (including that the applicant referenced "transmits and receives" to stress that the prior art disclosed neither), the Board should decline to find the applicant intended to exclude the broader meaning ascribed by the specification. Finally, it is not necessary to construe this term because Kirkup satisfies even Patent Owner's narrow proposed construction.

A. The Specification Contradicts Patent Owner's Proposed Construction

Patent Owner insists that "short-range communications" should be narrowly construed because they are "executed by the 'transceiver,' which a person of skill in the art would recognize as performing transmitting and receiving." *POR* (Paper 17), 19. Petitioner does not dispute that transceivers are capable of transmitting and receiving, but that does not mean that every act of "short-range wireless communications" *requires* both. Indeed, the '586 Patent specification repeatedly describes "short-range wireless communications" that are unidirectional. For example, Step 204's "short-range wireless communications" consists of a single transmission:

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