

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS
AMERICA, INC., and APPLE INC.,
Petitioner,

v.

SMART MOBILE TECHNOLOGIES LLC,
Patent Owner.

Case IPR2022-01248
Patent 8,842,653 B1

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

Patent Owner argues that the Petition should be denied because it does not present a construction in the Petition put forward in parallel district court litigation. *See* POPR at 4-17. Patent Owner’s argument would require an exact uniformity between constructions *presented* between forums, as opposed to uniformity in the *standard* used across forums. *Id.* But the Patent Office’s purpose for changing the claim construction standard to *Phillips* was to promote “uniform interpretation of the patent laws,” to reduce the potential for different construction outcomes, not to rigidly require presentation of the same constructions across forums. *Changes to the Claim Construction Standard*, 83 FED. REG. at 51,348.

It is well-established that claim construction is only required for “terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017). It follows that where terms are not in controversy – where there are not “disputed meanings” – then it is not necessary to put forward a construction in an IPR. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). Such is the case here. The prior art reads on the claims in a manner that does not require construction, and Patent Owner has not offered any constructions in their Preliminary Response. Notably, Patent Owner has not identified any alleged inconsistency in constructions for claim 14, other than merely identifying that Petitioner contended at district court that 14[h] is indefinite. *See* POPR at 10.

Moreover, it was Patent Owner that sought a construction of “*multiplexing*” in district court, to which Petitioner was required to respond. If there is a “two-faced approach” in this proceeding, it is Patent Owner’s proposed construction of “*multiplexing*” in district court they don’t also seek here.

The decisions Patent Owner relies upon are consistent with this claim construction principle. *KioSoft* is not an example of the Board generally “preclud[ing] a petitioner from taking inconsistent claim constructions in AIA proceedings and district court.” POPR at 15. *KioSoft*’s Petitioner actively proposed a construction, placing the construction into controversy. *See KioSoft Tech. LLC v. PayRange Inc.*, CBM2020-00026, Paper 11 at 15-16 (PTAB Mar. 22, 2021). Petitioner actively argued – under *Phillips* – for a construction different from their proposal at district court, even using the same expert. *Id.* at 17. This Petition does not seek a construction for “*multiplexing*,” since it is not necessary to resolve any controversy, not to mention that this term is missing from claim 14. Nor did Petitioner’s expert provide a declaration in the district court proceeding.

Orthopediatrics does not stand for a general rule that any differences in constructions warrant a denial of institution. While Petitioner argued constructions weren’t necessary, Patent Owner argued for means-plus-function limitations, thus placing them in controversy. *Orthopediatrics Corp. v. K2M Inc.*, IPR2018-01546, Paper 10 at 7-9 (PTAB Feb. 14, 2019). Petitioner’s position was problematic

because they had argued at district court that the terms were means-plus-function limitations. *Id.* Here, Patent Owner does **not** argue that any term requires construction, but rather presents multiple arguments using Petitioner's district court proposal while disagreeing with it. POPR at 1, 2, 4-10, 17. And neither party argues for a means-plus-function limitation.

Patent Owner omits other decisions where differences in claim construction proposals between parallel proceedings did not warrant denial, and that frame the issue as whether a party has placed a term into controversy. In an analogous case, Petitioner stated that no claim construction was necessary while Patent Owner advocated Petition denial for not proposing any constructions or not applying the same constructions. *See Dell Inc. v. Neo Wireless LLC*, IPR2021-01486, Paper 10 at 12-13 (PTAB Mar. 16, 2022). Patent Owner proposed no construction. *Id.* The Board agreed with Petitioner that construction wasn't necessary. *Id.*; 26-28; *Quest Diagnostics Inc. v. Ravgen, Inc.*, IPR2021-00791, Paper 20 (PTAB Oct. 19, 2021).

Accordingly, that a term received a proposed construction in this case's related proceeding is not determinative; rather, the question is whether construction under the shared *Phillips* standard is required to resolve a controversy. Indeed, the term "*multiplexing*," to which Patent Owner dedicated most of its preliminary response (POPR at 2, 8-9, 18-43), is not even part of claim 14. There is no controversy here, and therefore there is no basis to deny the Petition.

Respectfully submitted,

Dated December 16, 2022

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