Filed: December 23, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

SMART MOBILE TECHNOLOGIES LLC,
Patent Owner.

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Case IPR2022-01249
Patent 9,019,946 B1

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**PATENT OWNER'S PRELIMINARY SUR-REPLY**

## TABLE OF AUTHORITIES

### Cases



### Regulations

Petitioner's Reply to Patent Owner's Preliminary Response does not meaningfully dispute that Petitioner (i) is taking inconsistent claim construction positions before this panel and in District Court, (ii) failed to inform this panel it was doing so, and (iii) makes no showing that its petitioned grounds meet its own claim constructions. The Reply therefore confirms that institution should be denied.

Petitioner devotes much of its Reply to alleging that claim construction is not necessary, but does not address or dispute the fact that Petitioner had the burden to identify its relied-on claim constructions and specify where each element of the construed claim is found in the art of record. 37 C.F.R. §§ 42.104(b)(3)-(4). Petitioner also does not dispute that it did not reveal or apply the constructions it simultaneously insists—in federal court, without informing this panel—must be applied to these claims for validity purposes. *See Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) ("It is axiomatic that claims are construed the same way for both invalidity and infringement."). Petitioner's failure, like that of the petitioner in *Facebook, Inc. v. Sound View Innovations*, IPR2017-00998, Paper 13 (P.T.A.B. Sept. 5, 2017), to mention "its seemingly inconsistent claim construction positions" in the two forums is a basis to deny institution. *Id.*, 18; *see ipDataTel, LLC v. ICN Acquisition*, IPR2018-01822, Paper 19, 13-14 (P.T.A.B. Apr. 22, 2019) (denying review where "[i]n the litigation,

Petitioner...argued that [a] term…is indefinite" but had "not offered any explanation as to how its positions here and in the District Court can be reconciled").

Petitioner complains that Patent Owner has not offered any constructions. It was Petitioner's burden, not Patent Owner's, to do that. As the POPR (at 10-20) explains, Office rulemaking has repeatedly confirmed petitioners may not take inconsistent claim construction positions between district court and IPR cases without justification. 83 Fed. Reg. 51,347-51,348 (Oct. 11, 2018) (amending rules to "prevent[] parties from taking inconsistent positions, such as a patent challenger arguing for a broad scope in a PTAB proceeding (under BRI) and a narrow scope (under *Phillips*) in district court to avoid a finding of infringement."); 51,342 ("the possibility of differing constructions for the same claim term is troubling, ***especially when claim construction takes place at the same time*** in parallel district court proceedings"). The Board has based denial of institution on such inconsistencies. *E.g., Samsung Elecs. Co. v. Ancora Techs., Inc.*, IPR2020-01184, Paper 11, 27 (P.T.A.B. Jan. 5, 2021) (denying institution where, "[s]ignificantly, Petitioner's [claim construction] argument…seems to be inconsistent with its position advanced in the parallel litigation and the Federal Circuit's interpretation"). Yet here, "Petitioner left it to Patent Owner to advise [the panel] of Petitioner's differing claim construction arguments to the district court." *Facebook*, 17.

Moreover, even now Petitioner still fails to offer any justification for its inconsistent positions. Its silence is especially significant here because nothing suggests, and the Petition offers no arguments for finding, that Petitioner's own claim constructions are met by the raised grounds in this case. As explained at length in the POPR, for example, Petitioner has not shown that its combinations disclose or suggest "multiplexed" signals that are "interleave[d] or simultaneously transmit[ted]," as its District Court construction expressly requires of such signals. POPR, 30-39. Petitioner also provides no justification for alleging certain limitations are indefinite for infringement purposes but not for invalidity purposes. *Facebook*, 9-10; *see also ipDataTel*, 13-14 (denying petition where Petitioner argued only before court, not Board, that claim was indefinite).

In conclusion, the Reply does not meaningfully dispute that Petitioner's claim construction positions are "inconsistent with its position advanced in the parallel litigation," *Samsung Elecs.*, 27, that it did "not inform the panel that Petitioner had taken a very different claim construction position before the district court," *Facebook*, 17, and that it has not "offer[ed] any explanation as to how its positions here and in the [d]istrict [c]ourt can be reconciled," *ipDataTel*, 13-14. This inconsistency and silence furnish yet another independent basis to deny institution.

For these reasons and the additional reasons set forth in the POPR, the Board should deny institution.

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