

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner,

v.

WIRELESSWERX IP LLC,  
Patent Owner.

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IPR2023-00850  
Patent 8,315,203 B2

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Before JOHN A. HUDALLA, JOHN D. HAMANN, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
Authorizing Additional Briefing  
*37 C.F.R. § 42.5*

On September 11, 2024, the Board conducted an oral hearing for this proceeding. Based on this hearing and the papers submitted by the parties, we have determined that additional briefing from the parties is warranted for the reasons we discuss below.

In the Petition, Petitioner states that it “does not believe any term requires explicit construction to resolve the issues in th[e] Petition.” Paper 1 (“Pet.”), 11. Petitioner, however, also states the following with respect to claims 6–30:

For clarity, the “communication transponder”/“transponder” in the claims is *not* the same transponder described in the specification and earlier applications. Ex-1002 ¶209. Instead, the specification and earlier applications use the term transponder to refer to the tracked device (or a hardware unit attached to the tracked device). *See, e.g.*, Ex-1001, 7:25-29, 7:36 (describing a “transponder [or] subscriber device”), 7:36-41 (“transponder can be [in or on] vehicles, aircraft, cargo, persons”); Ex-1024 ¶¶7 (“monitor movement of an entity compris[ing] a transponder”), 8 (“transponder can be [in or on] vehicles, aircraft, cargo, persons”), 52-65 (describing a transponder for attachment in a vehicle); Ex-1025 ¶¶14, 18, 46, 74, 76. In contrast, in Claims 6-30, the “communication transponder” or “transponder” has the same role as the “nodes” in Ground 1. Ex-1002 ¶209.

Pet. 46–47. Petitioner cites to the expert declaration of Scott Andrews as support, but this testimony parrots Petitioner’s assertion without providing any additional reasoning or evidence. Ex. 1002 ¶ 209.

In its Response, Patent Owner does not explicitly address the meaning of “communication transponder” or “transponder” in the challenged claims. *See generally* Paper 11. Rather, Patent Owner disputes that the cited art teaches these challenged claims when considering nodes (beacons) to teach transponders. *Id.* at 24–26. Petitioner’s Reply addresses these arguments

from Patent Owner, but does not add to why Petitioner contends that as used in the claims, “communication transponder” and “transponder” are not the same transponder described in the specification and earlier applications.

Paper 14, 5–14. Patent Owner did not file a sur-reply.

“The Board will construe patent claims . . . based on the record of the . . . proceeding, taking into account the claim language itself, specification, and prosecution history pertaining to the patent, as well as relevant extrinsic evidence . . . .” Consolidated Trial Practice Guide November 2019<sup>1</sup> (“CTPG”) 46. “Thus, as in a district court proceeding, the parties should point out the specific portions of the specification, prosecution history, and relevant extrinsic evidence they want considered, and explain the relevancy of any such evidence to the arguments they advance. Each party bears the burden of providing sufficient support for any construction advanced by that party.” *Id.*

At this juncture, we seek additional briefing as to whether as a matter of claim construction it is appropriate to deviate from how the specification “use[s] the term transponder to refer to the tracked device (or a hardware unit attached to the tracked device),” as characterized by Petitioner. Pet. 47. In other words, is Petitioner’s assertion correct that the proper claim scope for “communication transponder” and “transponder” covers a node (e.g., beacon)? Accordingly, we authorize additional briefing to address these issues. CTPG 45 (“If the Board raises a claim construction issue on its own, both parties will be afforded an opportunity to respond before a final written decision is issued.”).

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<sup>1</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

Specifically, we authorize additional briefing for the parties to address the meaning of “communication transponder” and “transponder,” in the context of the challenged claims, including whether it is appropriate to deviate from how the specification uses these terms and whether these terms cover a node. We remind the parties that we will “tak[e] into account the claim language itself, specification, and prosecution history pertaining to the patent, as well as relevant extrinsic evidence.” CTPG 46. And thus, the parties should address these items, where relevant.

We also authorize the parties to address the effect of the aforementioned construction on the unpatentability issues before us. In the additional briefing, the parties may point to evidence already in the record, but may not introduce new evidence.

Accordingly it is

ORDERED that each party is authorized to file an opening brief, not to exceed seven pages, that addresses the above-identified issues no later than ten days after the date of this order; and

FURTHER ORDERED that each party is authorized to file a responsive brief, strictly limited to addressing issues raised in the opposing party’s opening brief, not to exceed seven pages, and no later than twenty days after the date of this order.

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