

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
APPLE INC.,¹
Petitioners,

v.

RJ TECHNOLOGY, LLC,
Patent Owner.

Case: IPR2023-01183
U.S. Patent No. 7,749,641

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450
Submitted Electronically via P-TACTS

¹ Apple Inc. was joined as a petitioner in this proceeding based on a petition and motion for joinder filed in IPR2024-00597, which was granted.

I. Introduction

Patent Owner (“PO”) seeks to expunge three sentences from a footnote in the Final Written Decision because the Board allegedly lacked authority to include them. The Board’s own words show PO is wrong and Director Review should be denied. The concluding sentence that PO seeks to remove states that the Board “decline[d] to determine that claims 1 and 5 would have been obvious in view of the combination of Abe and Guyomard.” FWD, 36 n.15. PO argues the Board lacked authority to say it was declining to reach an issue because, according to PO, the Board lacked authority to address it at all. This argument is circular and unavailing. PO’s objections to the other two sentences are equally meritless. These sentences merely restate the Board’s findings—made elsewhere in the FWD—about limitations found in dependent claims. PO does not dispute—nor even acknowledge—those other findings, which are both appropriate and well-supported. Because PO’s request fails to meet the standard for Director Review, it should be denied.

II. Footnote 15 Does Not Reach the Determinations and Conclusions Alleged By PO

PO seeks Director Review to have the Director edit a footnote to strike three sentences from the Final Written Decision. The sentences PO focuses on are:

The only limitation that was shown to be missing in Abe, however, was a charge cut-off voltage for the cell or battery that is above 4.2 V. Petitioner’s arguments with respect to Abe and

Guyomard demonstrate that one of ordinary skill in the art would have sought to use a charge cut-off voltage in the ranges of “4.3 V to 5.2 V” and “4.3 V to 4.8 V” in view of Guyomard. Despite this finding, we decline to determine that claims 1 and 5 would have been obvious in view of the combination of Abe and Guyomard, because Petitioner did not challenge claims 1 or 5 on this ground. Pet. 7, 41–51; Tr. 36:23–37:20; *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 367 (2018) (“the petitioner’s contentions, not the Director’s discretion, define the scope of the litigation all the way from institution through to conclusion”); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (“the Board must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond”).

The third sentence provides the Board’s reasoning for not determining that Claims 1 and 5 were unpatentable based on Abe and Guyomard. The first two sentences just restate uncontested and appropriate findings discussed elsewhere in the FWD.

III. The Third Sentence: Expunging The Board’s Reasoning For *Not* Reaching an Issue Because the Board Allegedly Could Not Reach the Issue Is Unwarranted

Setting aside the propriety of the Board’s decision, the Board certainly has the authority to state why it would not reach an issue. In the third footnote sentence the Board is saying why it is declining to reach an issue. PO’s argument that the Board lacks authority to say why it is not reaching an issue is unsupported. The only

authority PO cites—*Unified Patents LLC v. Memoryweb, LLC*—is not on point. In *Memoryweb*, the Director vacated the Board’s RPI substantive analysis because it was not necessary to resolve the proceeding where no issues regarding time bar or estoppel were presented. IPR2021-01413, Paper 76 at 5 (PTAB May 22, 2023). Here, the Board provided no patentability analysis in the third sentence; quite to the contrary, the Board explained why it did not make a determination as to claims 1 and 5 based on Abe and Guyomard. *Memoryweb* does not prevent the Board from providing such an explanation.

Additionally, the Board’s basis for not reaching the patentability of claims 1 and 5 based on the combination of Abe and Guyomard should be preserved so that there is a fulsome record of the Board’s reasoning for any appeal.

IV. Patent Owner Seeks to Expunge Two Sentences That Are Present Elsewhere in the FWD, Rendering the Requested Relief Meaningless

The first two sentences that Patent Owner wants the Director to intervene to expunge are essential parts of the Board’s finding of unpatentability made elsewhere in the FWD. They are merely reiterated in the footnote to provide background. Thus, expunging them from the footnote would serve no purpose and does not meet the standard for Director Review.

For instance, in portions of the FWD that PO takes no issue with, the Board explained: “Upon review of the parties’ arguments and supporting evidence, we determine that Petitioner persuasively demonstrates that Abe discloses every

limitation of independent claims 1 and 5, except a charge cut-off voltage of greater than 4.2 V.” FWD, 30; *see also id.*, 25-30 (providing the Board’s analysis supporting its conclusion). That the Board repeated this finding in the footnote was not beyond the Board’s authority.

The second sentence of footnote 15 is also found elsewhere in the FWD. The Board found: “Given the successful results reported in Guyomard, we credit the testimony of Mr. Juzkow that one of ordinary skill in the art would have successfully designed the battery of Abe and Guyomard to have a charge cut-off voltage of 4.5, a value that falls squarely within the 4.3 V to 5.2 V and 4.3 V to 4.8 V ranges recited in dependent claims 2–3 and 6–7. Ex. 1002 ¶¶ 174, 182–190.” FWD, 34. PO does not argue the Board overstepped when making this finding. Yet, it argues that the Board overstepped by repeating that finding in a footnote. Because these findings are appropriate—and PO does not contend differently—there is nothing wrong with the Board repeating them in a footnote. PO’s argument to the contrary cannot be squared with its own implicitly inconsistent position on the matter.

Accordingly, PO’s request to have the first two sentences of footnote 15 expunged lacks merit and should be denied.

V. CONCLUSION

For all these reasons, Petitioner requests that PO’s request for Director Review be denied.

Dated: February 18, 2025

Respectfully Submitted,

/Andrew R. Sommer/

Andrew R. Sommer
Reg. No. 53,932

CERTIFICATE OF COMPLIANCE

This response was authorized by the February 10, 2025 email from the Board and complies with the page limits set forth therein.

Dated: February 18, 2025

Respectfully Submitted,

/Andrew R. Sommer/

Andrew R. Sommer
Reg. No. 53,932

CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing paper was caused to be served on the 18th of February 2025 via email upon the following counsel of record for Patent Owner:

Minghui Yang:	mitch@carmichaelip.com
James T. Carmichael	jim@carmichaelip.com
Stephen McBride	stevemcbride@carmichaelip.com
George Stamatopoulos	George.Stamatopoulos@kobrekim.com
Daniel Zaheer	Daniel.Zaheer@kobrekim.com
Michael Ng	Michael.Ng@kobrekim.com
Robert Zhou	Robert.Zhou@kobrekim.com
	RJ-IPRs@Carmichaelip.com

/Andrew R. Sommer/

Andrew R. Sommer
Reg. No. 53,932