IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION

Petitioners,

v.

PROXENSE, LLC

Patent Owner

IPR2024-00405

U.S. Patent No. 10,073,960 B1

PATENT OWNER SUR-REPLY

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EXHIBIT LIST

No.	Exhibit Description
2001	Claim Construction Order in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.,* No. 6.21-CV-00210-ADA
2002	Memo In Support of Claim Construction Order in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*
2003	Markman Transcript from *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*
2004	Claim Construction Order in *Proxense, LLC v. Google LLC,* No. 6:23-cv-00320-ADA
2005	Opening Claim Construction Brief in *Proxense, LLC v. Microsoft Corporation,* No. 6:23-cv-00319-ADA
2006	Responsive Claim Construction Brief in *Proxense, LLC v. Microsoft Corporation*
2007	Reply Claim Construction Brief in *Proxense, LLC v. Microsoft Corporation*
2008	Sur-reply Claim Construction Brief in *Proxense, LLC v. Microsoft Corporation*
2009	Opening Claim Construction Brief in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*
2010	Reply Claim Construction Brief in *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*
2011	Joint Claim Construction Order
2012	Claim Construction Order- *Proxense, LLC v. Microsoft Corp*., No. 6:23-cv-00319
2013	*Intentionally Left Blank*
2014	Declaration of Markus Jakobsson
2015	PLAINTIFF'S PRELIMINARY INFRINGEMENT CONTENTIONS, *Proxense, LLC v. Microsoft Corp.,* No. 6:23-cv-00319-ADA
2016	Ex. E, PLAINTIFF'S PRELIMINARY INFRINGEMENT CONTENTIONS, *Proxense, LLC v. Microsoft Corp.,* No. 6:23-cv-00319-ADA

I. INTRODUCTION

The Reply is mistaken in its assertion that Patent Owner is for the first time in these proceedings advancing certain constructions. The constructions advanced here were presented before the District Court, and not challenged.

The Reply also fails to give adequate weight to the interplay between indefiniteness and a means-plus-function analysis. As is well established, for computer implemented inventions the specification must disclose an algorithm for performing the claimed specific computer function, otherwise the claims are indefinite. Such an algorithm is present here, as detailed in Patent Owner's Response.

Additionally, the Reply fails to address the established principle that for a special purpose computer-implemented means-plus-function limitation, the structure must be more than a ***general purpose computer or microprocessor*** and that the specification must disclose an algorithm for performing the claimed function. The Reply ignores this by focusing on the unrecited physical operation of elements, rather than the logical operation recited in the claims.

II. PROXENSE'S CONSTRUCTION WAS EXPRESSLY STATED IN ITS INFRINGEMENT CONTENTIONS

The Reply is flat wrong in its assertion that Patent Owner's position deviates from that position adopted in the co-pending *Proxense v. Microsoft* litigation.

The Preliminary Infringement Contentions filed July 24, 2024 (submitted herewith as Ex. 2015) including Ex. E (submitted herewith as Ex. 2016), detailed the alleged infringement of U.S. Patent No. 9,679,289 Patent by Microsoft. With regards to the asserted infringement of claim 14 of the 289 Patent, Patent Owner stated:

> An enablement signal is the message comprising information received from a PDK in exchange for the access key provided by the application, function, or service to be enabled that permits the application, function, or service to operate.

Ex. 2016, at 10. Accordingly, Patent Owner asserted verbatim the construction it presents in these proceedings. Petitioner did not challenge that construction before the District Court. Rather, it waited until these proceedings to do so. If anyone is deviating from the position advanced in the co-pending litigation, it is Petitioner.

More disturbing, Petitioner is taking advantage of the estoppel effect of the District Court's construction of "hybrid device" on Proxense:

> Claims 1 and 10 of the 188 Patent and claims 1 and 11 of the 700 Patent state, 'one or more of ***the integrated RDC*** and ***integrated PDK enabling one or more an application, a function and a service***.' An application, function, or service is 'enabled' by a PDK when it ***receives information from a PDK in exchange for an access key***. Similarly, ***an RDC 'enables*** one or more of an application, a function, and a service' ***when it forwards such a message to the application, function, or service***. The claimed "hybrid device" carries out these functions.

Ex. 2002, at 26.

Abiding by the District Court's prior construction, Patent Owner asserted infringement allegations fully adopting and limited to the above construction. Instead of challenging the construction before the District Court, Petitioner waited until these proceedings by asserting constructions broader than the District Court's to invalidate the 960 Patent. If Patent Owner had attempted the same with its infringement allegations, Petitioner would have asserted that Patent Owner was collaterally estopped. Accordingly, Petitioner takes shelter behind the above construction before the District Court, while disregarding it here to invalidate the 960 Patent. The Board should not allow Microsoft to take such an inconsistent position before it.

III. THE CLAIMS INVOKE § 112(F) BECAUSE THEY RECITE GENERAL PURPOSE COMPUTERS PERFORMING A CLAIMED FUNCTION

The law has been consistent and clear: to claim a means for performing a specific computer-implemented function and then to disclose only a ***general purpose computer*** as the structure designed to perform that function amounts to pure functional claiming. *Aristocrat,* 521 F.3d 1328 at 1333 (Fed. Cir. 2008). In this instance, the structure corresponding to a 35 U.S.C. § 112(f) claim limitation for a computer-implemented function must include the algorithm needed to transform the **general purpose** computer disclosed in the specification. *Aristocrat,* 521 F.3d at 1333; *Finisar Corp. v. DirecTV Group, Inc.,* 523 F.3d 1323, 1340 (Fed. Cir. 2008); *WMS Gaming, Inc. v. Int'l Game Tech.,* 184 F.3d 1339, 1349 (Fed. Cir. 1999); *Rain Computing, Inc. v. Samsung Electronics America Co.,* 989 F.3d 1002, 1007-8 (Fed. Cir. 2021). Microsoft has cited nothing challenging this well settled law.

Rather, Microsoft goes tp great lengths to distract from the logical operation recited in the claims. First Microsoft states the "connectivity" recited in the claims performs the logical function of "enabling one more of an application, a function, and a service." Paper 16, 8-12. But Microsoft's long-winded folly forgets one critical fact, the claims do not recite the connectivity performing the logical operation of "enabling one or more of an application, a function, and service." Rather, the claims recite "wherein one or more of (a) the integrated, wireless communication interface communicating wirelessly with the at least one external device within the proximity zone enables one or more of an application , a function , and a service and (b) the local, secured information stored by the integrated, secure memory enables one or more of an application , a function , and a service" (Claim 1) and "an enablement signal enabling one or more of an application, a function and a service" (Claim 14). Accordingly, the claims recite specific elements that perform the logical operation, not connectivity.

A. Local Secured Information Is Defined in the Specification as Performing an Algorithm

The 960 Patent defines "local secured information" as information unlocked with a corresponding access key. 960 Patent, 3:564-57 ("The service block access keys 118 allow the sensor 108 to unlock information stored in the corresponding service blocks 112, which information is used as local secured information."). This is the only instance in which the term "local secured information" appears within the 960 Patent outside of the claims. Furthermore, "local secured information" is explicitly recited in independent claims 1 and 14.

"Although reluctant to exclude an embodiment, this [Board] must not allow the disclosed embodiment to 'outweigh the language of the claim." *Rolls-Royce, PLC v. United Technologies Corp.*, 603 F. 3d 1325, 1334 (Fed. Cir. 2010). *See also TIP SYSTEMS, LLC v. Phillips & Brooks/Gladwin,* 529 F. 3d 1364, 1373 (Fed. Cir. 2008) ("However, to construe the claim term to encompass the alternative embodiment in this case would contradict the language of the claims… Our precedent is replete with examples of subject matter that is included in the specification, but is not claimed."); and *Schoenhaus v. Genesco, Inc.*, 440 F. 3d 1354, 1359 (Fed. Cir. 2006) ("[W]here a patent specification includes a description lacking a feature, but the claim recites that feature, the language of the claim controls."). Accordingly, because claims 1 and 14 explicitly recite "local secured information" to describe and limit the "integrated, secure memory" the language of the claims explicitly limits the integrated secured memory to that unlocked with a corresponding access key. To construe "local secured memory" to be anything else would be to allow potentially disclosed alternative embodiments to outweigh the language of the claims as to contradict the language of the claims.

Disregarding the explicit language of the claims, Petitioner attempts to persuade the Board to repeat the error of the district court in *Rain Computing, Inc. v. Samsung Electronics America Co.*:

> ***The district court erred***, however, in concluding that the disclosure of computer-readable media or storage devices provided sufficient structure for the 'control access' function. These computer-readable media or storage devices amount to nothing more than a general-purpose computer. And 'controlling access to one or more software application packages to which the user has a subscription' requires more 'than merely plugging in a general purpose computer.' Rather, some special programming, *i.e.,* an algorithm, would be required to control access to the software application packages.

989 F.3d 1002, 1007-1008 (Fed. Cir. 2021) (citations omitted and emphasis added). Just because memory is a concrete structure does not make it more than a general-purpose computer. As such, memory absent an algorithm cannot provide the requisite structure for the claimed function of "enabling one or more of an application, a function, and a service."

B. The Claims Recite the Wireless Communication Interface Performs a Logical Operation, Not a Physical Operation

Petitioner next tries to misdirect the Board by focusing on the physical operation of receivers. To this end, it cites *EnOcean GmbH v. Face Int'l Corp.*, 742 F.3d 955 (Fed. Cir. 2014). But, as replicated in the Reply, the claims at issue in *EnOcean* recited the physical operation of receivers for "receiving a first electromagnetic signal," "receiving a first radiofrequency signal," and "receiving a radiofrequency telegram." Paper 15, at 20. The claims of the 960 Patent, however, do not recite the wireless communication interface performs any physical operation, but rather the logical operation of "enabling one or more of an application, a function, and a service." Thus, *EnOcean* is inapplicable.

Again, Petitioner invites the Board to repeat an error made by a district court:

> ***The district court misstated the law***, however, when it stated that disclosure of a processor and ***transceiver*** alone was sufficient to provide structure to these claims. The processor and transceiver amount to nothing more than a general-purpose computer. We have 'consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor.' *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.,* 521 F.3d 1328, 1333 (Fed.Cir. 2008). General-purpose 'computers' or 'processors' can be 'programmed to perform very different tasks in very different ways.' *Id.* Accordingly, 'simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to `the corresponding structure, material, or acts' that perform the function, as required by section 112 paragraph 6.' *Id.*

HTC CORP. v. IPCom GmbH & Co., KG, 667 F. 3d 1270, 1280 (Fed. Cir. 2012). Though a receiver, wireless card, or other communication interfaces may be structures with known physical operations, without an algorithm they are insufficient to enable a logical operation, such as the function of "enabling one or more of an application, a function, and a service" as recited in the claims.

C. The Enablement Signal Cannot Be Sidestepped with Step Plus Function

Petitioner next attempts to sidestep the issue by asserting that step-plus-function analysis somehow is different than a means-plus-function analysis. Paper 15, at 24-25. Yet, it only cites cases predating *Williamson v. Citrix,* without offering any reasoning why step-plus function claims are any different. In fact, Microsoft's primary case, *Masco Corp. v. United States*, 303 F.3d 1316, (Fed. Cir. 2002), was explicitly overruled by *Willamson. Williamson,* 792 F.3d at 1349 ("A few years later, we reiterated *Lighting World*'s characterization of the presumption as a 'strong one that is not readily overcome' in *Inventio AG v. ThyssenKrupp Elevator Americas Corp.,* 649 F.3d 1350, 1358 (Fed. Cir.2011). In *Flo Healthcare Solutions, LLC v. Kappos,* 697 F.3d 1367, 1374 (Fed.

Cir.2012), decided just a year after *Inventio,* we raised the bar even further, declaring that '[w]hen the claim drafter has not signaled his intent to invoke § 112, ¶ 6 by using the term `means,' we are unwilling to apply that provision *without a showing that the limitation essentially is devoid of anything that can be construed as structure*' (emphasis added), citing ***Masco Corp. v. United States,* 303 F.3d 1316, 1327 (Fed.Cir.2002),** a case involving the different term 'step for' and the unusual circumstances in which § 112, para. 6 relates to the functional language of a method claim…. Our consideration of this case has led us to conclude that such a heightened burden is unjustified and that we should abandon characterizing as 'strong' the presumption that a limitation lacking the word "means" is not subject to § 112, para. 6.") (emphasis added). Accordingly, Petitioner's position that means and step plus functions limitations should be treated differently was specifically refuted in *Williamson*.

Regardless, Patent Owner's Response provided a step-plus-function analysis, which Petitioner ignores. *See* Paper 11, at 22-25.

Petitioner further contends that an "enabling signal" is known in the art as "a signal that starts a process or allows one to take place." Paper 15, at 23. However, as noted in Patent Owner's Response, the limitations of claim 14 expressly state receipt of a signal is insufficient to enable an application, a function, and a service. The first element of claim 14 is "creating a first wireless link," which is followed by "receiving a first signal." But the link and the first signal do not "enable one or more of an application, a function and service." Claim 14, rather, recites "generating an enablement signal enabling one or more of an application, a function and service." Accordingly, by the express language of claim 14, the mere receipt of a signal starting a process or receipt of a signal via a wireless link is insufficient to perform the function of "enabling one or more of an application, a function and service."

IV. DR. JAKOBSSON'S DECLARATION SHOULD NOT BE DISREGARDED

Regarding a "function," Dr. Jakobsson provided answers within the context of the claims, but Petitioner sought broader opinions on its general meaning of "functions," which were likewise outside the report's scope. Ex. 1030, 90:16-93:4.

Additionally, when asked about "general-purpose computer," a legal term relevant to claim construction, Petitioner appeared dissatisfied with the response. Ex. 1030, 64:4-23. Petitioner then pressed Dr. Jakobsson with argumentative questioning, asking whether he conducted an independent analysis of the legal term—an irrelevant inquiry. *Id*. at 64:24-69:18.

Ultimately, Petitioner's repeated attempts to extract broader meanings of claim terms, outside the scope of both the claims and Dr. Jakobsson's report, do not diminish the weight of his testimony. Instead, they underscore the shortcomings of Petitioner's own line of questioning.

V. CONCLUSION

When properly construed claims 1 and 14 are computer implement inventions invoking 35 U.S.C. § 112(6) and thus include the algorithm disclosed in the specification. Microsoft does not even attempt to show performance of the algorithm by the asserted references. Accordingly, Microsoft has not established the invalidity of the 960 Patent.

Dated: February 18, 2025

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CERTIFICATION OF WORD COUNT UNDER 37 C.F.R. § 42.24

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner Response (excluding the table of contents, certificate of service, word count, or listing of exhibits) total 2,323 words, which is less than the 5,600 words allowed under 37 C.F.R. § 42.24(c)(4).

Dated: February 18, 2025

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that the Patent Owner Response was served on February 18, 2025, by e-mailing copies to the following e-mail addresses provided by Petitioners in their respective Petitions:

IPR42342-0134IP1@fr.com;

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