UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

COBBLESTONE WIRELESS LLC,
Patent Owner.

Case IPR2024-00606
Patent 7,924,802

PATENT OWNER'S AUTHORIZED PRELIMINARY SUR-REPLY

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The Petition had to show "how the challenged claim is to be construed." 37 C.F.R. § 42.104(b)(3). Therein, Petitioner treated the preamble of claims 1 and 10 as limiting. Pet., 9, 12, 18, 30, 78, 86; POPR, 8-10, 12, 33. But Petitioner now sings a different tune. It argues for the first time that the preamble is not limiting, and that "a wireless communication channel" means "one or more" channels. Reply, 1-4. It also presents unauthorized new arguments as to why its grounds supposedly disclose the preamble. *Id*., 5. These new positions and arguments are untimely and incorrect. *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd*., 821 F.3d 1359, 1369 (Fed. Cir. 2016) ("the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition."); *Wasica Fin. GmbH v. Cont'l Auto. Sys*., 853 F.3d 1272, 1286 (Fed. Cir. 2017).

I. "A WIRELESS COMMUNICAITON CHANNEL" IN THE PREAMBLE OF CLAIMS 1 AND 10 IS LIMITING.

The POPR (at 2-4) showed that "a wireless communication channel" in the preamble of claims 1 and 10 is limiting. The Reply does not address any of the POPR's authorities. Nor does it address the POPR's showing (at 3-4) that the preamble here "states the framework of the invention" (*On Demand Mach. Corp. v. Ingram Indus*., 442 F.3d 1331, 1343 (Fed. Cir. 2006)) and is "necessary to give life, meaning, and vitality'" to the claim (*Catalina Mktg. Int'l v. Coolsavings.com, Inc*., 289 F.3d 801, 808 (Fed. Cir. 2002)).

The Reply contends that the preamble is not "structurally necessary" for

claims 1 and 10. Reply, 2. Even if that were true, it would be insufficient as it does not address the other bases discussed in the POPR. But it is also not true. Petitioner argues that because "in a wireless communication channel" does not appear in the system claim 17, it follows that it is not "structurally necessary" for the method claims 1 and 10. *Id*. Petitioner ignores that method claims, unlike apparatus claims, "typically rely entirely on what the method 'does.' And what a method does is usually recited in its preamble," and, consequently, "statements of intended purpose in methods of using apparatuses … has tended to result in a conclusion that such preamble language is limiting." *Eli Lilly & Co. v. Teva Pharms. Int'l GmbH*, 8 F.4th 1331, 1341 (Fed. Cir. 2021); *see also* POPR, 2-3.

The Reply ignores the POPR's citations to the '802's specification. *See* POPR, 2-3. Instead, Petitioner argues that "Figures 6, 7A and 7B are the only figures that depict methods (and map to claims 1 and 10), yet their corresponding descriptions in the specification do not mention 'a wireless communication channel.'" Reply, 2. Petitioner is wrong. *See*, *e.g*., Ex. 1001 ['802] 1:61-63 ("the present invention includes a ***method*** of transmitting information ***in a wireless communication channel***"); 2:45-47 (same). Nor does Petitioner provide any analysis that Figures 6, 7A-7B "map to claims 1 and 10" or that they otherwise intended to deviate from the '802 patent's repeated and consistent emphasis that its invention is in the context of "a wireless communication channel." POPR, 2-3.

Finally, the Reply (at 1) faults Patent Owner for not submitting an expert declaration. But Petitioner's expert expressly considered the preamble a "limitation." *See* Ex. 1003 [Almeroth-Decl.] ¶ 82. Patent Owner was not required to submit expert testimony regarding an undisputed issue. *See* Pet., 9, 12, 18, 30, 78, 86. Petitioner has not provided any justification for changing its position.

II. "IN A WIRELESS COMMUNICATION CHANNEL" REQUIRES THE CLAIMED METHOD TO BE PERFORMED IN ONE "WIRELESS COMMUNICATION CHANNEL."

As the POPR (at 5-8) explained, "in a wireless communication channel" requires that the claimed method be performed within one wireless communication channel. As the CAFC has explained, "the question is not whether there can be more than one request in a claim-covered system: there can." *In re Varma v. IBM Corp*., 816 F.3d 1352, 1363 (Fed. Cir. 2016). Rather, the question here is whether the claimed method can be split across two or more communication channels, without any one communication channel practicing the claim. It cannot. "For a dog owner to have 'a dog that rolls over and fetches sticks,' it does not suffice that he have two dogs, each able to perform just one of the tasks." *Id*.

The Reply has no response to *In re Varma*. In fact, the Reply does not cite ***any*** case that finds "a" to mean "one or more" in similar circumstances. Reply, 3-4. Instead, Petitioner argues that Patent Owner misapprehended a different case, *Convolve, Inc. v. Compaq Computer Corp.*, 812 F.3d 1313, 1321 (Fed. Cir. 2016).

Reply, 3. *Convolve* supports the proposition that there is no presumption that "a" means "one or more" when it appears before "comprising." POPR, 5-6. Petitioner argues that *Convolve* "did not attach any significance to the term 'a processor' appearing before the word 'comprising.'" Reply, 3. But it did. *Comcast* first explained that "an indefinite article 'a' or 'an' in patent parlance carries the meaning of 'one or more' ***in open-ended claims containing the transitional phrase 'comprising***,'" and then found that claim 1 requires a single processor perform certain function because, *inter alia*, it "recites 'a processor' ***in the preamble before recitation of 'comprising.'***" *Id*. In contrast, "a processor" in claim 9 meant "one or more" because it appeared after "comprising." *Id*.

The Reply (at 3-4) also relies on *Braintree Laboratories, Inc. v. Novel Laboratories*, 749 F.3d 1349 (Fed. Cir. 2014) but that case is inapposite. *Braintree* in fact ***reversed*** the lower court holding that "a patient" means "one or more patients." *Id*., 1357. Instead, it held that in the context of that patent, "a patient" referred to "the general class of persons to whom the patented composition is directed." *Id*. Thus, *Braintree* is inapposite.

The Reply's reliance (at 3) on *TiVo, Inc. v. EchoStar Commc'ns Corp.*, 516 F.3d 1290, 1303 (Fed. Cir. 2008) is similarly misplaced because there, "an MPEG stream" appeared after "comprising," and the Court still held that it meant only one MPEG stream. *Id*., 1295, 1303-1304.

III. PETITIONER'S BELATED AND UNAUTHORIZED ARGUMENTS FAIL TO SHOW THAT ITS GROUNDS DISCLOSE THE CLAIMS.

The Reply (at 4-5) improperly argues that its grounds disclose the preamble. This is outside of the authorized briefing scope, which was limited to "responding to Patent Owner's arguments concerning the construction of the preamble." *See* Board Email dated July 1, 2024. The Reply still fails to meet its burden.

The Petition contended that plain and ordinary meaning applies to all terms. Pet., 9. The Reply (at 5) now argues that "a communication channel," "to the extent it is comprehendible," "refers to a single transmission signal …." It presents no plain meaning analysis, or any citation to evidence or its expert declaration. It presents no analysis of the specification other than two irrelevant citations.

Nor is Petitioner correct. For example, its own exhibit analyzes a "communication channel" based on transmission between a single transmitter and a single receiver. Ex. 1023 [Lathi] 110-114. Petitioner's construction does not so limit the "single transmission signal." Petitioner's references in its grounds similarly use "channel" inconsistently with the Reply. *See, e.g.*, POPR, 8-10, 34. The Reply's assertion (at 5) that Patent Owner is in "no position" to raise this issue improperly reverses the burden of proof. *Google LLC v. Neonode Smartphone LLC*, IPR2021-01041, Paper 52, 25 (Jan. 11, 2023) ("Because [Petitioner] has the burden of persuasion, [Patent Owner] has no obligation to precisely define the term … or explain how the term differs from the [reference].").

Respectfully submitted,

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Date: July 22, 2024

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served by electronic service, by consent between the parties (Pet. at 74), on the date signed below:

PATENT OWNER'S AUTHORIZED PRELIMINARY SUR-REPLY

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Respectfully submitted,

/ Keith Moore /

Date: July 22, 2024