UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

PROXENSE, LLC,

Patent Owner.

Case No. IPR2024-00782
U.S. Patent No. 8,646,042
Filing Date: April 12, 2012
Issue Date: February 4, 2014

PETITIONER'S PRELIMINARY REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

I. INTRODUCTION

Petitioner Google LLC submits this reply to address Patent Owner Proxense, LLC's contention that the term "enabling one or more of an application, a function, and a service" should be expressly construed to require information be received from a PDK in exchange for an access key. Paper 8, at 3. But before Proxense filed its preliminary response, the Board already rejected Proxense's nearly identical arguments, found no explicit construction of this term necessary, and instituted review in *Microsoft Corporation v. Proxense, LLC*, IPR2024-00573, Paper 11 (PTAB August 13, 2024). In that case, Proxense advanced the "same constructions," Paper 8, at 3, requesting the term "enabling one or more of an application, a function, and a service" be construed to include an exchange for an access key. Despite invoking a means-plus-function analysis for the first time, Proxense's Patent Owner Preliminary Response in this case, has not added any compelling new arguments or evidence. Paper 5, at 13-29. The Board should reject Proxense's proposed construction, and institute review.

II. ARGUMENT

A. The Enabling Term Is Not Subject to Means-Plus-Function Interpretation

Proxense contends that the "enabling" term "*may* further be defined by way of a means-plus-function analysis … *if a 'PDK', 'RDC', or 'enablement signal' are*

[sic] not a sufficiently definite structure." Paper 5, at 17 (emphasis added).[1] Not once had Proxense, in any of the related district court litigations, argued that any terms required § 112, ¶ 6 analysis. *See, e.g.*, Exs. 1024-1027. Indeed, they are not subject to a means-plus-function analysis.

At the outset, none of the independent claims of the '042 patent recite the disputed limitation in "means-plus-function" or "step-plus-function" format. *See, e.g.*, '042 patent, claim 1; claim 10. Nor does Proxense argue that PDK, RDC, and enablement signal are nonce words used as a substitute for "means" or "step." Because the disputed claim limitations do not employ "means for" or "step for," the presumption is that each of the terms PDK, RDC, and enablement signal conveys sufficiently definite structure or act and, thus, is not subject to § 112, ¶ 6. *Dyfan, LLC v. Target Corp.*, 28 F.4th 1360, 1367 (Fed. Cir. 2022).

The cases Proxense cited—*HTC Corp. v. IPCom GmbH & Co., KG*, 667 F.3d 1270 (Fed. Cir. 2012); *Rain Computing v. Samsung Electronics America,* 989 F.3d 1002 (Fed. Cir. 2021); and *Ergo Licensing, LLC v. CareFusion 303, Inc.*, 673 F.3d

[1] The Board already considered and rejected Proxense's arguments that (1) the court in *Proxense v. Samsung* previously construed the term "enabled," Paper 5, at 13, 17; and (2) the '042 patent implicitly defines "enabling" through several examples in the specification, *id.*, 14, 21-29. IPR2024-00573, Paper 11, at 8-15.

1361 (Fed. Cir. 2012)[2]—are all inapposite. In all those cases, the disputed claim terms are expressly means-plus-function limitations. *See, e.g.*, *HTC Corp.*, 667 F.3d at 1280 (The parties agreed that the term "arrangement for reactivating" was a means-plus-function limitation."); *Rain Computing*, 989 F.3d at 1006 (finding the word "module" was a black box recitation of structure "as if the term 'means' had been used"); *Ergo Licensing*, 673 F.3d at 1362 (finding the terms "control means" and "programmable control means" were means-plus-function terms).

In contrast, the terms "PDK," "RDC," and "generating an enablement signal" provide sufficiently definite structure or an act, because they are "not used as 'generic terms or black box recitations of structure or abstractions.'" *Dyfan*, 28 F.4th at 1368 ("Unlike in the mechanical arts, the specific structure of software code and applications is partly defined by its function."); *see also* Ex. 1009, 3-4. Thus, the recitation of "enabling one or more of an application, a function, and a service" does not change this. Contrary to Proxense's argument, Paper 5, at 17-19, when a "structure-connoting term … is coupled with a description of the [term's] operation" § 112 ¶ 6 does not apply. *Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1320 (Fed. Cir. 2004); *Dyfan*, 28 F.4th at 1368. Additionally, Proxense's argument that "enablement signal" is "nothing more than the encrypted data sent from the PDK

[2] Proxense cited to "303 F.3d 1361," which appears to be a typographical error.

to the RDC," Paper 5, at 19, is contrary to the '042 patent specification but more importantly irrelevant, because claim 10 is a method claim, and "generating an enablement signal" is an act that precludes treatment under § 112 ¶ 6. Because the terms themselves connote sufficient structure or act, the presumption that § 112, ¶ 6 does not apply is determinative. *Dyfan*, 28 F.4th at 1366.

B. Even if Construed as Means-Plus-Function, the Algorithm is Broader Than Proxense Argues

But, even if these terms are means-plus-function or steps-plus-function terms, Proxense is wrong that "the only algorithm disclosed in the specification" is that of "a service block … providing the corresponding access key." Paper 5, at 19-20. Notably, the '042 patent discloses a hybrid device providing "additional functionality" where an access key is *not* required, including using "credentials (credit card, account information, etc.) … to enable a service," using "cellular service account information … to enable specific cellular services," using "personal ID" to identify an account, etc. '042 patent, 15:58-61, 16:20-63; *see also* Ex. 1003, ¶¶90-93. The '042 patent further explains that "[a]ny variety of different types of [external] devices may be coupled to signal line 1406 [to an RDC] to receive the authorization or enabling signal." '042 patent, 17:5-7; Fig. 14. Thus, the "algorithm" is not limited to that of an "access key."

C. The Board Need Not Construe the "Enabling" Term to Resolve the Controversy

The Board also need not construe the term here because it is not necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). Regardless of the construction, Dua and Buer render the claims obvious. As the Petition explains, Dua discloses receiving RFID transmission data from the external tag (PDK) in exchange for information such as "communication settings, media processing capabilities, and other parameters" (access key under Proxense's construction, as evidenced by its infringement contentions) for establishing a wireless connection with the external device. *See, e.g.*, Pet. 24-28; Ex. 1003, at ¶¶134-150; Ex. 1018. Buer similarly discloses receiving necessary authentication information from the tag (PDK), including "cryptographic keys" (access keys) to extract credentials to enable a wide variety of applications, functions, or services on the hybrid device. *See, e.g.*, Pet. 42-47, 56; Ex. 1003, at ¶¶185-203, 229-233. Thus, the Board should institute review and cancel all claims.

Dated: September 10, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PRELIMINARY REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** is served on September 10, 2024, on counsel of record for the subject patent via email to the address below.

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