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Subject: IPR2021-01438 and 01439 - Request for Authorization to File Motion re: Claim Construction Order

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Dear Honorable Board,

Pursuant to 37 C.F.R. § 42.123, Proxense, LLC (Patent Owner) requests authorization from the Board to file a motion to submit the Memorandum in Support of Claim Construction Order, Proxense, LLC v. Samsung Electronics Co., Ltd. et al, No. 6:21-cv-00210-ADA (W.D. Tex., Waco Div. Dec. 28, 2022), which provides the District Court's construction of "enabling one or more of an application, a function, and a service" as recited in claims 1 and 10 of U.S. Patent No. 9,049,188 and claims 1 and 11 of U.S. Patent No. 9,235,700. Id., at 26 ("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 "enable[es] one or more of an application, a function, and a service" when it forwards such a message to the application, function, or service.").

The submission of the above claim construction is timely (as it was just entered into the Court's docket yesterday) and will not delay the proceedings. Since it was just issued, Patent Owner could not have submitted the District Court's Memorandum earlier – in fact, Patent Owner is requesting to file a motion a submit the claim construction order within one day after it was entered. Additionally, though oral hearing has taken place, approximately two months remain before the one-year deadline for completing trial. As such, the Board has time to consider the claim construction.

More importantly, Petitioner is collaterally estopped by the District Court's claim construction of "enabling one or more of an application, a function, and a service." See B & B Hardware. Hargis Industries, U.S., 135 S.Ct, 1293, 1303 (2015) ("Both this Court's cases and the Restatement make clear that issue preclusion is not limited to those situations in which the same issue is before two courts. Rather, where a single issue is before a court and an administrative agency, preclusion also often applies."); Papst Licensing GMBH & Co. KG v. Samsung Elecs. AM. Inc., 942 F3d 1243, 1251 (Fed. Cir.

2019) (""[T]he issue preclusion doctrine can apply in this court to the Patent Trial and Appeal Board's decision in an IPR once it becomes final."); and In re Freeman, 30 F.3d 1459, 1469 (Fed. Cir. 1994) ("Because Dr. Freeman had a full and fair opportunity to litigate the identical issue of the meaning of the term 'buoyant uplift,' an issue actually decided in the district court and essential to the finding of noninfringement in that action, application of issue preclusion is appropriate here."). Accordingly, in light of the claim construction order, Petitioner cannot maintain a different construction of "enabling one or more of an application, a function, and a service" in these proceedings.

In both these proceedings, and before the District Court, the interpretation of "enabling one or more of an application, a function, and a service" was at issue. In District Court, Petitioner argued "hybrid device" appearing in the preamble was indefinite because:

…claim 2 of the '188 Patent requires that the "one or more of the application, the function, and the service are enabled at least in part on the hybrid device," while claim 3 requires the same be enabled "external to the hybrid device." Accordingly, the precise boundaries of what is "on the hybrid device" and what is "external to the hybrid device" becomes important to determining the scope of the claims.

Samsung's Reply Claim Construction Brief, at 9, Proxense, LLC v. Samsung Electronics Co., LTD., No. 6:21-cv-00210-ADA (W.D. Tex., Waco Div. Dec. 28, 2022).

Before this Board, Petitioner raised the identical argument in response to Patent Owner's construction of "enabling one or more of an application, a function, and a service" with regards to the origin and destination of the enabling. Petitioner's Reply, at 10, IPR2021-01439, Paper 11.

The Board should authorize Patent Owner's motion to submit the highly relevant Memorandum in Support of Claim Construction Order because: (1) the issue was actually litigated before the District Court, and Petitioner based its indefiniteness argument on the inability to determine the meaning of "enabling one or more of an application, a function, and a service"; (2) the resolution of the issue was essential to final judgement, as the District Court determined that "hybrid device" was not indefinite based on its construction of "enabling one or more of an application, a function, and a service" in response to Samsung's arguments regarding the term; (3) Petitioner had a full and fair opportunity to litigate the issue in district court as a full Markman briefings were submitted and a Markman hearing was conducted.

Accordingly, Patent Owner requests authorization from the Board to file a motion to submit the above Memorandum in Support of Claim Construction Order.

Sincerely,

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