

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

PROXENSE, LLC,

Patent Owner.

Case No. IPR2024-00783¹

U.S. Patent No. 9,679,289

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

¹ IPR2025-00075 has been joined with this proceeding.

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EX-1059	<i>Microsoft Computer Dictionary</i> , Fifth Edition, 2002
EX-1060	Payments System Research Briefing, Federal Reserve Bank of Kansas, December 2005

I. INTRODUCTION

Apple Inc. (“Petitioner” or “Apple”) submits this Reply in response to the Patent Owner’s Response (“POR”). In its POR, Proxense, LLC (“Proxense” or “Patent Owner”) attempts to distinguish the Challenged Claims of U.S. Patent No. 9,679,289 (“the ’289 patent”) from the prior art by narrowly construing the claims as “means-plus-function” elements under 35 U.S.C. §112, ¶6. POR, 5-30. Besides its attempt to improperly construe the claims narrowly under §112, ¶6 and add limitations, Proxense has no arguments to distinguish over the prior art. *Id.* The Board did not find this argument persuasive before, stating in its Institution Decision (“ID”): “Patent Owner has not sufficiently demonstrated that the terms could not be understood by person of ordinary skill in the art ‘to have a sufficiently definite meaning as the name for structure for the claimed functions.’” ID, 15. Proxense fails to remedy this deficiency of argument in its POR.

To the contrary, as demonstrated herein, the evidence of record—including Proxense’s own positions in litigation and other proceedings, the claim construction orders of the district court and the Board, the intrinsic evidence, and almost all experts—overwhelmingly indicates that the claim terms of the ’289 patent are not subject to interpretation under §112, ¶6. The analysis of Proxense’s expert, Markus Jakobsson, is fundamentally flawed, based on incomplete information, and is

contradicted by all other experts. The Board should thus reject Proxense's proposed construction of the claim terms under §112, ¶6.

Proxense does not dispute the teachings of the prior art, Petitioner's characterizations of the prior art, or the combinations asserted in the Petition against the Challenged Claims. Thus, Proxense's attempts to distinguish over the prior art fail.

II. THE CLAIM TERMS OF THE '289 PATENT SHOULD NOT BE CONSTRUED UNDER § 112, ¶6

Proxense asserts that the claims should be interpreted under §112, ¶6. In particular, Proxense argues that claims 1 and 14 recite the function of "enabling one or more of an application, a function and a service," and that such function is attributable to "local, secured information stored by the integrated, secure memory" or an "integrated RDC³ communicating wirelessly with the at least one external device within the proximity zone" in claim 1 and is attributable to an "enablement

³ Claim 1 recites "integrated reader-decoder circuit (RDC)," whereas claim 14 recites "integrated receiver-decoder circuit (RDC)." Ex-1001, claims 1, 14. Throughout its briefing, Proxense uses the terms interchangeably. *See e.g.*, POPR, 6-7. Indeed, Proxense states "there is agreement that an RDC is nothing more than a receiver." POR, 23.

signal” in claim 14. POR, 8. Proxense argues that “none of these structures are recognized by those skilled in the art as sufficiently definite structures for performing the function,” and thus should be narrowly construed to cover a particular algorithm in the ’289 patent specification. POR, 8-9, 21-22, 24. Proxense’s argument fails for at least the following reasons.

A. §112, ¶6 Is Presumed Not to Apply

None of the elements of the Challenged Claims—including the terms “local, secured information stored by the integrated, secure memory,” “integrated RDC communicating wirelessly with the at least one external device within the proximity zone,” and “enablement signal”—use the word “means” or its counterpart “step for.” EX-1001, claims 1, 14. Thus, it is presumed that §112, ¶6 does not apply. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348-1349 (Fed. Cir. 2015).

B. Proxense Fails to Overcome the Presumption Against Interpretation Under §112, ¶6

The presumption against applying §112, ¶6 can be overcome “if the challenger demonstrates that the claim term fails to ‘recite[] sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function.’” *Williamson*, 792 F.3d at 1348. The essential inquiry remains “whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.” *Id.* As demonstrated below, Proxense fails to overcome the presumption against construing the terms “local,

secured information stored by the integrated, secure memory,” “integrated RDC communicating wirelessly with the at least one external device within the proximity zone,” and “enablement signal” under §112, ¶6. Indeed, the overwhelming evidence of record—including the testimony of multiple experts, including one of Proxense’s own—is to the contrary.

1. Proxense’s Proposed Means-Plus-Function Constructions Are Inconsistent With Proxense’s Own Positions in Litigation and Other Proceedings, the Claim Construction Orders of the District Court and the Board, and the Intrinsic Evidence

This is not the first proceeding in which the claim terms of the ’289 patent or its related patents have been construed. The very same claim terms at issue here have also been considered and construed in district court cases filed by Proxense against Samsung, Google, and Microsoft,⁴ as well as in other IPR proceedings, including IPR2021-01438 against U.S. Patent No. 9,049,188 (the “Samsung ’188 IPR”) in the same family. *See* EX-1009; EX-1020; EX-1033; EX-1030; EX-1031; EX-1042.

⁴ *Proxense, LLC v. Samsung Electronics Co., Ltd.*, 6:21-CV-00210, 6-24-cv-00143 (W.D. Tex.) (“*Samsung case*”); *Proxense, LLC v. Microsoft Corporation*, 6:23-cv-00319 (W.D. Tex.) (“*Microsoft case*”); and *Proxense, LLC v. Google LLC*, 6-23-cv-00320 (W.D. Tex.) (“*Google case*”).

In the *Samsung*, *Google*, and *Microsoft* cases, the court construed the claim terms of the '289 or related patents as follows:

Claim term	Construction
“personal digital key”	An operably connected collection of elements including an antenna and a transceiver for communicating with a RDC and a controller and memory for storing information particular to a user.
“receiver-decoder circuit”	A component or collection of components, capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing.
“enablement signal”	No construction needed.

See EX-1009; EX-1020; EX-1033. In the Samsung '188 IPR, the Board determined that “the term ‘PDK’ for ‘storing local, secured biometric information’ for authenticating a user, as claimed, encompasses a local memory for storing biometric information for authenticating a user, wherein the information is secured.” EX-1042, 18-19. In short, no district court or this Board has ever construed any claim terms of the '289 patent or its related patents as means-plus-function terms.

And with the exception of this IPR proceeding and IPR2024-00573 filed by Microsoft (the “Microsoft IPR”), in none of the other cases or proceedings has Proxense itself asserted that any claim terms of the '289 or related patents should be construed as means-plus-function elements. See EX-1009; EX-1020; EX-1033; EX-1031. In fact, in the court cases, Proxense itself proposed and argued for the very same *non*-means-plus-function constructions of “personal digital key” and “receiver-

decoder circuit” that were ordered by the court. *See id.* In the parallel litigation for this proceeding, Proxense expressly agreed that the claim term “receiver-decoder circuit (RDC)” should have the constructions set forth above. EX-1053. Furthermore, even in this proceeding, Proxense stated that the court’s constructions of “receiver-decoder circuit” and “personal digital key” are “proper,” and urged the Board to “adopt” or not “disregard” them. Patent Owner’s Preliminary Response (“POPR”), 8-9 (“The District Court’s construction of ‘receiver-decoder circuit’ was consistent with the specification and, therefore, proper and there is no compelling reason for this Board to disregard it.”), 12 (“The District Court’s construction of ‘Personal Digital Key’ was therefore proper and should be adopted by this Board.”).

Nowhere in its briefing for the *Samsung*, *Google*, *Microsoft*, and *Apple* cases did Proxense ever assert that any of the terms of the ’289 or related patents were subject to interpretation under §112, ¶6. EX-1016; EX-1024; EX-1026; EX-1031; EX-1047. Nor did Proxense apply any interpretation of claim terms under §112, ¶6 in its infringement claim charts against the products accused in the *Google*, *Microsoft*, and *Apple* cases. EX-1018; EX-1050; EX-1051; EX-1052. Further, none of the claim constructions advanced by Proxense in litigation included the “service blocks” or “access keys” that Proxense now alleges form the necessary structure for the claimed “enabling one or more of an application, a function and a service.” EX-1016; EX-1024; EX-1026; EX-1031; EX-1047; POR, 10-21, 23, 27, 30-33.

Proxense reaches back to the *Samsung* case to support its arguments that the claim terms should be subject to 112, ¶6. POR, 28-30, 32. But the ID correctly noted that the *Samsung* court’s claim construction memo contained “a determination of whether a term is indefinite [which] is not the same thing as construing a claim term.” ID, 12. Additionally, the ID correctly applied the plain meaning of “local, secured information,” “receiver-decoder circuit,” and “enabling one or more of an application, a function and a service,” noting that nothing in the specification of the ’289 patent limits or redefines these terms. ID, 8-20. Indeed, Proxense’s interpretation of the *Samsung* court’s analysis is skewed to fit its self-serving §112, ¶6 interpretations. Despite being tasked with characterizing similar limitations, neither the court nor any of the two parties asserted that these similar limitations invoke §112, ¶6 treatment, much less demand implementation details of the described algorithm implemented by control logic 250.

Nor does the intrinsic evidence support Proxense’s position on claim construction. “Intrinsic evidence, such as...the prosecution history, can be informative in determining whether the disputed claim language recites sufficiently definite structure or was intended to invoke § 112 ¶ 6.” *Dyfan, LLC v. Target Corp.*, 28 F.4th 1360, 1365-66 (Fed. Cir. 2022), citing *Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1299 (Fed. Cir. 2014). During prosecution of the ’289 patent, the applicant did not indicate that it intended any of the claim terms to invoke §112, ¶6, for example,

to distinguish over prior art. *See generally* EX-1002; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (prosecution history “often inform[s] the meaning of the claim language by demonstrating how the inventor understood the invention”). Nor did the Examiner believe that the claims were subject to §112, ¶6. *See generally* EX-1002.

2. The Analysis of Proxense’s Current Expert Is Flawed and Is Inconsistent With Proxense’s Claim Construction Positions in District Court and Other Proceedings

A number of experts—including Charles Eldering, Andrew Wolfe, Steve Traynor, and now Markus Jakobsson—have opined on claim construction for the ’289 or related patents. EX-1042; EX-1003; EX-1032; EX-2011; EX-1044; EX-1045. The vast majority of these experts have *not* concluded that the claim terms should be construed under §112, ¶6.

Dr. Jakobsson, Proxense’s expert in the present and Microsoft IPR proceedings, stands alone in opining that the disputed claim terms “integrated RDC communicating wirelessly with the at least one external device within the proximity zone,” “local, secured information stored by the integrated, secure memory,” and “enablement signal” would not be understood by a POSITA as having sufficiently definite meaning as the names of structures. EX-2014, ¶¶5, 11-12, 23-24, 65. Dr. Jakobsson’s analysis is flawed.

Dr. Jakobsson recognizes that the '289 patent describes structure for each of the disputed claim terms, and that for at least “integrated RDC” this structure is the *same* as the construction proposed by Proxense in the litigation cases, ordered by the district court (*see supra*), and adopted by Drs. Wolfe and Traynor (*see infra*). EX-2011, ¶¶55-56. However, unlike everyone else, Dr. Jakobsson did not stop there.

Dr. Jakobsson appears to have been led down this path by the legal principles provided to him by Proxense. EX-2014, ¶¶19-26. In the “Understanding of Legal Principles” section of his declaration, Dr. Jakobsson states that his understanding of the law is: “when a claim term recites a function performed by a general-purpose computer, the corresponding structure is the computer as programmed to perform an algorithm, such as a control logic, disclosed in the patent for performing the function.” *Id.* For that statement of law, Proxense cites to *Rain Computing v. Samsung Electronics America*, 989 F.3d 1002 (Fed. Cir. 2021) and *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339 (Fed. Cir. 1999). POR, 6.

But the statement of law cited by Proxense (and provided to Dr. Jakobsson) from the *Rain Computing* and *WMS Gaming* decisions is inapposite, at least for how Dr. Jakobsson applied it. In the context of those decisions, the statement “when a claim term recites a function performed by a general-purpose computer” only applies if it is already clear or has been determined that the claim terms are means-plus-function terms. In fact, the claim terms at issue in the *Rain Computing* and *WMS*

Gaming decisions were either actual “means” terms or included a “well-known nonce word” (i.e., “module”). *Rain Computing*, 989 F.3d at 1006; *WMS Gaming*, 184 F.3d at 1347-50. That is not the situation with the ’289 patent. As discussed *supra*, none of the disputed claim terms use the word “means” or its counterpart “step for.” Nor does Proxense expressly argue that either the term “local, secured information stored by the integrated, secure memory” or “integrated RDC” is a nonce word. POR, 8-22. While Proxense asserts that “enablement signal” is a nonce word, that term appears in method claim 14, and Proxense has failed to properly analyze the method claim within the appropriate legal framework as “step-plus-function.” POR, 23-28. In a method claim, the mere use of “-ing” verbs does not invoke §112, ¶6. *O.I. Corp. v. Tekmar*, 115 F.3d 1576, 1582-83 (Fed. Cir. 1997) (“If we were to construe every process claim containing steps described by an ‘ing’ verb, such as passing, heating, reacting, transferring, etc., into a step-plus-function, we would be limiting process claims in a manner never intended by Congress.”).

Rather than considering the statement of law “when a claim term recites a function performed by a general-purpose computer, the corresponding structure is the computer as programmed to perform an algorithm” as the second step in a means-plus-function analysis (which presumes lack of structure and a generic computer that requires an algorithm), Dr. Jakobsson applied this understanding of law in an improper attempt to backdoor the “local, secured information stored by the

integrated, secure memory” and “integrated RDC communicating wirelessly with the at least one external device within the proximity zone” terms as words that lack structure, and thus should be construed as means-plus-function terms specifically because they are directed to a “general-purpose computer.” EX-2011, ¶36. This improper approach is inconsistent with Dr. Jakobsson’s treatment of the “enablement signal” term, where he at least acknowledged the need for a contested term to include “means” or a “nonce” word to invoke construction under §112, ¶6. Indeed, Dr. Jakobsson follows up his analysis of “local, secured information stored by the integrated, secure memory” and “integrated wireless communication interface communicating wirelessly with the at least one external device within a proximity zone” with that for the “enablement signal,” which he opines “is a completely meaningless nonce....” *Id.*

Dr. Jakobsson’s construction of the claim terms stands in stark contrast to, and is completely contradicted by, the construction agreed upon by the court, the parties to the litigation, and the other experts. But this should come as no surprise. Dr. Jakobsson was only retained in October or November of 2024, just a few months before Proxense’s Reply in the Microsoft IPR was due. See EX-1055, 7:5-15. And Proxense did not provide Dr. Jakobsson with complete information. At his deposition, Dr. Jakobsson testified that he had not been given the claim construction briefing, *Markman* orders, or infringement contentions from the various litigation

cases; the expert declarations of Drs. Eldering, Traynor, and Wolfe; or even been informed that the claim terms had previously been construed or that other experts were involved in this IPR and related matters. EX-1055, 10:22-12:14, 49:20-54:12. Dr. Jakobsson further testified that he had “no idea” whether it would have been helpful for him to see the prior construction positions, and whether he would have disagreed with those constructions since “I haven’t seen them so it’s hard to say.” EX-1055, 53:17-54:7.

Furthermore, Dr. Jakobsson is not an objective, unbiased witness. To the contrary, Dr. Jakobsson has been adverse to Apple in at least four cases, and currently has a case pending against Apple in his own right—i.e., *Carbyne Biometrics, LLC v. Apple Inc.*, CA 1:23-cv-00324 (W.D. Tex.). EX-1055, 14:21-23:10; EX-1056. Moreover, Dr. Jakobsson testified that he wanted to work for Apple in the past, but “there was not real interest for the type of work that I was most enthusiastic about.” EX-1055, 37:16-24.

3. Proxense’s Proposed Means-Plus-Function Constructions Are Contradicted by All Other Experts

The other experts who have opined on claim construction for the ’289 or related patents—including Drs. Eldering, Wolfe, and Traynor—contradict Proxense’s proposed means-plus-function constructions and confirm that the analysis of Proxense’s expert, Dr. Jakobsson, is wrong.

Dr. Eldering was Proxense's own expert in the Samsung '188 IPR filed against a patent which is related to and has claims that are similar to those challenged here. Compare EX-1054, claims 1, 10 against EX-1001, claims 1, 14. As Proxense itself states, the '188 patent claims (at issue in the *Samsung* case) "recited the same functions at issue here (i.e., 'enabling one or more of an application, a function, and a service')." POR, 29. Importantly, Dr. Eldering did not opine that any of these terms would be understood by a POSITA to lack sufficiently definite meaning as the name for structure for performing "enabling one or more of an application, a function, and a service." EX-1043.

The opinion of Proxense's expert Dr. Eldering that these claim terms (appearing in both the '289 and related '188 patents) should not be interpreted under §112, ¶6 is confirmed by and consistent with the opinions of experts Patrick Traynor and Andrew Wolfe, who submitted declarations in the Microsoft IPR and this proceeding, respectively. EX-1044, ¶¶26-27; EX-1045, ¶¶7-24; EX-1003, ¶¶96-100; EX-1032, ¶¶29-68.

Dr. Wolfe opines that a POSITA would understand that the terms "local, secured information stored by the integrated, secure memory," "integrated RDC communicating wirelessly with the at least one external device within the proximity zone," and "enablement signal" connote sufficient structure to perform the function of "enabling one or more of an application, a function and a service." EX-1032, ¶¶29,

36, 39-40, 43, 51-52, 57, 63-69.

According to Dr. Wolfe, a POSITA would not have understood the term “local, secured information stored by the integrated, secure memory” to be a nonce word. To the contrary, a POSITA would have understood the term “memory” alone is a definite structure. EX-1032, ¶¶36, 39. *Memory* is defined as the “capacity of a computer or integrated computer system for short and medium-term retention of digital data” and speaks to a broad class of structures used to retain data for various purposes. EX-1034, 5⁵; *EnOcean GmbH v. Face Int'l Corp.*, 742 F.3d 955, 960 (Fed. Cir. 2014) (A term is “a corresponding structure, as long as the class of structures is identifiable by a person of ordinary skill in the art.”); EX-1032, ¶39. Not only would a POSITA understand that the claimed “memory” includes any of multiple varieties of memory structures for storing information, but a POSITA would have recognized that such memory structures can participate in “enabling one or more of an application, a function, and a service” by storing, for example, access information, necessary to access or otherwise invoke that application, function, or service. EX-1032, ¶¶37-40; *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 703-05 (Fed. Cir. 1998) (“Even though the term ‘detector’ does not specifically evoke a particular structure, it does convey to one

⁵ Unless otherwise stated, pagination references the PDF page.

knowledgeable in the art a variety of structures known as ‘detectors.’”).

Likewise, Dr. Wolfe opines that a POSITA would not have understood the term “integrated RDC communicating wirelessly with the at least one external device within the proximity zone” to be a nonce word. EX-1032, ¶51. Instead, a POSITA would have understood the term “RDC” alone is a definite structure, and that such structure encompasses at least “a collection of circuit components capable of wirelessly receiving data in an encrypted format and decoding the encrypted data for processing.” EX-1032, ¶51. A POSITA would have understood that an “integrated RDC” speaks to a class of structures used to connect to wireless networks, particularly because it communicates wirelessly. EX-1032, ¶¶53-55. There is ample evidence that the claimed RDC is a type of wireless communication interface which has an “established meaning in the art.” *MTD Products Inc. v. Iancu*, 933 F.3d at 1343-44; EX-1032, ¶¶53-56. Dr. Wolfe explains that “wireless cards” were known at the time and consisted of hardware enabling a computer to communicate wirelessly. EX-1032, ¶54; EX-1037, 5. More broadly, “transceivers,” “receivers,” and “decoders” denote definite structure to a POSITA and were well known examples of wireless communication interfaces. *Id.*; EX-1032, ¶54; EX-1038, 7; EX-1035, 4, 7-8. Proxense itself recognized such structure as being implicated by the recited “RDC” in advancing a construction in litigation, without relying on any §112, ¶6 invocation to support its construction. EX-2009, 3. Further, the Federal Circuit

has “determined that “‘circuit,’ by itself connotes some structure.” *See Dyfan LLC v. Target Corp.*, 28 F.4th 1360, 1366 (Fed. Cir. 2022) citing *Apex Inc. v. Raritan Comput., Inc.*, 325 F.3d 1364, 1373 (Fed. Cir. 2003).

Dr. Wolfe further opines that a POSITA would have understood the term “generating an enablement signal” is a definite act or structure. EX-1032, ¶¶63-66. The use of signals to enable functions was well known. EX-1036, 3, (“activate - To start an operation, usually by application of an appropriate enabling signal.” (emphasis added)); EX-1032, ¶66. Moreover, defining an element in functional terms “is not sufficient to convert a claim element containing that term into a ‘means for performing a specified function’ within the meaning of section 112(6).” *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580,1583 (Fed. Cir. 1996) (determining that “detent mechanism” is not overly vague or devoid of structure but is named for the action it performs). Similarly, “enablement signal” derives its name “from the function [it] perform[s]”—i.e., “an enablement signal enabling one or more of an application, a function and a service.” EX-1032, ¶¶65, 67. Further evidence establishing the well-known nature and structure of the term “enablement signal” include:

1. “enabling signal” is defined as “*noun* a signal that starts a process or allows one to take place.” EX-1039, 3.
2. “enable” is defined as “[t]o initiate the operation of a device or circuit

by applying a trigger signal or pulse.” EX-1040, 3.

3. “enable” is defined as “[t]o selectively activate a device or function. . . selective operation can be achieved by an enabling action—such as a signal . . .” EX-1041, 3.

EX-1032, ¶¶65-66.

Consistent with Dr. Wolfe’s opinions, Dr. Traynor opined that a POSITA would have understood the terms “local, secured information stored by the integrated, secure memory,” “integrated RDC communicating wirelessly with the at least one external device within the proximity zone,” and “enablement signal” to “have sufficiently definite structure, such that a MPF interpretation is improper.” EX-1045, ¶¶7-22.

The terms “local, secured information stored by the integrated, secure memory,” “integrated RDC communicating wirelessly with the at least one external device within the proximity zone,” and “generating an enablement signal” thus 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. The recitation of “enabling one or more of an application, a function, and a service” does not change this. 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). ID, 12.

In sum, all of the other experts—Drs. Eldering, Traynor, and Wolfe—agree that the claim terms should not be construed under §112, ¶6.

C. Proxense’s Proposed Means-Plus-Function Constructions Should Be Rejected Because They Could Lead to Inconsistent Results, Lack of Unity, and Undermining the Integrity of the Patent System

Proxense is advancing entirely different positions for claim construction as between this IPR proceeding and litigation. In contrast to its positions in the court cases (discussed *supra*), here, Proxense’s proposed means-plus-function constructions seek to narrow the claims to require that “enabling one or more of an application, a function and a service” be performed through the exchange of “an access key.” POR, 9-28.

The timing of Proxense’s first proposal to construe the claims of the ’289 patent under §112, ¶6 is important. From what Petitioner can discern, this occurred on April 29, 2024, when Proxense filed its Preliminary Response in the Microsoft IPR. EX-1057. Proxense reaches back to the *Samsung* case to support its arguments that the claim terms should now be subject to 112, ¶6. POR, 28-30, 32, 35. But the *Samsung* case settled on January 19, 2023, before Proxense sued Microsoft and Google in May 2023, and Petitioner in March 2024. If the rulings of the court in the *Samsung* case counseled that the claim terms of the ’289 patent should be construed under 112, ¶6, Proxense should have proposed such construction in each of the

Google, *Microsoft*, and *Apple* cases. Proxense did not. *See* EX-1026; EX-1031; EX-1047. Instead, Proxense requested and obtained ***non***-means-plus-function constructions, and proceeded to litigate its cases on that basis. *See e.g.*, EX-1018; EX-1050; EX-1051; EX-1052. It was only after Proxense was faced with the invalidity arguments made in this proceeding and the Microsoft IPR challenging the '289 patent that Proxense changed its position on claim construction.

Proxense's strategy is clear—it seeks to narrow the claims through a means-plus-function construction to avoid the prior art in IPR, while maintaining a broader construction of the same terms in litigation. The Board should not reward Proxense for its gamesmanship. If the Board were to adopt Proxense's proposed means-plus-function constructions versus the court's broader constructions on the same terms, "the subsequent decisions issued in reliance on these inconsistent claim constructions may lack 'uniformity' between [the Board] and the district court and may undermine the 'predictability' of the ['289] patent's claim scope and the 'integrity of the patent system' overall." *Kiosoft Technologies, LLC v. TechTrex, Inc.*, IPR2021-00086, Paper 12, at 16. Thus, Proxense's means-plus-function constructions should be rejected.

III. PROXENSE’S ATTEMPTS TO DISTINGUISH OVER THE PRIOR ART FAIL

All of Proxense’s arguments to distinguish the Challenged Claims over the prior art are based on a construction of the claims—whether interpreted under §112, ¶6, or otherwise—that require “local, secured information” or “enabling one or more of an application, a function and a service” be unlocked or performed through the exchange of “an access key” POR, 30-37.

For Grounds 1 and 2, Proxense argues that Dua alone or in combination with Giobbi ‘157 and/or Kotola fails to disclose the “local, secured information” limitation because “Dua fails to disclose that tamper proofing is accomplished by storing confidential information or encryption keys ‘locally,’ meaning within a service block of a RFID tag and unlocked with a corresponding access key provided to the RFID tag.” POR, 30-32. Proxense argues that the cited prior art fails to disclose the “enabling” limitation because “Dua does not contemplate that information is received in exchange for an access key provided to the PDK” and “nowhere does Dua teach or describe that this ‘connection setup’ is accomplished by providing an access key in exchange for information held locally in the PDK’s service blocks.” POR, 32-33.

For Grounds 3-5, Proxense argues that Buer, alone or in combination with Giobbi ‘157 and/or Nishikawa fails to disclose or render obvious “local, secured information” because Buer’s data memory 314 “is not unlocked by an access key

provided by the service provider as required by the challenged claim(s).” POR, 33-34. Proxense argues that the cited references do not disclose the “enabling” limitation because “Buer at most teaches sending messages containing credential information from a token activated by proximity” and “the first message lacks information received from a token in exchange for an access key provided to the token.” POR, 34-36.

As discussed above, contrary to Proxense’s arguments, the claim terms of the ’289 patent are not subject to interpretation under §112, ¶6. Thus, Proxense’s attempts to distinguish over the prior art on this basis fail.

Furthermore, to the extent Proxense is arguing that the claimed limitations are required to be performed through the exchange of “an access key” even if not interpreted under §112, ¶6, the Board already considered and rejected this argument in the Institution Decision. ID, 8-10, 12, 17-19, 29-30, 33-34, 40, 43-44. As stated in the ID, “we determine that the term “local, secured information” encompasses information stored locally on an integrated, secure memory, wherein the information is secured, and is not limited to information stored within a service block of a PDK and unlocked with a corresponding access key provided to the PDK.” ID, 10. Likewise, “we determine that the term “enabl[ing] an application, a function, and a service” recited in claims 1 and 14 is not limited to receiving information from a PDK in exchange for an access key.” ID, 20.

In the ID, the Board noted that any special definition for the “local, secured information” or “enabling” claim terms requiring the use of an access key “must be set forth in the Specification with reasonable clarity, deliberateness, and precision.” ID, 10, 18-20. The Board concluded: “We do not discern such clarity, deliberateness, and precision to be present here.” ID, 10, 20.

With the POR, Proxense even now fails to show that the specification of the ’289 patent sets forth with reasonable clarity, deliberateness, and precision any special definitions of the “local, secured information” or “enabling” terms that would require the use of “access keys.” POR, 9-21, 23-28. Proxense’s entire argument for the meaning of these terms relies on a means-plus-function construction (*see id.*), which as discussed above should be rejected.

IV. CONCLUSION

Proxense's proposed constructions for the claims which lack "means for" and "step for" language, should be rejected because Proxense has failed to overcome the rebuttable presumption against §112, ¶6 treatment of these limitations. Because Proxense's proposed narrowing constructions are the basis for its entire argument in the POR, the instituted grounds have not been rebutted and the Challenged Claims are unpatentable over the prior art.

Date: May 5, 2025

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24, the undersigned hereby certifies that the foregoing **PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE** contains 4983 words, excluding those portions exempted under 37 C.F.R. § 42.24(c), as measured by the word-processing system used to prepare this paper.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on May 5, 2025, a complete and entire copy of the foregoing **PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE** and accompanying exhibits were provided by email, to the Patent Owner, by serving the correspondence addresses of record as follows:

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