

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioners,

v.

PROXENSE, LLC,

Patent Owner

IPR2024-00783

IPR2025-00075

U.S. Patent No. 9,679,289 B1

PATENT OWNER SUR-REPLY

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EXHIBIT LIST

No.	Exhibit Description
2001	Claim Construction Order in <i>Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.</i> , No. 6:21-CV-00210-ADA
2002	Memo In Support of Claim Construction Order in <i>Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.</i>
2003	Markman Transcript from <i>Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.</i>
2004	Claim Construction Order in <i>Proxense, LLC v. Google LLC</i> , No. 6:23-cv-00320 ADA
2005	Google LLC's Opening Claim Construction Brief in <i>Proxense v. Google LLC</i> , No. 6:23-cv-00320-ADA
2006	Opening Claim Construction Brief in <i>Proxense v. Samsung Electronics, Co., Ltd. et al.</i>
2007	Reply Claim Construction Brief in <i>Proxense v. Samsung Electronics, Co., Ltd. et al.</i>
2008	Claim Construction Order in <i>Proxense v. Microsoft Corporation</i> , No. 6:23-cv 00319-ADA
2009	INTENTIONALLY LEFT BLANK
2010	INTENTIONALLY LEFT BLANK
2011	INTENTIONALLY LEFT BLANK
2012	Plaintiff's Preliminary Claim Construction in <i>Proxense, LLC v. Apple, Inc.</i> , No. 6:24-cv-00143-ADA
2013	Defendant's Preliminary Claim Construction in <i>Proxense, LLC v. Apple, Inc.</i> , No. 6:24-cv-00143-ADA
2014	Declaration of Markus Jakobsson
2015	Exhibit 3002, Email to Board, <i>Samsung Electronics America, Inc. v. Proxense, LLC</i> , IPR2021-01438
2016	Commissioner for Patents Memo of March 18, 2024, Resources for Examining Means-Plus-Function and Step-Plus-Function Claim Limitations (35 U.S.C. 112(f))

I. INTRODUCTION

Petitioner’s (“Apple”) Response only demonstrates that three different paths lead to the same result. In *Proxense, LLC v. Samsung Electronics, Co., Ltd. et al.*, No. 6.21-CV-00210 (W.D. Tex. March 5, 2021) (“Proxense v. Samsung”), when determining if the term “hybrid device” was indefinite, the District Court reached the same construction Patent Owner (“Proxense”) advances in these proceedings. *See* 2002, 26-27. Likewise, when attempting to construe the term “enabling one or more of an application, a function, and a service,” Dr. Eldering reached a construction nearly identical to that which Patent Owner advances. *See* Ex. 1043, ¶¶ 18, 35, and 55-74. Consistent with both the District Court and Dr. Eldering, Proxense proposes a construction that includes the algorithm of control logic 250. *See* Paper 20, 21 and 27. The only difference between the District Court’s, Dr. Eldering’s and Patent Owner’s is the path taken to arrive at the same result. The fact that three different analyses arrive at the same construction demonstrates it is the correct construction.

II. CLAIM CONSTRUCTION

To be clear, Patent Owner is asking the Board to construe the following two terms:

“one or more of (a) the integrated RDC communicating wirelessly with the at least one external device within the proximity zone and (b) the local, secured information stored by the integrated, secure memory

enables one or more of an application, a function, and a service.” 289 Patent, claim 1.

“an enablement signal enabling one or more of an application, a function and a service.” 289 Patent, claim 14.

These are the terms at issue and the terms the Patent Owner respectfully requests the Board construe when assessing Petitioner’s grounds of invalidity. Accordingly, Patent Owner asserts these terms invoke 35 U.S.C. § 112, ¶ 6.

A. District Court’s Construction

The District Court construed the above two terms when determining if “hybrid device” as used in the preamble of claims 1 of U.S. Patent Nos. 9,049,188 (“188 Patent”) and 9,235,700 (“700 Patent”), the body of claim 10 of the 188 Patent, and the body of claim 11 of the 700 Patent was indefinite. *See* Ex. 2002, 25. “In the face of an allegation of indefiniteness, general principles of claim construction apply.” *Enzo Biochem, Inc. v. Applera Corp.*, 589 F.3d 1325, 1332 (Fed. Cir. 2010) (citing *Young v. Lumenis, Inc.*, 492 F.3d 1336 (Fed. Cir. 2007)). Accordingly, the District Court had to engage in claim construction to determine if the term “hybrid device” was indefinite as Samsung asserted.

Applying the general principles of claim construction, the District Court concluded,

“A POTISA could reasonably ascertain the scope of the claim because the claims explain the required operation of the “hybrid device.” 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 ‘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 claimed ‘hybrid device’ carries out these functions.” Ex. 2002, 26.

As with the claims 1 of the 188 Patent and 700 Patent, the 289 Patent now at issue recites the term “hybrid device” in the preamble of claim 1. Additionally, as with claim 10 of the 188 Patent and claim 11 of the 700 Patent, claim 14 of the 289 is a method claim reciting “hybrid device” within the body of the claim. Thus, there is no reason the District Court’s construction should not be given weight.

Furthermore, Proxense has never asked the District Court, nor the USPTO, to depart from this construction. Immediately after District Court issued Ex. 2002, Proxense notified the Office and “request[ed] 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).” Ex. 2015, 1. Furthermore, the Patent Owner specifically requested the District Court maintain its construction of “hybrid device” in *Proxense v. Apple*. Ex. 2012, 2. (Proposing a claim construction for “hybrid device” as “Adopt the Court’s prior construction in *Proxense v. Samsung*: A device

comprising an integrated personal digital key (PDK) and an integrated receiver-decoder circuit” and a construction for “hybrid device comprising” as “Plain and ordinary meaning. No construction necessary beyond adopting the Court’s prior construction of “hybrid device” in *Proxense v. Samsung*.”). Accordingly, from the moment the District Court issued its construction of “hybrid device,” Patent Owner has consistently requested it be maintained.

B. Dr. Eldering’s Opinion

Prior to the District Court issuing Ex. 2002, Patent Owner requested Dr. Eldering provide his expert opinion as whether “enabling one or more of an application, a function, and a service” would be understood by a POSITA as being “explicitly defined in the specifications.” Ex. 1043, ¶ 18. Based upon his review of the specification, including the numerous examples recited therein, Dr. Eldering concluded, “It is my opinion that the term ‘enabling one or more of an application, a function, and service’ is explicitly defined in the specification as sending a message comprising information from a service block of a PDK unlocked, prior to transmission, with an access key provided to the PDK,” Ex. 1043, ¶ 55; *see also* ¶ 69 (“[T]he specification explicitly defines an integrated PDK ‘enabling one or more of an application, a function, and service’ as the integrated PDK sending a message comprising information from a service block of the PDK unlocked, prior to transmission, with an access key provided to the PDK.”) and ¶ 70 (“The shared

specification also explicitly defines the integrated RDC ‘enabling one or more of an application, a function, and service’ as receipt by the integrated RDC of a message comprising information from a service block of a PDK unlocked, prior to transmission, with an access key provided to the PDK.”). Additionally, Dr. Eldering concluded “local, secured information stored by the integrated, secure memory ... is explicitly defined in the specification[] ... as a “service block accessed by an access key provided to a PDK containing the service block.” Ex. 1043, ¶ 17; *accord* ¶¶ 42, 45, and 46. Accordingly, when just examining the teachings of the specification, Dr. Eldering found an explicit definition consistent with the District Court’s construction. Thus, though applying different analyses, Dr. Eldering and the District Court arrived at the same construction.

That both Dr. Eldering and the District Court arrived at the same result when applying different analyses demonstrates the correctness of their determinations. Each independently supports the other. Thus, to the extent Dr. Eldering’s Declaration is relevant to these proceedings and properly presented (Patent Owner does not concede either), it verifies the factual accuracy of the District Court’s construction of “hybrid device.”

C. Patent Owner’s Means-Plus-Function Analysis

While Dr. Eldering’s Declaration provides factual support for the District Court’s construction, it cannot provide a legal analysis. Accordingly, Patent Owner

provided a legal analysis. *See* Paper 20, 4-28. As with Dr. Eldering’s factual analysis, Patent Owner’s legal analysis fully supports the District Court’s construction. Thus again, different analyses converge upon the same conclusion, demonstrating the accuracy of the shared conclusion.

Admittedly, the terms to be construed do not recite the words “means.” However, this is not dispositive as to whether 35 U.S.C. § 112, ¶ 6, is invoked. It merely creates a presumption that § 112 ¶ 6 does not apply. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015). “That presumption ‘can be overcome and § 112 ¶ 6 will apply 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.’” *Fintiv, Inc. v. PayPal Holdings, Inc.*, 134 F.4th 1377, 1381 (Fed. Cir. 2025) (citing *Williamson*, 792 F.3d at 1348). Accordingly, the critical inquiry is whether the claims recite sufficient structure for performing the recited function of “enabling one or more of an application, a function and a service.”

The structure recited in the claims for performing the function of “enabling one or more of an application, a function and a service” is “local, secured information stored by the integrated, secure memory” or an “RDC.” Petitioner does not dispute that these structures are nothing more than general-purpose computers. Rather, Petitioner asserts that a general-purpose computer is a sufficiently definite

structure when recited in the claims. However, a general-purpose computer is not a sufficient structure absent an algorithm. *Fintiv*, 134 F.4th at 1384 (“If the function is performed by a general-purpose computer or microprocessor, then the second step generally further requires that the specification disclose the algorithm that the computer performs to accomplish that function.” (Quoting *Rain Computing, Inc. v. Samsung Electronics America, Inc.*, 989 F.3d 1002, 1007 (Fed. Cir. 2021))). Petitioner has not provided any reason as to why a general-purpose computer when recited in the claims is somehow a sufficiently definite structure, but not when the same general-purpose is recited in the specification. Such a misapplication of established precedent would completely turn means-plus-function analysis on its head. Otherwise indefinite claims would be suddenly valid simply because the claims recite or could be construed as reciting a general purpose. *See Fintiv*, 134 F.4th at 1385 (“We have held that describing “the results of the operation of an unspecified algorithm” is not sufficient to transform the disclosure of a general purpose computer into the disclosure of sufficient structure to satisfy § 112 ¶ 6.” (citing *Aristocrat Techs. Austl. Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1335 (Fed. Cir. 2008))).

Petitioner next attempts to discredit Patent Owner’s legal analysis by noting that claim 14 is a method claim. However, the relevant limitation (i.e., “an

enablement signal enabling one or more of an application, a function and a service”) is a structural limitation, and thus mean-plus-function analysis is appropriate.

“To the extent the [Petitioner] or the Patent and Trademark Office understood that a means-plus-function term cannot be nested in a method claim, they were incorrect. Applicants are free to invoke § 112 ¶ 6 for a claim term nested in a method claim. We have never held otherwise”

Rain Computing, 998 F.3d at 1006 (Fed. Cir. 2021); *see also* Ex. 2016, at 2 (“It is important for examiners to note that structural elements may appear in both product claims and process claims; thus, all claim types should be reviewed for the presence of means-plus-function limitations.”).

Petitioner’s criticisms of Patent Owner’s legal analysis have no legal merit. More importantly, Patent Owner’s analysis under § 112, ¶ 6 arrives at arrives at the same construction reached by Dr. Eldering and the District Court. Three different analyses arriving at the same construction demonstrate the accuracy of Patent Owner’s proposed construction.

III. DR. JAKOBSSON DECLARATION

Petitioner attempts to discredit the testimony of Dr. Jakobsson based on some alleged bias. Even if true (which Patent Owner does not concede), and the Board were to disregard Dr. Jakobsson testimony (Patent Owner believes the Board should not), the prior testimony of Dr. Eldering introduced by Petitioner clearly supports

Patent Owner's proposed construction. Accordingly, Dr. Jakobsson testimony is fully collaborated by the prior testimony of Dr. Eldering. Consequently, Petitioner's efforts to discredit Dr. Jakobsson are defeated by the prior testimony of Dr. Eldering. The Board, therefore, should not disregard the testimony of Dr. Jakobsson.

IV. PATENT OWNER'S INFRINGEMENT CONTENTIONS

Petitioner attempts to raise issues with Patent Owner's infringement contentions. As an initial matter, whether the infringement contentions properly assert infringement is irrelevant to these proceedings. The Board does not have the authority to make determinations regarding infringement. Accordingly, if the Board were to evaluate the sufficiency of Patent Owner's infringement contentions, it would be making determinations beyond its statutory authority.

Additionally, Petitioner has cited no authority for its claim that Patent Owner had to specifically announce its claim construction positions, including the applicability of § 112, ¶ 6, in the infringement contentions. Thus, Petitioner is asking this Board to set rules for the District Courts. This is incredibly improper as each court is allowed to set its own rules.

Petitioner's criticism of Patent Owner's infringement contentions should not be entertained by the Board.

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. Petitioner does not even attempt to show performance of the algorithm by the asserted references. Accordingly, Petitioner has not established the invalidity of the 289 Patent.

Dated: June 16, 2025

Respectfully submitted by,

___/James A. Zak/___

James A. Zak, Esq.
(Reg. No. 60,190)
jzak@hechtpartners.com
HECHT PARTNERS LLP
125 Park Avenue, 25th Floor
New York, NY 10017
P: (651) 357-8517

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 2,116 words, which is less than the 5,600 words allowed under 37 C.F.R. § 42.24(c)(4).

Dated: June 16, 2025

Respectfully submitted by,

____/James A. Zak/_____

James A. Zak, Esq.
(Reg. No. 60,190)
jzak@hechtpartners.com
HECHT PARTNERS LLP
125 Park Avenue, 25th Floor
New York, NY 10017
P: (651) 357-8517

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 June 16, 2025, by e-mailing copies to the e-mail addresses provided by Petitioner in their Petition.

Dated: June 16, 2025

Respectfully submitted by,

___/James A. Zak/___

James A. Zak, Esq.
(Reg. No. 60,190)
jzak@hechtpartners.com
HECHT PARTNERS LLP
125 Park Avenue, 25th Floor
New York, NY 10017
P: (651) 357-8517