

Apple Inc.

Petitioner

v.

Proxense, LLC

Patent Owner

IPR2024-00782 & IPR2024-00783

PROXENSE

Claims Have Been Construed – and Apple Cannot Rebut Dr. Jakobsson with Borrowed Testimony

- The Board construed the claims at issue in IPR2024-00573 and IPR2024-00407.
 - Patent Owner disagreed but cannot dispute that construction here.
 - The Board will rely on and import the construction from IPR2024-00573 and IPR2024-00407.
- However, the Board **cannot** properly consider Apple’s “**borrowed**” testimony for purposes of rebutting the testimony Dr. Jakobsson in these proceedings.
- Apple’s witness, Dr. Wolfe, never refuted Dr. Jakobsson testimony that “local secured information stored by the integrated secure memory,” “RDC,” and “PDK” are general purpose computers.

- The claims at issue were construed by this Panel in other proceedings.
- The proper forum to dispute that construction would be:
 - Request for Rehearing under 37 C.F.R. § 42.71(d);
 - Request for Director Review under 37 C.F.R. § 42.75;
 - An appeal to the United State Court of Appeals for the Federal Circuit under 35 U.S.C. § 141(c).
- These proceedings are not the proper forum and thus the Panel must adopt the claim construction from IPR2024-00573 and IPR2024-00407.

“Borrowed” opinions/testimony should not be considered for purposes of rebutting the testimony Dr. Jakobsson.

- The Board should not consider Petitioner’s Borrowed Testimony for purposes of rebutting Dr. Jakobsson.
- Apple has offered the testimony from three different IPRs in its replies.
 - Traynor from IPR2024-00573 & IPR2024-00407
 - Eldering from IPR2024-01438
- These were not Apple’s experts, they were third parties whose testimony was unfairly lifted from other proceedings.

“Borrowed” opinions/testimony should not be considered for purposes of rebutting the testimony Dr. Jakobsson

5 U.S.C. § 556(d): “A party is entitled to present his case or defense by oral or documentary evidence, to submit rebuttal evidence, and to *conduct such cross-examination* as may be required for a full and true disclosure of the facts.”

“Borrowed” opinions/testimony should not be considered for purposes of rebutting the testimony Dr. Jakobsson

- Traynor and Eldering are third-parties to these proceedings.
- Compelling testimony under 35 U.S.C. § 24 would have been *impossible to complete in six weeks*, requiring:
 - Getting permission under 37 C.F.R § 42.20(b) to file a motion under 37 C.F.R. § 42.52
 - Filing the motion under 37 C.F.R. § 42.51(b)(2) to compel
 - Filing Petitioner’s opposition to the motion
 - Granting of the motion
 - Filing an Application for Subpoena with the District Court under 35 U.S.C. § 24
 - Wait for the Subpoena to issues
 - Serve the Subpoena and wait for acceptance or rejection
 - Take the deposition – assuming witness is available

Apple's witness, Dr. Wolfe, never refuted Dr. Jakobsson testimony that terms are general purpose computers.

- Dr. Jakobsson testified the terms “local secured information stored by the integrated secure memory,” “RDC,” and “PDK” are general purpose computers.
 - “Rather, the ‘integrated RDC,’ recited in claim 1 of the 042 Patent, is nothing more than the general ability of general-purpose computers to decode encrypted data received via Bluetooth, Wi-Fi, and similar connection. The ‘integrated PDK,’ also recited in claim 1 of the 042 Patent, is nothing more than a general-purpose computer capable of communication.”
 - IPR2024-00782, Ex. 2011, ¶ 36.
 - “On its face, the term ‘local, secured information stored by the integrated, secure memory’ recites nothing more than a computer readable media providing the general and generic ability of general-purpose computers to securely store information within tamper-proof memory.”
 - IPR2024-00783, Ex. 2014, ¶ 37

Apple's witness, Dr. Wolfe, never refuted Dr. Jakobsson testimony that PDKs and RDCs are general purpose computers

- Dr. Wolfe never refuted that terms “local secured information stored by the integrated secure memory,” “RDC,” and “PDK” are general purposes computers.
- Dr. Wolfe acknowledged that he “understand[s] that for patents involving a computer-implemented invention in which the inventor has used means-plus-function claiming, the courts have consistently required that the structure disclosed in the specification *be more than simply a general purpose* computer or microprocessor.” Supp. Wolfe Decl., Ex 1032. ¶
 - Though not as pertinent, the **borrowed** testimony from Dr. Traynor also does not refute that terms “local secured information stored by the integrated secure memory,” “RDC,” and “PDK” are general purposes computers
- That a “local secured information stored by the integrated secure memory,” “RDC,” and “PDK” are nothing more than general purposes computers, therefore, is not in dispute.

Apple's witness, Dr. Wolfe, never refuted Dr. Jakobsson testimony terms are general purpose computers

- Unable to refute Dr. Jakobsson's testimony through their own expert, Apple attempts to discredit him.
- But he prior testimony of Dr. Eldering introduced by Apple clearly supports Patent Owner's proposed construction – verifying the accuracy and credibility of Dr. Jakobsson testimony
 - “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
 - “[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.” Ex. 1043, ¶ 69
 - “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.” Ex. 1043, ¶ 70

Patent Owner is not making a strategic Shift

- Since issued the Patent Owner has honored the District Court’s claim construction of “enabling” and construed as part of “hybrid device”
 - Immediately after District Court issued the construction, 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).” IPR2024-00783, Ex. 2015; IPR2024-00782, Ex. 2013.
 - Patent Owner specifically requested the District Court maintain its construction of “hybrid device” – under which enabling was construed - in *Proxense v. Apple*. IPR2024-00783, Ex. 2012, 2; IPR2024-00782, Ex. 2009, 2.
- Accordingly, from the moment the District Court issued its construction of “hybrid device,” Patent Owner has consistently requested it be maintained.
- Apple claims Patent Owner needed to announce its construction in its infringement contentions—but has cited no authority.

Conclusion

- The claims at issue have already been construed by this Panel – it is not proper to revisit that here.
- The PTAB can rely on and import the construction from IPR2024-00573 and IPR2024-00407.
- The testimony of Dr. Jakobsson that the terms “local secured information stored by the integrated secure memory,” “RDC,” and “PDK” are general purpose computer has not been refuted – thus the issue is not in dispute.
- Patent Owner has consistently honored the District Court’s construction since issued – no “strategic shift.”