

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

PROXENSE, LLC
Patent Owner

Case No. IPR2024-00784
U.S. Patent No. 10,073,960 B1

**SUR-REPLY TO PETITIONER'S REPLY TO PATENT
OWNER'S PRELIMINARY RESPONSE**

EXHIBIT LIST

No.	Exhibit Description
2001	Claim Construction Order in <i>Proxense v. Samsung Electronics, Co., Ltd. et al.</i> , No. 6:21-CV-00210-ADA
2002	Memorandum In Support of Claim Construction Order in <i>Proxense v. Samsung Electronics, Co., Ltd. et al.</i>
2003	Markman Transcript from <i>Proxense v. Samsung Electronics, Co., Ltd. et al.</i>
2004	Claim Construction Order in <i>Proxense 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

Claims 1 and 14 of the 960 Patent are means-plus-functions claims invoking 35 U.S.C. § 112 ¶ 6. The test for determining if § 112 ¶ 6 is invoked has been stated on several occasions.

To determine whether § 112 ¶ 6 applies to a claim limitation, we must inquire 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. If those words lack a sufficiently definite meaning, § 112 ¶ 6 applies.** If the limitation uses the word ‘means,’ there is a rebuttable presumption that § 112 ¶ 6 applies. If not, there is a rebuttable presumption that the provision does not apply. But that presumption can be overcome and § 112 para. 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.

Raining Computing v. Samsung Electronics America, 998 F.3d 1002, 1005 (Fed. Cir. 2021) (citing *Willamson v. Citrix, LLC*, 792 F.3d 1139 (Fed. Cir. 2015) (internal quotations, brackets, and citations omitted and emphasis added).

One way to demonstrate that a claim limitation fails to recite sufficiently definite structure is to show that, although not employing the word ‘means,’ the claim limitation uses a similar ‘nonce’ word that can operate as a substitute for ‘means’ in the context of § 112, para. 6... In each case, **a critical question** is whether the claim term is used in common parlance or by persons of skill in the pertinent art **to designate structure**, including either a particular structure or a class of structures.

MTD Products Inc. v. Iancu, 933 F.3d 1336, 1341 (Fed. Cir. 2019) (emphasis added). Accordingly, contrary to Petitioner’s assertions, the failure of the claims to recite a recognized “nonce” word is not determinative.¹

The claim terms at issue do not denote structure. The following claim terms are at issue: (1) “wireless communication interface”; (2) “local secured information”; and (3) “enablement signal.” On their face, these 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. Petitioner has presented no evidence to the contrary. This fact is determinative. Consequently, “we ask if the

¹ Petitioner’s claim this argument was rejected in IPR2024-00573 is false. There was no final order in that case and it is thus not controlling or binding and the means-plus-function arguments were not addressed.

claim language, read in light of the specification, recites sufficiently definite structure to avoid § 112 ¶ 6.” *Media Rights Technologies v. Capital One Financial*, 800 F. 3d 1366, 1372 (Fed.Cir. 2015).

With respect to “wireless communication interface”, although the specification does not use that exact term, it uses the term “wireless interface”:

The RDC 304 provides the **wireless interface** to the PDK 102. Generally, the **RDC 304 wirelessly receives data from the PDK 102** in an encrypted format and decodes the encrypted data for processing by the processor 306.

960 Patent, 7:52-55 (emphasis added). The “wireless communication interface” would thus be the RDC, but the specification does not provide any definite structure here. The specification describes the structure of an RDC as a transceiver and processor, but a “processor and transceiver amount to nothing more than a general-purpose computer.” *HTC Corp. v. IPCom GmbH & Co., KG*, 667 F.3d 1270, 1280 (Fed. Cir. 2012). It has been “consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor.” *Id.* Accordingly, an RDC is not a sufficiently definite structure for “wireless communication interface.”

Likewise, the disclosed PDK does not provide sufficient structure. The operation of the RDC is to “provide[] the wireless interface to the PDK” such that the “RDC 304 wirelessly receives data from the PDK 102”. The PDK is also disclosed in terms of a processor and transceiver.

In a minimal embodiment, the PDK102a includes an antenna and a transceiver for communicating with a RDC (not shown) and a controller and memory for storing information particular to a user.

960 Patent, 14:28-31. But again, a processor and transceiver amount to nothing more than a general purpose computer. *See HTC Corp.*, 667 F.3d at 1280 (Fed. Cir. 2012).

Likewise, memory storing information particular to a user requires an algorithm. “[C]omputer-readable media or storage devices amount to nothing more than a general-purpose

computer.” *Rain Computing*, 989 F.3d at 1007 (Fed. Cir. 2021). “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.”

Id. Here, the required algorithm is provided in the specification.

Regardless of how created, once created, external applications (such as applications 120 in FIG. 1) can gain access to a specific service block 112 by proving the corresponding access key 118. In FIG. 2, this is shown conceptually by control logic 250.

960 Patent, 6:64-7:1. Accordingly, the only definite structure (i.e. “the algorithm that the computer performs”) disclosed in the specification for the “wireless communication interface” is the algorithm defining the interaction between a PDK and RDC (and the only disclosure of the claim term “local secured information”) detailed in control logic 250.

The service block access keys 118 allow the sensor 108 to unlock information stored in the corresponding service blocks 112, which information is used as local secured information.

960 Patent, 3:54-57. Without this explicit and sole structural definition, the term would be nothing more than integrated secure memory. Memory, however, is not a sufficiently definite structure, it is computer-readable media. “[C]omputer-readable media or storage devices amount to nothing more than a general-purpose computer.” *Rain Computing*, 989 F.3d at 1007 (Fed. Cir. 2021). Furthermore, “controlling access to one or more software application packages to which the user has a subscription requires more than merely plugging in a general purpose computer.” *Id.* (citing *Ergo Licensing, LLC v. CareFusion 303, Inc.*, 673 F.3d 1361 (Fed. Cir. 2012) (internal quotations and brackets omitted). “Rather, some special programming, *i.e.*, an algorithm, would be required to control access to the software application packages.” *Id.* The only programming defined in the specification is the above referenced algorithm defining the operation of a PDK and RDC. Accordingly, the algorithm is the required structure.

The same is true for the “enablement signal” recited in claim 14. The structure of an enablement signal is not separately disclosed in the specification. Instead, a link between a RDC and PDK is required to generate an enablement signal on a signal line between an RDC and a device. For instance, with respect to Fig 14, the specification states, “only when the hybrid device 1102 has multiple links 1402, 1404 will the hybrid device 1102 generate an authorization or enable signal on signal line 1406.” 960 Patent, 17:54-57. In Fig. 14, links 1402, 1404 are between PDKs 102b, 102a and RDCs 304a, 304b, respectively. “If either the RDC 304b or PDK102b is not present, the hybrid device 1102 does not allow operation of the personal computer.” 960 patent, 18:4-6. Fig 15 shows another embodiment requiring the same. “For the system 1500, only when multiple PDK links 1502,1504 to the hybrid device 1102 exist, will an authorization/enablement signal be generated on signal line 1506.” 960 Patent, 18:11-13. Thus, the only disclosures of the enablement signal of the present invention, as disclosed in the specification, state that its generation is conditional upon a link between an RDC and PDK. An enablement signal, therefore, depends upon the operation of a PDK and RDC, as detailed in the above referenced algorithm, such that the algorithm is the required structure and an access key is required.

Petitioner attempts to avoid the application of a means-plus-function analysis to claim 14 by wrongly asserting method claims are precluded from treatment under § 112 ¶ 6.

To the extent the examiners 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.

Raining Computing, 998 F.3d at 1006 (Fed. Cir. 2021). Accordingly, means-plus-function analysis is applicable to claim 14.

Petitioner also attempts to avoid the clear application of the case law by citing *Dyfan, LLC v. Target Corp.*, 28 F. 4th 1360 (Fed. Cir. 2022). In that case, however, un rebutted testimony

established “that persons of ordinary skill in the art would have known of off-the-shelf code” for performing the recited functions, causing the Court to determine that “the recited functions can be performed by conventional off-the-shelf software, a person of ordinary skill in the art would have understood the alleged means-plus-function ‘code’ limitations in the asserted claims to connote structure.” *Dyfan, LLC v. Target Corp.*, 28 F. 4th 1360, 1369 (Fed.Cir. 2022). Petitioner provided no such evidence. Accordingly, Petitioner’s reliance on *Dyfan* is misplaced.

The patent specification requires an access key for all embodiments. Petitioner attempts to avoid the clear application of the case law by mischaracterizing examples in the specification as not requiring an access key. But these cited sections all require a PDK, which requires an access key. The cited sections disclose that “the **hybrid device 1102 includes and uses both the RDC 304a and the PDK 102a**. This adds the hybrid functionality of being capable of **performing both simultaneous RDC and PDK functions** to the cellphone 1202.” 960 Patent 16:38-42 (emphasis added). With respect to cellular services or charging an account, the specification states:

“If the second PDK102b is no longer present, **those services are disabled.**” 960 Patent, 17:21-22 (emphasis added).

“Since the parent is in the same vicinity, the **hybrid device 1102 communicates with the parents PDK120b** and obtains authorization to charge to the parents account.” 960 Patent, 17:42-44 (emphasis added).

Every instance Petitioner cites requires the presence of a PDK, for which there is only one algorithm disclosed, the use of an access key as discussed above.

Petitioner finally attempts to avoid the clear application of the law by citing to examples in the asserted art. However, as noted in Patent Owner’s Preliminary Response, Petitioner has only shown that the art discloses receiving a key, not providing an access key in exchange for the retrieval of information.

Dated: September 17, 2024

Respectfully submitted by,

/David L. Hecht/

David L. Hecht (Reg. No. 61,618) (lead counsel)
dhecht@hechtpartners.com
HECHT PARTNERS LLP
125 Park Avenue, 25th Floor
New York, NY 10017
P: (212) 851-6821

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that Patent Owner Proxense, LLC's Preliminary Response was served on September 17, 2024, by e-mailing copies to the following e-mail addresses as provided in Petitioner's Petition:

Google-Proxense-IPRs@finnegan.com

Dated: September 17, 2024

Respectfully submitted,

By: /David L. Hecht/
David L Hecht Reg. No 61,618
Hecht Partners LLP
125 Park Avenue, 25th Floor
New York, NY 10017
Tel: 212-851-6821
E: dhecht@hechtpartners.com

Counsel for Patent Owner