

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners,

v.

EMPIRE TECHNOLOGY DEVELOPMENT LLC,
Patent Owner.

Case No. IPR2024-00896
U.S. Patent No. 8,798,120

PATENT OWNER'S PRELIMINARY SUR-REPLY

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LIST OF EXHIBITS

Ex. No.	Description
Ex-2001	Master License Agreement
Ex-2002	Assignment and Assumption Agreement
Ex-2003	Amendment No. 2 to Master License Agreement
Ex-2004	U.S. Patent No. 8,081,698 (“Xu”)
Ex-2005	U.S. Patent App. Pub. No. US 2002/0056066 A1 (“Gesbert”)
Ex-2006	Docket Control Order, <i>Empire Technology Development LLC v. Samsung Electronics Co., Ltd., et al.</i> , 2:23-cv-00427, ECF No. 25 (E.D. Tex. Feb. 5, 2024)
Ex-2007	<i>United States District Court—National Judicial Caseload Profile</i> , UNITED STATES COURTS (Dec. 31, 2023), https://www.uscourts.gov/sites/default/files/fcms_na_distprofile1231.2023_0.pdf .
Ex-2008	Defendants’ Patent Local Rule 3-3 Disclosure of Invalidity Contentions and Subject Matter Eligibility Contentions, <i>Empire Technology Development LLC v. Samsung Electronics Co., Ltd., et al.</i> , 2:23-cv-00427, ECF No. 25 (E.D. Tex. Mar. 29, 2024)
Ex-2009	Katherine K. Vidal, <i>Memorandum re Interim Procedure for Discretionary Denials</i> , UNITED STATES PATENT AND TRADEMARK OFFICE (June 21, 2022), https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_2022_0621_.pdf .
Ex-2010	Defendants’ Identification of Preliminary Claim Constructions, <i>Empire Technology Development LLC v. Samsung Electronics Co., Ltd., et al.</i> , 2:23-cv-00427, ECF No. 25 (E.D. Tex. Oct. 9, 2024)

I. PETITIONERS' CHANGED POSITION ON "IDLE POWER CONSUMPTION" IS FATAL TO THE PETITION.

Petitioners have reversed their position on the "idle power consumption" limitation of claim 25 in an attempt to salvage their defective Petition. At the time of filing the Preliminary Response, both parties agreed that no term required construction. *See* Pet. at 9; POPR at 10-11. The parties also agreed that "idle power consumption" referred to times when the device was powered on and waiting to transmit data over the communications channel. *See, e.g.,* Pet. at 46 (stating "the claimed 'idle' mode (i.e., circuits powered on but not transmitting)"); POPR at 29 (stating "'idle time' and 'idle power consumption' refer to times when the circuitry of the device is powered on and waiting to transmit"). Now faced with the arguments of the Preliminary Response, Petitioners reverse course and broaden their interpretation of "idle power consumption" in an effort to expand the scope of claim 25 onto prior art that was already found to be distinguishable during the original prosecution. *See* Ex-1004 at 105-09, 189. Petitioners are trying the same tactic in the district court by seeking an overbroad construction of "power used by the mobile station when it is not sending data." Ex-2010 at 8. Petitioners' about-face emphasizes the deficiencies in their Petition, and the Board should deny institution.

A. Petitioners Attempt to Broaden Their Previous Understanding of "Idle Power Consumption" to Save Their Insufficient Petition.

In their Preliminary Reply, Petitioners assert that the '120 Patent "does not

require all circuitry to be ‘powered on’ when evaluating idle power consumption.” Reply at 1. Petitioners’ position defies a common sense understanding of idling—a state characterized by being powered on but inactive. Furthermore, Petitioners’ new position on idle power contradicts at least two arguments in their Petition.

First, in addition to noting that “the claimed ‘idle’ mode” has “***circuits powered on*** but not transmitting,” Pet. at 46 (emphasis added), the Petition states at least ***three*** further times that “idle power consumption means that ***the circuits are powered*** but have nothing to transmit or receive,” *id.* at 25, 41, 49 (emphasis added). Petitioners’ expert offers the exact same testimony. Ex-1002 ¶¶ 86, 120, 134, 144.

Second, Petitioners’ current position contradicts their Ground 1 argument, which recognizes that when circuits are powered off, “they ***no longer contribute to station idle power consumption.***” Pet. at 41 (emphasis added). Though all of the references fail to disclose the “idle power consumption” limitation (as explained in the POPR), Petitioners’ explanations in Ground 1 confirm that circuits do not contribute to idle power consumption when they are powered off.

B. The ’120 Patent Confirms that Circuits Are Powered On During “Idle Power Consumption.”

The ’120 Patent is clear that “***idle time is a time during which the transceiver may be waiting to send data*** over the communications channel.” Ex-1001 at 2:60-62. This sentence is an explanation of idle time, not an example (as Petitioners

contend), *cf.* Reply at 2, while the next sentence is an explicit example of idle time, Ex-1001 at 2:62-64 (“The transceiver may, for example, be waiting for a scheduled start time for the transceiver to use the communications channel”).

Petitioners argue that the '120 Patent “does not require all circuitry to be ‘powered on’” because it mentions that idle power may be consumed “[e]ven if the idling transceivers turn off their transmission chains.” Reply at 1 (citing Ex-1001 at 3:5-7). But ***turning off transmission chains*** only ***means*** that the transceivers are not transmitting—***the transceivers remain powered on*** during idle time. *Cf.* Ex-1001 at 2:59-60. Petitioners are incorrect in accusing Patent Owner of introducing a distinction between circuitry powered on and transmission chains turned off, *cf.* Reply at 1-2, because Patent Owner makes no such distinction as both correctly describe idle time. In contrast with idle time, Cui-2003 describes a sleep mode “where ***all the circuits in the signal path are shut down.***” Ex-1007 at 2806 (emphasis added). Moreover, the '120 Patent notes that idle power may be consumed by leakage current, Ex-1001 at 3:5-7, but Cui-2003 states that in sleep mode the power consumption is zero because there is no leaking current, Ex-1007 at 2806.

Petitioners err in asserting that “the '120 Patent uses the term ‘idle’ broadly to include both” sleep and idle because the '120 Patent (i) uses the term “idle” in accordance with its plain and ordinary meaning and (ii) never mentions sleep mode at all. *Cf.* Reply at 3.

IPR2024-00896 (U.S. Patent No. 8,798,120)
Patent Owner's Preliminary Sur-Reply

Dated: October 17, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that the above document was served on October 17, 2024, by filing this document through the Patent Trial and Appeal Board P-TACTS System, as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioners:

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